

SERVICES

Technology and Software Licensing, including Enterprise and Open Source
Hardware/Semiconductor
Digital Media/Internet/Entertainment
Life Sciences/BioTech
Commercial Transactions – Strategic Alliances, Corporate Partnering and M&A
Virtual General Counsel – Policies, Compliance, Employment and Consulting Agreements

» Technology and Software Licensing, including Enterprise and Open Source

We have advised clients on numerous transactions and matters relating to the development, commercialization, sales and procurement of software and technology, including:

- Software License and Support Agreements
- Enterprise and Site License Agreements
- Clickwrap/Shrinkwrap Licenses
- Evaluation Licenses
- Source Code Licenses
- Open Source Software Licenses
- Open Source Compliance Programs
- Software License Checklists and Training for In-House Sales Departments
- Distribution Agreements
- OEM/VAR/ISV Agreements
- Software Development Agreements
- Independent Consulting Agreements
- SDK (Software Development Kit Licenses)
- ASP (Application Service Provider)/Hosting Agreements
- SaaS (Software as a Service) Agreements
- Outsourced Support and Service Agreements
- SLAs (Service Level Agreements)
- Patent, Copyright, Trade Secret and Technology Licenses
- Trademark Licenses

Representative Transactions:

For **Critical Path, Inc.:**

- Negotiated software licenses and service agreements with wireless carriers and telecommunications providers worldwide, including: **AT&T, Verizon, BellSouth, Nortel, T-Mobile, British Telecom, O2, Vodafone, Nokia, Hutch Wireless, Swisscom, Telecom Italia, Telia, Telstra, Tiscali, Wind, Indosat, IDEA, China Mobile, PCCW, SK Communications, Viet Tel, and Brasil Telecom;**
- Negotiated strategic alliance, marketing, teaming and system integrator agreements with partners such as **Accenture, Hewlett Packard, Ericsson, Nokia, EDS, IBM, Logica, and Unisys;**
- Negotiated enterprise licenses and hosted service agreements with customers such as **General Electric, EDS, IBM, Bristol Meyers, DuPont, UBS, Citibank, Morgan Stanley, Visa, New York Life, Royal Bank of Canada, Royal Bank of Scotland, Walmart, State Farm, the U.S. Department of Justice and the Canada Department of National Defense, among others;**
- Developed an open source software compliance program and worked with product development and release teams to monitor and track open source usage, draft documentation, and ensure compliance with open source license terms and conditions.

Presented a “Licensing Fundamentals” training program to Siebel Systems’ in-house legal department, including licensing checklists and a playbook for negotiating software licenses and technology transactions.

Advised **OpenTV** regarding its license and distribution strategy and its patent and technology licenses for interactive television technology with **Thomson NV**.

Advised **Rhapsody Networks** in its negotiation of a key OEM Development and Distribution License Agreement with **Veritas Software** to bundle and distribute Veritas' operating system software with Rhapsody's network switching system.

>> **Hardware/Semiconductor - Development, Manufacturing and Distribution**

We have advised clients on numerous transactions relating to the development, manufacturing, distribution, commercialization, sales and procurement of hardware and semiconductor technology, including:

- OEM License, Supply and Distribution Agreements
- Joint Development Agreements
- Design License Agreements
- Manufacturing, Supply and Marketing Agreements
- Wafer Supply Agreements
- Foundry Agreements
- Evaluation and Lab Test Agreements
- Technology License Agreements
- Cross-License Agreements
- Technology and IP Transfer and Assignment Agreements

Representative Transactions:

Drafted **NuCORE Technology's** master license agreement template and negotiated key OEM Agreements with **US Software** and **Swell Software** for the license and supply of NuCORE's semiconductor products to digital camera manufacturers.

Represented integrated silicon test solutions provider **LogicVision, Inc.** in the negotiation of a joint development and marketing alliance and equity investment by **Intel Corporation**.

Drafted Technology and Trademark Licenses for **SanDisk Corporation** to establish the **CompactFlash Trade Association Alliance** relating to SanDisk's CompactFlash standard for flash memory.

Negotiated and structured complex, multi-party strategic alliance for **Sony Corporation** for next generation television set-top boxes, with separate agreements covering technology cross-licenses, cross-development, manufacturing, supply and marketing arrangements between **Sony, Sun Microsystems, General Instruments** and **TCI Cable**.

Negotiated and structured a strategic alliance, joint technology development and manufacturing, supply and marketing arrangement for flat panel displays between **Sony Corporation** and **Candescent Technologies**.

Negotiated Strategic OEM License, Supply and Distribution Agreements for **Network Appliance, Inc.** with **Dell Computer, Legato Systems, CommVault Systems** and **Cobalt Networks** for network storage appliance hardware.

>> **Digital Media/Internet/Entertainment**

We have advised clients on numerous transactions involving digital media, Internet and E-commerce, and music and film industry transactions, including:

- Merchandise, Likeness and Promotion Licenses
- Digital Music Streaming and Webcasting Licenses
- Website Development/Hosting Agreements
- Online/Website Terms of Use and Service
- Online, Game and Wireless Content Licenses and Clearances
- Video Game Development and Platform Agreements
- Video Game Publishing and Distribution Agreements
- E-Commerce, Co-Branding, Co-Marketing Agreements
- Web Advertising Agreements
- Website Linking Agreements

- DMCA Safe Harbor Policies and Compliance
- Recording and Music Publishing Agreements
- Film Composer Agreements
- Personal Management Agreements
- Privacy
 - Website and enterprise privacy policies
 - Data Transfer Agreements
 - EU Data Directive Safe Harbor
 - COPPA
 - HIPAA

Representative Transactions:

Represented **MusicMatch** (since acquired by Yahoo!) in negotiating a Webcasting Performance and Ephemeral License Agreement with the **SoundExchange** division of the **Recording Industry Association of America (RIAA)**, to allow digital music performances on MusicMatch's Web radio service. The blanket license was one of the first with the RIAA utilizing the compulsory license scheme for digital performances of sound recordings under the Digital Millennium Copyright Act (DMCA), and covered the recording catalogs of all of the RIAA-represented major labels.

Counseled **Sony Online Entertainment** on the restructuring of its IP ownership, amendment of existing development and publishing agreements, drafting agreements for the transfer of online game technology and patent rights.

Represented **Eidos Interactive** ("Lara Croft - Tomb Raider") in its multimedia game development, publishing and distribution agreements with **Disney, Microsoft, Sega** and **Blockbuster Video**.

Represented **Toysrus.com** in its strategic alliance and co-marketing agreement with **Amazon.com** for an exclusive, co-branded toy store "tab" on the Amazon.com website, and the transfer of the management and operation of Toysrus.com's entire online, e-commerce operations to the Amazon.com website.

Negotiated and managed many of the initial marketing and alliance agreements for **E*Trade Group's** online brokerage presence, as well as its international brokerage alliance joint ventures in Canada, Australia, Korea, Japan and Italy, including marketing alliances with **AOL, CNNfn, ZDNet, Yahoo, Microsoft Network, Amazon.com, Intuit, E-Loan, First Virtual Holdings, GeoCities, Netscape, CNBC, MSNBC, Softbank, Excite, Newsweek, CNET, CBS Sportsline, USA Today Financial Marketplace, Warner Bros., American Airlines Aadvantage, United Airlines (Mileage Plus), Robertson Stephens & Co., Cybercash, Visa, Varilease, 3Com/Palm Computing, Ethos, Prodigy, Infoseek, Pointcast, Critical Path, SinaNet, CompuServe/SpryNet, GTE Sprint, AT&T, BellSouth** and many others.

Represented **Signatures Network, Inc.** (a subsidiary of **Live Nation**) in drafting and negotiating Merchandising, Licensing, & Marketing Agreements, Publishing Agreements, Wireless Content and Ringtone Agreements, Official Website, Fan Club, Online Ticketing and Online Store Agreements, and Website Terms of Use and Privacy Policies for many of the world's best known, top recording artists (present and past), entertainment personalities, and television production companies.

>> Life Sciences/Biotech – Product Development, Supply and Distribution

We have advised clients on numerous transactions relating to the development, commercialization, sales and procurement of life sciences, biotech, and medical device products, including:

- Research and Development Agreements
- Product Development, Manufacturing and Supply Agreements
- Material Transfer Agreements
- Compound Manufacturing Agreements
- Patent and Technology Licenses
- University Licenses
- Clinical Trial and Commercialization Agreements
- Intellectual Property Transfer Agreements
- Joint Development and Strategic Alliance Agreements

Representative Transactions:

Cygnus Inc.: Negotiated a Patent License, Manufacturing and Supply Agreement with **DuPont** for thin film sensor materials used in Cygnus' GlucoWatch diabetes blood sugar monitoring device.

Chiron Corporation: negotiated collaboration agreements for licenses and access to technology for generating fully human monoclonal antibody therapies against cancer-specific antigen targets, with Chiron responsible for product development, manufacturing, and commercialization of any products developed through the collaboration programs.

Cardiovascular Devices, Inc.: negotiated development, manufacture and supply agreement with **Advanced Cardiovascular Systems, Inc./Guidant** for the manufacture, supply and commercialization of implantable stents used in cardiovascular surgery.

Axys Pharmaceutical: negotiated compound development and supply agreements for novel compound diversity libraries used in drug screening.

BioSpace, Inc.: Provided advice regarding development and administration of life science online information site, including software licenses and partnering agreements with **Eli Lilly, Abgenix, Xcyte** and others, as well as privacy advice.

ViaMD, Inc.: provided advice on privacy issues to medical device supply chain management services provider; negotiated hosting, license and supply agreements with medical device suppliers, customers and technology providers.

Emerge Healthcare: represented an online healthcare benefits platform provider in strategic alliances with several healthcare and benefits providers for an online benefits exchange platform.

Medunite Inc.: Represented a healthcare and health insurance electronic transaction service provider in outsourcing its data centers and application hosting services to EDS, including advice on HIPAA implications.

» Commercial Transactions – Strategic Alliances, Corporate Partnering and M&A

We have advised clients on numerous strategic alliance, joint venture, corporate partnering, M&A and related transactions, including:

- Letters of Intent/MOU
- Strategic Alliance and Co-Marketing Agreements
- Joint Development, Manufacturing, Supply and Marketing Agreements
- Cross-License Agreements
- Asset Purchase Agreements
- Transition Services Agreements
- Escrow Agreements
- Due Diligence (including Intellectual Property and contracts)
- Patent, Copyright, Trademark, Trade Secret and Technology Assignments
- Trademark Licenses

Representative Transactions:

Represented **Critical Path, Inc.** in its reorganization, recapitalization and merger with a group of existing investors, resulting in the cashing out of existing public common shareholders and taking the company private.

Represented **Critical Path, Inc.** in the sale of its hosted messaging business and intellectual property to Tucows Inc.

Represented **Critical Path, Inc.** in the sale of its Supernews hosted usenet service and intellectual property to Giganews Inc. and Supernews Inc.

Represented **Toysrus.com** in its strategic alliance and co-marketing agreement with Amazon.com for an exclusive, co-branded toy store "tab" on the Amazon.com website, and the transfer of the management and operation of Toysrus.com's entire online, e-commerce operations to the Amazon.com website.

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Represented multimedia software company **Scala, Inc.** in a strategic alliance and cross-license transaction with a **General Instrument** subsidiary involving GI's interactive television program guide technology.

Represented Digital River, Inc. in its acquisition of **Calico Commerce, Inc.**'s Market Maker™ multi-channel e-commerce business, including personnel, technology and clients. Structured the ongoing alliance between the parties, including negotiating a distribution and OEM licensing agreement that provided joint marketing, sales and business partnering arrangements for the combined hosted and packaged product offerings of each party and established **Calico** as **Digital River's** distribution channel in Japan for sales of the Market Maker product.

Served as US counsel, working with UK counsel to advise e-commerce company **John Lewis, PLC** on its acquisition of the UK operations, website and business of e-commerce portal **Buy.com**, including the negotiation of an asset purchase agreement, along with separate service, trademark and technology license and sublicense agreements.

Counseled **Epylon Corp.** on the sale of its B2B technology and business to **Accenture**, including the drafting and negotiation of various technology transfer and license agreements.

Virtual General Counsel – Policies, Compliance, Employment and Consulting Agreements

- Advising Management and Board on business and legal direction
- Board and Committee policies
- Advice on intellectual property protection, IP portfolio management, and online liability
- Employment Agreements
- Consulting Agreements
- PIAA (Proprietary Information and Assignment Agreements)
- Termination and Settlement Agreements
- Agency and Service Agreements