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Intellectual Property in Cross-Border Transactions

What buyers & sellers need to know about intangible assets

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Basic Forms of Intellectual Property

- Copyrights
- Trademarks
- Patents
- Confidential information & Trade secrets

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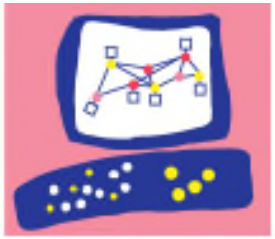
One Product:
Multiple Layers of Intellectual Property



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Why should (and do) buyers care about intellectual property?

– Peace of Mind

– Get Value for Purchase Price

– Reduce Risk

Image: Colin Kinner

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U.S. Patent Litigation Explosion

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IP Due Diligence – What to Expect

- IP assignments from all developers
- Licenses for all third party software
  - Including open source code
- Freedom to operate analysis (?)
- Supply chain agreements
  - Do upstream rights match your downstream promises?

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IP Due Diligence – Buyer Concerns

- Unlimited IP non-infringement warranties and indemnities to customers
- Risks of losing licensed-in IP
- Ability to enforce rights against infringers
- Assignment rights in licenses

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Questions?

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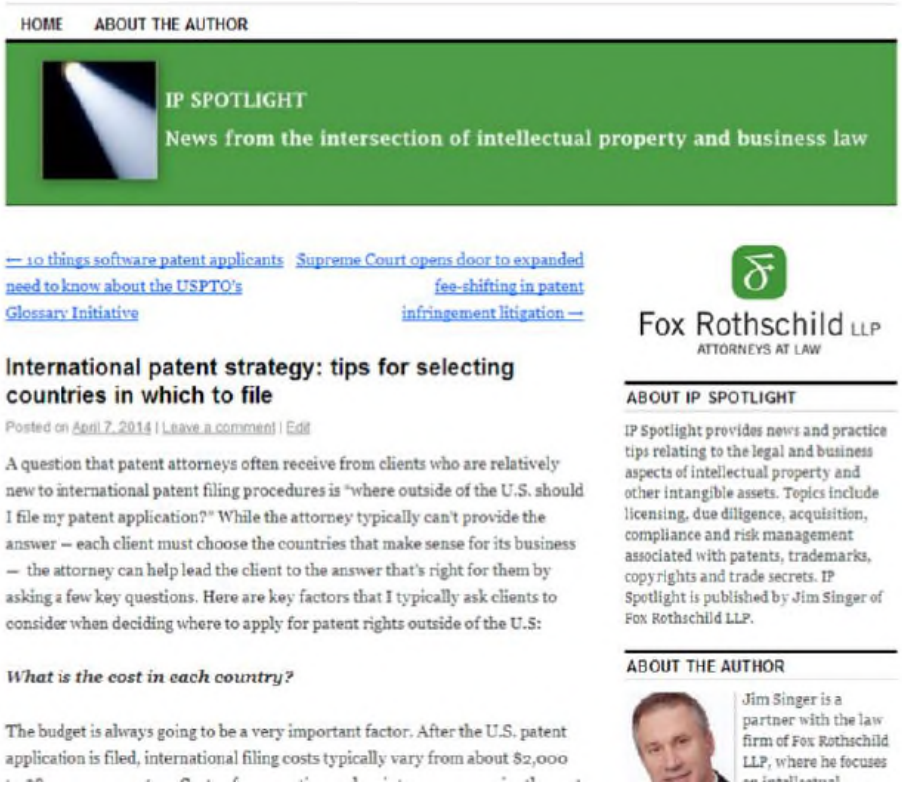

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News from the intersection of intellectual property and business law

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International patent strategy: tips for selecting countries in which to file

Posted on April 7, 2014 | Leave a comment | Edit

A question that patent attorneys often receive from clients who are relatively new to international patent filing procedures is "where outside of the U.S. should I file my patent application?" While the attorney typically can't provide the answer – each client must choose the countries that make sense for its business – the attorney can help lead the client to the answer that's right for them by asking a few key questions. Here are key factors that I typically ask clients to consider when deciding where to apply for patent rights outside of the U.S:

What is the cost in each country?

The budget is always going to be a very important factor. After the U.S. patent application is filed, international filing costs typically vary from about $2,000

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ABOUT IP SPOTLIGHT

IP Spotlight provides news and practice tips relating to the legal and business aspects of intellectual property and other intangible assets. Topics include licensing, due diligence, acquisition, compliance and risk management associated with patents, trademarks, copyrights and trade secrets. IP Spotlight is published by Jim Singer of Fox Rothschild LLP.

ABOUT THE AUTHOR

Jim Singer is a partner with the law firm of Fox Rothschild LLP, where he focuses

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