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IP Licensing

Steptoe and Johnson LLP has broad experience representing both licensors and licensees in all forms of licensing and contractual arrangements that transfer intellectual property rights, including patents, copyrights, mask works, trade secrets, know-how, trademarks, and unfair competition. These contractual arrangements reflect business transactions that often cut across the lines that separate the different categories of intellectual property.

Steptoe has represented clients needing assistance with licensing arrangements in fields as varied as scientific journals and databases, telecommunications technology, electronics, security software, flat-screen technology, and life sciences (gene therapy and gene expression in cancer research). We have advised software publishers, developers, integrators, distributors, computer and equipment manufacturers, service providers, and other companies including biotechnology and life sciences companies, as well as collaborative arrangements, joint ventures, associations, authors, and inventors on efforts to exploit intellectual property through forms of horizontal and/or vertical licensing arrangements.

Our life sciences practice focuses on facilitating collaborative arrangements between biotechnology and/or pharmaceutical companies for developing, acquiring, and exploiting biomedical assets. Our attorneys have extensive experience formulating corporate policy, as well as negotiating and drafting sponsored research agreements with federally funded organizations such as the National Institutes of Health.

We have also worked with clients to advance their interests in leveraging business resources to assist with manufacturing, market penetration (both geographic and segment), and distribution.

Representative Matters

Representative clients include the following:

- Foreign licensee licensing telecommunications software platform for a wireless communications system;
- Systems developer of complex software system created through a series of cross-licenses with various segments of an integrated e-mortgage closing, signing, and filing system;
- Owner of trade dress in utility vehicles in licensing such trademark-protected rights to third-party operator;
- Licensee of business method patent in field of interest calculation on credit cards;

IP Licensing

- Licensor of trademarks in merchandising arrangements with third parties;
- Developer/owner in a contract for third-party development of complex communications software for use in the transportation industry;
- Major software developer in its role as outsourcing provider for all annuity-related functions of a major software manufacturer;
- Licensor of patented tracking technology in licensing such technology in a particular geographic area and for a particular market segment;
- Licensee of patented technology useful in licensee's locator/tracking products and services;
- Medical research institute as licensee of a software tool from a third-party manufacturer in exchange for the institute's licensing its proprietary gene-expression database for such manufacturer's research activities;
- Licensee of software tools and know-how for use in medical research;
- Licensee of musical compositions for performance in a transportation system;
- Licensor of software program in drafting and negotiating agreement for overseas distribution;
- Developed "template" form licensing agreements for a worldwide program;
- Licensee of trademark docketing system software;
- Licensee of document retrieval and storage software; and
- Owner of trade secret technology and know-how in licensing program with third-party manufacturers.

Technology Licensing Representations

Step toe attorneys have drafted and negotiated a wide range of licenses for patented and unpatented technologies, as well as other types of technology transfers and high-tech service agreements, including standard form software license agreements for software vendors, international software distribution agreements, and software system acquisition agreements on behalf of users.

IP Licensing

Our attorneys have represented clients applying for licenses under patents administered by the National Technical Information Service and have negotiated cooperative research and development agreements (CRADAs), and related licenses of patented and unpatented technology, between private parties and the United States.

Our attorneys have also represented clients in drafting collateral agreements between private parties seeking to commercialize technologies obtained under CRADAs or federal patent licenses, and in arbitration proceedings with an industry association in which rights in patented power-generation technologies were disputed.

On the international front, the firm has represented both US and foreign parties in structuring complex joint venture or teaming agreements regarding high-tech projects, including US-Russian joint ventures to modify and distribute US nuclear power plant simulation technology, and to produce and distribute personal computers and software, as well as a US-Japanese joint venture to produce and market state-of-the-art film products.