INTELLECTUAL PROPERTY LICENSING EXPERIENCE

OVERVIEW

Bryan Cave Leighton Paisner attorneys have handled numerous licensing matters in all IP areas; a representative listing follows.

Patent/Trade Secret/Know-how

- For manufacturers of consumer electronics devices: end-user license agreements, licenses in of software, content, and technology, and licenses out of technology

- License by an EP entity of its proprietary platform technology for collaborative research and development with a major US pharmaceutical company, with special attention paid to differing invention ownership laws in the EP and the US

- A major patent licensing program for an educational institution concerning a synthetic antibiotic

- License in of development software for use by a developer to create an application that was licensed out in the mobile telecom industry

- For a start-up: trade secret and patent licenses concerning nanotechnology for commercialization by Fortune 50 firms in the consumer products and pharmaceuticals industries and for use in connection with currency security features

- For one of the world’s largest contract manufacturers of electronics: licenses in of technology for manufacturing the hiring party’s products, with special attention to allocation of rights to newly developed technology

- License out by a major pharmaceutical company of a particular drug form to a generic pharmaceutical company

- For an insurance company: patent licenses for software to be used by its sales force

- Licenses in of patents from educational institutions concerning power metering and location identification

- License in for a major pharmaceutical company concerning controlled-release compositions as part of a transfer of its patent assets
- Licenses for development of financial and communications management systems in telecommunications and energy industries
- Licenses in of patents from educational institutions and commercial enterprises concerning plant-made pharmaceuticals, and licenses out to commercial enterprises
- For software developers: end-user licenses; licenses in of pre-existing components for incorporation into products; and licenses out to government and educational entities
- For consultants: allocation of intellectual property license and ownership rights developed for their clients in multiple industries, including logistics, transportation, software, healthcare, medical devices, and consumer electronics
- Patent and know-how licenses concerning fire prevention systems, mining equipment, biofuels, skateboards and scooters, asphalt paving technology, school bus safety equipment, and clothing
- For educational institutions: commercialization of research through licensing in compliance with the Bayh-Dole Act and relevant university policies
- Licensing for strategic alliances and joint ventures, including licenses in of technology, allocation of competitive IP exploitation rights to the venture and between venturers, and exit planning

**Trademark**

- For a major manufacturer of toy action figures: licenses with motion picture studios, publishers, NASCAR, and major professional sports leagues and their players’ associations
- For a major motorcycle aftermarket manufacturer: license in for use of a well-known mark on its products
- For a school in a state university system: licenses out of the use internationally of its mascot in connection with educational outreach project
- For an international footwear company: co-branding agreements, joint promotion agreements, product placements, and other collaborative efforts, with major brand owners and motion picture studios
- For a major US home furnishings retailer: licenses with US and international manufacturers, and joint venture and co-branding agreements
- For a manufacturer of stylized footwear: licenses out to video game developers/manufacturers to include depictions of footwear in games
▪ For a global retailer of toys and infant and baby products: licenses with third parties to allow the client to expand its trademark portfolio with relatively small expense

▪ For a world-renowned dance company: licenses out of their source-indicating choreography for live performances by third parties and for use in advertisements and on consumer products

▪ For a major charity whose goal is to bring clean and safe drinking water to people in developing nations: licenses out of its trademarks on a variety of products, a portion of the sales revenue of which goes to the charity to further its work

▪ For a major manufacturer of HVAC equipment: licensing in connection with acquisition of a company and its portfolio of internationally well-known brands

▪ For an international appliance manufacturer: licenses out of its world-famous brands

▪ For a major international food producer: brand licenses

▪ For consumer products manufacturers: licenses and other agreements with major league sports teams and stadium owners concerning sports stadium naming rights

▪ For an international hair products company: licenses with distributors in over three dozen countries

▪ For major apparel manufacturers: US and foreign licenses in and out

▪ For sporting goods manufacturers: US and foreign licenses in and out

▪ For US beverage companies: licenses out

**Copyright**

▪ For authors and publishers: licensing and distribution of academic, professional, and scientific content for print and electronic publishing

▪ For an advertising agency: licenses to use pre-existing music and performances in advertisements

▪ For an international hair products company: licenses with distributors in over three dozen countries

▪ For a well-known visual artist: licenses to use his images on posters

▪ For vendors of information services: licensing of proprietary databases

▪ For an international supplemental insurance company: licenses for insurance policies
- For a major not-for-profit organization: licensing out of a database to for profit organizations

- For a not-for-profit organization: licensing out of its photographic collection to an online retailer

**Other**

- For a well-known international luxury goods company: license to use the name, likeness, and other indicia of a deceased celebrity

- For a major toymaker: licenses with professional baseball, football, and hockey players, NASCAR drivers, and motion picture actors for use of their names, images, and identity on toy action figures

- For a famous professional baseball player: endorsement and other license agreements for the commercial use of his name, identity, and persona.

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