IP Considerations in M&A Transactions: Masters Class

How to Navigate IP Traps Commonly Missed by Corporate and M&A Generalists

ABA IP West Conference
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Panelists

Kandace Watson
**Corporate Partner, Sheppard Mullin**
Kandace Watson has extensive experience representing companies, corporate boards and executives in intellectual property (IP) intensive industries, including biomedical, biotechnology, chemical, healthcare, pharmaceutical, social media, software and technology. She was recommended in 2016 by Legal 500 US for Mergers & Acquisitions and Buyouts. She was named San Diego’s “Top Attorneys 2015” in the Corporate Transactional practice category presented by The Transcript. Corporate boards and management teams seek Ms. Watson’s legal and strategic advice to structure, negotiate and close complex transactions, comply with related SEC and other federal and state regulations, and expand operations globally. She frequently handles matters involving non-practicing entities (“NPEs” or “Patent Trolls”) and regularly leads transactions to successfully consummate patent purchase and license agreements.

Marty Lorenzo
**Vice President of Legal Affairs, Petco**
Marty Lorenzo brings over 28 years of experience derived from the legal, business and military fields. Marty is currently the Vice President of Legal Affairs at Petco Animal Supplies, Inc. He provides sophisticated strategic legal advice and counsel on a wide range of commercial matters. Prior to joining Petco, Marty was in private practice, most recently at Kilpatrick Townsend & Stockton LLP, where his practice focused on international business, corporate finance, and securities. He advised clients on a wide variety of business issues and strategic transactions, such as mergers and acquisitions, initial public offerings, capital formation, international expansion, technology licensing, and corporate governance.

Amit Kumar
**Associate General Counsel, adidas Golf and adidas Special Projects**
Amit Kumar is the primary lawyer for adidas’s worldwide golf business and he also supports adidas’s M&A team. Prior to joining adidas, Amit was Counsel at Kilpatrick Townsend, where he advised companies – in particular consumer product brands – on matters relating to technology transactions, mergers, strategic alliances, manufacturing, distribution, and advertising. Prior to joining Kilpatrick Townsend, Amit was the Vice President of Legal Affairs for TaylorMade-adidas Golf, where he represented the company in a variety of matters for over ten years.
NDA’s aka Non-Disclosure Agreements and Confidentiality Agreements

- Key Legal Terms (Non-Use and Non-Disclosure)
- What needs protection?
- Who needs protection?
- How long is protection needed?
- When should confidential information be shared?
- Where will confidential discussions occur?
- Practical tips
Getting in the Deal Early

- Is IP a key asset of the deal?
- Patents (e.g., Products & Technology)
- Trademarks (e.g., Brands)
- Copyrights (e.g., Software)
- Trade Secrets (e.g., Know-How)
- IP Representation & Warranty Insurance
IP Due Diligence

- Ownership
- Proprietary Invention Assignment Agreements (Employees, Contractors)
- Expiration Dates
- Freedom to Operate
- Competitive Landscape
- Product to Patent Claim – Cross Check
IP Battle Scars in M&A Transactions
Questions & Answers
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