

# IP Transactions & Licensing

For many businesses, IP is their most valuable asset. As such, it is closely guarded and zealously enforced. But in today's competitive landscape, where collaboration is key and mergers are many, IP must be made available to others in order to survive and thrive. Cozen O'Connor works closely with inventors, owners, licensors, licensees, buyers, and sellers to both protect and leverage the value of owned or licensed IP to the greatest extent possible.

IP Transactions & Licensing is a multidisciplinary practice that benefits from Cozen O'Connor's combined knowledge of patent, trademark, copyright, trade secret, domain name, and data privacy and security law, as well as years of experience representing clients in a diverse range of industries, from blockchain to pharmaceuticals.

Our team also combines corporate and litigation capabilities. Attorneys successfully negotiate financially beneficial transactions alongside the firm's renowned M&A and tax counsel, while identifying areas of potential liability and designing creative solutions to mitigate risk.

## Licensing

Cozen O'Connor advises clients on the many nuanced issues applicable to IP licenses, from exclusivity to enforcement considerations, while keeping in mind each business's unique financial, structural, and corporate needs. Our attorneys handle straightforward license-for-income transactions, complex multi-party strategic agreements, co-brand and cross-license agreements, SaaS and PaaS agreements, and a host of other IP-sharing arrangements.

## Due Diligence

Cozen O'Connor offers industry-leading due diligence — thorough but efficient review of all traditional IP (trademarks, patents, copyrights, and trade secrets) as well as IP assets that are sometimes overlooked in corporate transactions (rights of publicity, data privacy and protection, open source software, and unrelated contracts that implicate IP). We review client and target IP and quickly isolate pertinent issues, make findings actionable, and guide clients and counterparts to effective solutions.

## Service Agreements & Collaborations

Done right, joint ventures, collaborations, and strategic alliances can generate new IP, expand market reach, and create new revenue streams. But healthy, mutually beneficial business partnerships are founded on well-designed agreements, continually serviced by counsel who understand the underlying IP and legal pitfalls. Cozen O'Connor routinely drafts and negotiates joint venture, strategic partnership, and co-development agreements; reseller, co-branding, sponsorship, and co-marketing arrangements; and other service agreements that promote strategic collaboration.

## Experience

Represented Orthofin, LLC, a company affiliated with Lincotek Group SpA (an Italy-based global leader in contract manufacturing services for the aerospace and medical businesses), in its acquisition of a majority stake in Riepen LLC and other assets constituting the Danco Medical business. This transaction drew on the experience of the firm's corporate, international, labor and employment, employee benefits and executive compensation, intellectual property, and environmental attorneys.

Represented Business Integration Partners (BIP), an Italian strategic consulting firm controlled by the CVC Capital Partners Fund VIII, in its purchase of a majority stake in Monticello Consulting Group,



**Ian R. Blum**  
Member

iblum@cozen.com  
Phone (212) 297-2679  
Fax (646) 588-1416



**Samuel A. Lewis**  
Co-Chair, Copyright Practice

slewis@cozen.com  
Phone (305) 397-0799  
Fax (305) 720-2271

## Related Practice Areas

- Copyright & Content
- Entertainment Law
- Franchising
- Hatch-Waxman & Biologics
- Intellectual Property
- Italy Practice
- Patents
- Trade Secrets, Restrictive Covenants, and Computer Abuse
- Trademark & Brand

a New York-based consultancy firm specializing in financial services consulting. The transaction drew on the experience of the firm's corporate, international, labor and employment, employee benefits and executive compensation, tax, and intellectual property attorneys.

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Represented the owners of HEYDUDE®, a privately-owned casual footwear brand founded in Italy, in connection with its sale to Crocs, Inc. for \$2.5 billion. The acquisition was funded by \$2.05 billion in cash and 2,852,280 shares issued to HEYDUDE's founder. The complexity and cross-border nature of the transaction required extensive collaboration with foreign counsel in Hong Kong, Italy, and other jurisdictions.

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Successfully represented Marquee Brands, LLC in connection with its multi-million dollar acquisition of Martha Stewart Omnimedia's intellectual property rights -- including patent, trademark and copyrights pertaining to Martha Stewart and Emeril Lagasse. The project involved data privacy issues and investigating extensive worldwide intellectual property rights and employee and contractor rights.

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Prevailed in an arbitration in which we represented a manufacturer of fire door systems that terminated an agreement under which it assisted a U.K. company in entering the U.S. market and became the exclusive licensee in the U.S for that company's products. The client terminated the agreement when the company was sold and the buyer engaged in conduct detrimental to the client, in breach of the agreement, including sharing its confidential information with a competitor. We overcame the claimant's demand for a declaration that it was not in breach of the agreement, and succeeded on a counterclaim for a declaration that the claimant was in breach and for damages.

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Assist Dansko in in negotiating transactions and performing IP due diligence in connection with various transactions.

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Handle the global IP portfolio and all copyright-related issues for The Wine Advocate. We also handle enforcement and assist in IP due diligence and contract negotiations and licensing.

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Successfully moved to dismiss a declaratory judgment action filed against our California-based client in federal court in New York by a New York company with which the client had entered into a licensing agreement. The plaintiff filed the action after our client raised concerns that the plaintiff had breached the agreement, pursuant to which the plaintiff was to market her knitting and weaving hand loom tools in craft stores in exchange for royalty payments. We successfully moved to dismiss for lack of personal jurisdiction and improper venue, overcoming the plaintiff's arguments that a New York choice of law provision and a license for the sale of the client's products nationwide established the requisite minimum contacts.

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Successfully represented Marquee Brands, LLC in connection with a substantial due diligence project culminating in its multi-million dollar acquisition of the outdoor sports and lifestyle brand Dakine, and all related intellectual property. The project involved investigating Dakine's extensive worldwide trademark and patent portfolio, third-party rights in Europe, employee and contractor intellectual property rights concerning copyright and patent issues in the United States and Europe, as well as data privacy issues.

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Handle Celgene's intellectual property matters on a global basis, including trademark, copyright, anti-counterfeiting, enforcements, customs litigation, and transactional matters.

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