Patent Due Diligence

Seasoned Team

Clients often ask Kilpatrick to handle patent diligence for acquisitions and investments even if our firm is not involved in other parts of the deal. Our Patent Due Diligence Team is often called upon because of our experience in nearly every area of technology, and our understanding of how the technology fits into the business goals of our clients. If a target is touting the strength of its patent position, our team is uniquely capable of evaluating such a claim. At the request of our clients, we have handled everything from a 1-10 rating of a patent portfolio to a comprehensive analysis of value vs. competitors and Freedom to Operate reviews.

Our Patent Due Diligence Team is comprised of highly experienced attorneys and technologists, who in turn, draw on the collective wisdom and knowledge of subject matter experts. We provide efficiency since there is rarely a learning curve for our attorneys who know the technology and industry. We use advanced software tools to assess the patent landscape. While the assessment of IP rights can sometimes be obscured by fundamental business obstacles, our team has the advantage of maintaining focus on the patent components of each transaction.

We understand that patent due diligence must go beyond simply checking off assignments and counting patents – over the course of each engagement we interview key company personnel to determine (1) which patents / applications are critical; (2) whether those patents map to actual planned products or abandoned dead-ends; and (3) the likelihood of patent issuance and claim scope based on cited prior art. We also provide recommendations to remedy issues before they threaten the completion of the deal or the business interests of the parties.

We also evaluate risks due to infringement letters received, competitor patents and products in the marketplace and when appropriate, perform Freedom to Operate studies. We know that companies often are not targeted until they receive significant funding and thus have the ability to scale our review as appropriate to the size of the investment. We provide practical recommendations to reduce risk, such as patent opinions to protect against treble damages, design changes and licenses, among other approaches.

We represent clients in every major industry, including for example bioinformatics, artificial intelligence, internet, software, electronics, healthcare and life sciences, telecom, financial institutions, business products and services, construction, building materials, textiles, defense, aerospace, semiconductors, and many others.

Experience

Below are representative engagements and types of transactions that our patent due diligence team regularly handles. Our work spans a wide range of industries – from biochemistry and life sciences to

software and aerospace. Due to the confidential nature of many of these transactions, client names are omitted.

We assisted one of the world's largest clinical laboratory networks in its acquisition of an international biotechnology laboratory. Our work included due diligence on the laboratory's oncology, virology, microfluidics, and reagent technology, and more than 200 related patents and applications. We also assisted with acquisition documents and post-closing transition of the intellectual property.

We represented **SunTrust Bank** in connection with multi-vendor, multi-tower IT outsourcing of its application development, production support and related information technology systems valued at approximately $200 million.

We drafted and structured numerous IP asset transactions for an international telecommunications company, including M&A deals; international strategic alliances; joint development agreements; and patent, brand, and technology license agreements.

We drafted and negotiated agreements for the global expansion and licensing of an international AI and autonomous technology company’s technology in other countries.

We served as lead IP counsel for a world leading telecommunications company in its acquisition of a publicly traded digital advertising company, a deal valued at over $1 billion.

We represented a venture capital firm in connection with an investment of over $20 million in a fabless semiconductor company developing ultralow power RF and baseband solutions for GPS and wireless markets.

We handled IP due diligence for multiple acquisitions by **Visa**, including CyberSource, Playspan, and Fundamo.

We handled patent diligence (portfolio evaluation and FTO) for an investor group in connection with multi-million dollar investments for European families.

We handled three deals for **LabCorp**, one with an extensive IP Estate (more than 200 patents and trademarks). Over the past 10 years, we have worked on well over 50 deals for LabCorp each with a significant IP component (in terms of the importance of technology or brand and/or size of the portfolio). Several years ago we assisted LabCorp in their close to $1 billion purchase of Genzyme Genetics, a deal that includes dozens of IP licenses and more than 1,000 individual patents/applications/trademarks that we successfully brought in and handled.

We handled several deals for **LabCorp** with large IP components including the acquisitions of Covance; Monogram Biosciences; Liposciences; Correlagen; Sequenom; Protedyne; and Bode Technologies.

We negotiated a complex joint development agreement for an international provider of high-resolution satellite imagery, data, and analysis with a global communications and information services company.

We negotiated and drafted development, contract research, and license agreements for a global agricultural sciences company with its leading competitor.

We drafted and negotiated a software license agreement between international telecommunications company and global measurement and data analytics company.

We have also served as patent due diligence counsel in deals with significant IP components for **Goodyear Aerospace (now Lockheed Martin)**; **GE Healthcare**; and **TransTech Pharma (VtV Therapeutics)**.

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