

IP Transactions

Irell & Manella LLP is a leading law firm in national and international transactions involving information technology, telecommunications, computing, media, biotechnology and other advanced technologies, and the protection of intellectual property including patents, copyrights, trade secrets, trademarks, service marks and trade dress. The firm has handled transactions of the highest importance in these areas for industry leaders and entrepreneurs throughout the world for more than 35 years.

More recently, Irell & Manella took an early leading role in the emergence of business transactions on the internet and has actively represented clients in a wide variety of internet-related technology and trade transactions involving intellectual property since 1994.

In short, Irell & Manella's longstanding and unmatched expertise in intellectual property, technology and trade transactions makes the firm uniquely suited to assist clients in resolving the complex issues and problems that will arise as technology, communications, media and related industries continue to converge, and in achieving the maximum value from their business strategies.

Clients

The clients of the firm's intellectual property transactions practice group range in size from multinational Fortune 500 companies, to start-up and middle-market entities, to individuals with significant assets in venture capital or technology. They form a diverse roster of companies and individuals involved in every aspect of the computer, information technology, biotechnology, telecommunications, internet, media, entertainment and other industries. The intellectual property transactions practice group's most important clientele include the following:

- Creators and producers of digital and analog special effects for major motion picture studios and other entertainment formats;
- Developers and manufacturers of biotechnology and medical technologies;
- Developers, manufacturers and distributors of computer hardware, software and peripherals;
- Providers of telecommunications products and services;
- Providers of internet and other online services;
- Operators of internet search engines and portals;
- Owners and developers of databases and related software products;
- System operators and channels in the cable television industry;
- E-commerce companies;

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- Developers and providers of gaming and gambling technology; and
- Investors and financiers.

Distinctions between industries, technologies and practice groups invariably blur the realities of the business world. Therefore, in addition to these clients the intellectual property transactions practice group often represents companies from more traditional industries, such as retail establishments and real estate developers, in connection with specific transactions involving technology, communications, entertainment and the internet, including technology procurement, outsourcing transactions and e-commerce strategies.

Attorneys

The attorneys of the intellectual property transactions practice group have a wealth of expertise and enjoy an international reputation in the core intellectual property and related legal disciplines which underlie technology and trade protection issues in technological, communications, entertainment, internet and related industries. These disciplines and issues include patents, copyrights, trade and service marks, trade and service dress, trade secrets, rights of publicity and privacy, unfair competition and antitrust. This extensive and widely recognized expertise affords the practice group a fundamental understanding of the technologies, products and processes of its clients and a broad and deep knowledge of the industries and markets in which they operate. As a result, the practice group provides a significant competitive advantage to its clients over most other law firms in the world and can structure, negotiate and implement innovative and carefully tailored transactions that achieve the maximum benefit for its clients.

Attorneys in the intellectual property transactions practice group who have been recognized for their achievements in the technology and trade fields include the following:

- Attorneys with technical degrees and extensive work experience in diverse technologies including computer science; cellular and molecular biology; and chemical, electrical and mechanical engineering;
- Members or former members of the faculties of leading law schools;
- A past president of the Computer Law Association and past co-chairman of Committee R (International Technology and E-Commerce Law) of the International Bar Association's Section on Business Law, co-author of the first full-length legal text on data processing contracts, and co-author of a two-volume treatise on the legal and management aspects of computer technology, *Bernacchi on Computer Law*;
- The current author of the leading treatise on copyright law, *Nimmer on Copyright*;
- The author of a major treatise on intellectual property issues in media productions, *Media Law for Producers*;

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- Attorneys listed in the *Best Lawyers of America*;
- Chambers and Partners legal publishers selected Irell & Manella as the 2005 "U.S. Intellectual Property Law Firm of the Year." Based on over 3,000 client interviews, Chambers and Partners recognize that Irell & Manella's "IP groups continue to stand head and shoulders above the competition" and that the firm is "highly regarded for its transactional expertise" in "high tech" and related sectors;
- An attorney named "Intellectual Property Lawyer of the Year" by the Century City Bar Association; and
- Regular lecturers and authors on the law of intellectual property, technology and related issues.

The intellectual property transactions practice group's client counseling services are fully supported and complemented by the capabilities and expertise of Irell & Manella's other talented practice groups, which provide full capabilities in all major pertinent areas of legal expertise, including transactional and securities law, venture capital financings, banking and finance, labor and employment issues, taxation, executive compensation, commercial law matters and litigation. The firm's litigation group is particularly known for its excellence in intellectual property cases, and has extensive litigation and arbitration experience in complex intellectual property disputes involving the entertainment, computer, internet and biotechnology industries.

Complex Technology and Biotechnology Transactions

The intellectual property transactions practice group handles the structuring, negotiation and documentation of complex transactions relating to the computer, information technology, biotechnology and other industries, including the following:

- Technology and software development agreements, including joint and multiparty development arrangements;
- Technology and biotechnology procurement transactions;
- Joint marketing agreements;
- Licensing transactions, including software and patent licensing;
- Distribution and reseller transactions, including OEM and VAR agreements;
- Outsourcing and data processing arrangements;
- Joint ventures and strategic alliances (see *infra*);
- Systems integration;
- Testing, maintenance and support agreements;

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- Open source arrangements and standards-setting bodies; and
- Computer-game development and publishing deal.

Joint Ventures and Strategic Alliances

The intellectual property transactions practice group is especially known for its expertise in structuring, negotiating and documenting complex, multi-party joint ventures and strategic alliance transactions involving technology, content and the internet. These transactions are often intertwined with issues that implicate other major practice areas in the firm, such as tax, corporate and antitrust law. Because of the practice group's extensive background and experience in the technology, entertainment, communications, internet and related industries, and the superb full-service counseling support immediately available from other practice groups to assist with such transactions, the practice group is uniquely situated to counsel clients regarding the complex issues involved in these sophisticated and innovative arrangements.

Patents

Irell & Manella's patent prosecution and counseling attorneys are experienced, technologically diverse and well-rounded. The intellectual property transactions practice group has prepared and prosecuted numerous patent applications in technological areas spanning turbines, electronics, computers, bioscience, mechanical arts, chemistry and aural and visual special effects. The firm's leading intellectual property litigation practice helps the practice group's patent prosecutors anticipate cutting-edge developments in patent law and maximize the strength of its clients' intellectual property portfolios.

The intellectual property transactions practice group provides the following services in the areas of patents concerning high technology, biotechnology and other areas of invention:

- Patent prosecution before the United States Patent and Trademark Office, and national, international and regional patent authorities worldwide;
- Specialized patent proceedings such as reexaminations, reissues, interferences and foreign opposition proceedings;
- Patent review and analysis;
- Prior art searches to determine patentability and freedom to operate within fields of invention;
- Management and strategic development of international patent portfolios to maximize their strength, scope and cost-effectiveness; and
- Patent and other intellectual property protection strategy and counseling. _ _

Trademarks

The intellectual property transactions practice group provides the following services related to

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trademarks, service marks, trade dress and other trade and branding protections nationally and globally:

- Strategic counseling in the selection of trademarks, including analyzing use and registration availability in the U.S. and abroad to optimize selection of protectible marks;
- Counseling in the use of trademarks in special industries, including motion pictures and other First Amendment works;
- Obtaining registrations for trademarks (including trade dress and product configurations) in the U.S. Patent and Trademark Office, including appeals to the U.S. Patent and Trademark Office Trademark Trial and Appeal Board;
- Maintaining and renewing registrations;
- Counseling and reviewing the client's trademark portfolio to maintain and enhance registration protection rights on a global basis;
- Negotiating and drafting trademark licenses, including merchandising and other licenses, as licensor or licensee; counseling and implementing assignments of trademarks and recording assignments;
- Performing securitization of trademarks;
- Managing the trademark asset in bankruptcy proceedings;
- Performing trademark due diligence analysis in connection with acquisition of or liens of trademark assets;
- Evaluating client's web sites and advertising to enhance effective trademark use;
- Counseling with respect to false advertising under the Lanham (Trademark) Act;
- Counseling with respect to domain names, metatags and other trademark issues in an internet setting; and
- Working with an established network of foreign trademark counsel in virtually every foreign country to clear and register trademarks abroad, including appeals, to bring and defend foreign trademark Oppositions and Expungement Actions, and to coordinate and enhance international trademark portfolios and optimize global brand expansion.

Telecommunications

The intellectual property transactions practice group handles numerous complex transactional matters in the telecommunications industry, as illustrated by the following:

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- Negotiation and documentation of agreements for construction and operation of networks and telecommunications infrastructures for voice, video and data communications in commercial and residential real estate developments;
- Leases for deployment of fiber-optic cable;
- Satellite acquisitions and transponder leasing; and
- Agreements for the deployment, management and operation of communications towers and equipment.

Internet Transactions

The intellectual property transactions practice group handles the most complex and sophisticated transactional matters relating to internet business, marketing and content creation. The firm's past and ongoing transactions in this area include the following:

- Linking deals;
- Co-branding/cross-marketing arrangements;
- Website development agreements;
- Hosting arrangements;
- Website review, counseling and clearance;
- Content and technology licensing and syndication;
- Distribution deals (including branded "channel," anchor tenant and similar deals);
- E-commerce transactions;
- Joint ventures and strategic alliances (see *supra*);
- Regulatory matters (including matters relating to advertising, contests, privacy and related issues); and
- Protection of brands from cyberpiracy.

Emerging-Stage Company Practice

As a result of its prominence in counseling the technology and internet industries, Irell & Manella represents many start-up and emerging-stage companies in these fields. In addition to the other matters described herein, the intellectual property transactions practice group and the firm provide a full range of pertinent legal services for such clients, including transactional matters such as the following:

- Company organization, formation and structuring;

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- Seed and venture capital financing transactions;
- Stock option and incentive plans;
- Public offerings;
- Mergers and acquisitions;
- Advisory board and board of directors issues;
- Executive compensation;
- Employment issues; and
- Consulting and independent contractor agreements.

Intellectual Property Audits and Due Diligence

In addition to the matters described above, the practice group also performs the following intellectual property counseling services for clients:

- Intellectual property audits;
- Structuring of proprietary rights programs, including analyzing proprietary ideas and products to determine the most desirable form of protection (patent, trade secret, copyright and trademark); designing confidentiality and security procedures; developing employee and confidentiality agreements; and obtaining U.S. and foreign patents, trademarks and copyrights; and
- Review and analysis of intellectual property portfolios in connection with potential investments, financings or acquisitions.

Representative Clients and Matters

The following represents a cross-section of clients and matters for which the intellectual property transactions practice group has played a central or exclusive role:

AT&T Corp. – Irell & Manella represented this client in connection with the creation of a joint venture with Matsushita and other leading companies to develop a system for the digital distribution and sale of various types of content over the internet.

Paul G. Allen and Vulcan Ventures – Exemplifying the firm's capabilities in representing individuals' significant venture capital investments in sophisticated technology fields, Irell & Manella represented Microsoft co-founder and investor Paul G. Allen and his venture capital fund in connection with his investments in technology, internet and communications companies, including Go2Net, Ticketmaster, DreamWorks SKG, Starwave, Charter Communications, Marcus Cable, High Speed Access Corp. and Oxygen Media.

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Alta Vista – Irell & Manella represented this client, now a business of Overture Services, Inc., in connection with the development and commercialization of a leading internet search engine, and has also provided counsel on patent matters.

Broadcom Corp. – Irell & Manella represents this leading supplier of cable modem and set-top-box chips in numerous licensing, development and outsourcing agreements; mergers and acquisitions; and other intellectual property and corporate matters.

CarsDirect.com, Inc. – Irell & Manella has represented this market leader in car sales over the internet in connection with a wide variety of licensing, trademark and domain name, intellectual property and corporate matters.

Charter Communications Inc. – Irell & Manella represented Charter Communications in connection with a wide variety of technology transactions, including a major outsourcing transaction involving hardware and software acquisition and management functions for a complex system that will provide consumers and businesses with broadband internet access through the cable infrastructure, and a strategic licensing arrangement covering a new operating system being developed by Microsoft Corporation for use in cable set-top boxes.

Clarity Partners and OpNext, Inc. – Irell & Manella represented Clarity Partners, L.P. in its \$321 million investment, together with the Japan-based trading house Marubeni Group, in OpNext, Inc. (formerly Hitachi Ltd.'s Telecommunications Infrastructure Systems Group). Clarity Partners is a private equity investment firm based in Beverly Hills, California that invests exclusively in communications, media and related technology companies. Irell & Manella also represented OpNext in its acquisition of Hitachi's Opto-Device Division of Semiconductor and Integrated Circuits, which designs, manufactures and sells devices and modules for the access communication, fiber-optic backbone and metro markets, in addition to the information and industrial markets. OpNext is a global leader in high performance optical networking components, including high power lasers, laser diode modules, transmitters and receivers, XENPAK modules, optical transceivers and optical transponders.

Classic Media LLC – Irell & Manella represented this company in connection with the acquisition of various film and television libraries.

Elan Corporation – Irell & Manella has represented this Ireland-based pharmaceutical company in connection with a variety of intellectual property transactional matters.

Future Media Productions, Inc. – Irell & Manella has represented this manufacturer of DVDs and CD-ROMs in obtaining key licenses to underlying DVD and CD-ROM patents and technologies from an international consortium consisting of major technology companies such as Matsushita, Philips Electronics, Sony and Toshiba.

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Intuit Inc. – Irell & Manella has represented Intuit in connection with a transaction involving the joint development of web-based human resources services, including payroll processing, COBRA administration, unemployment claims processing and a variety of other administrative and processing services to be made available to businesses online, as well as a strategic alliance to make available through Intuit's website certain insurance policies and services.

Lucasfilm Ltd. – Irell & Manella has worked with Lucas Digital, a Lucasfilm subsidiary, to help this film special effects provider identify and patent techniques used in the complex animation effects seen in some of the world's most popular movies.

Mattel Inc. – Irell & Manella has represented Mattel in connection with various intellectual property matters, including serving as Mattel's intellectual property counsel in connection with its high-profile sale of The Learning Company.

Metro-Goldwyn-Mayer Inc. – Irell & Manella represents this major motion picture studio in connection with rights acquisition, product placement, marketing agreements, traditional and online co-promotions, contests and sweepstakes and other related matters relating to the production, distribution, marketing and promotion of the studio's motion picture releases.

MTV Networks – Irell & Manella represents this cable-television network and related networks such as Nickelodeon in connection with rights and programming acquisitions, co-productions and cross-border licensing transactions.

Newhall Land and Farming Co. – This company is a large public company that owns huge tracts of land throughout California and is a major developer of master-planned residential and business communities throughout the state. Irell & Manella represented this client in connection with all phases of a complex arrangement with Pacific Bell in which Pacific Bell will install, operate and maintain a state-of-the-art telecommunications infrastructure and network for voice, data and video communications in a major new development consisting of 40,000 residences and numerous commercial facilities.

Sierra Monolithics – Irell & Manella represented this developer of state-of-the-art microwave communications systems and ultrahigh-speed integrated circuits in a complex transaction with IBM in which Sierra Monolithics would design and develop products for IBM and license to IBM this and other technology.

Stamps.com Inc. – Irell & Manella has represented this e-commerce client in connection with the development and commercialization of a system for selling stamps over the internet, including representation of the company in critical patent matters and litigation.

Starbright Foundation – As part of our pro bono commitment, Irell & Manella represented the Starbright Foundation, a nonprofit organization chaired by producer Steven Spielberg, in negotiating and documenting all of the transactions necessary to create and maintain the Starbright World Network, a

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broadband computer network linking chronically ill children throughout the nation in a virtual play world with real-time multipoint audio-video conferencing.

Technicolor Inc. – Irell & Manella represents Technicolor, Inc. in a variety of real estate, corporate and intellectual property matters, including providing advice and structuring transactions in connection with Technicolor’s digital cinema business, Technicolor Digital Cinema LLC. Technicolor Digital Cinema provides a complete range of end-to-end digital cinema distribution technology and support services, including on-site distribution, full-scale system installations, digital uploading to projection systems and theater site testing and verification.

Texas Instruments Inc. – Irell & Manella counseled Texas Instruments in connection with its initiative to develop and standardize an enhanced digital projection technology for motion picture cinemas, further counseling Texas Instruments on the risks as well as benefits on which to advise potential investors in seeking development funding.

THX Ltd. – Irell & Manella represents this premier sound technology company in connection with a variety of patent and related intellectual property transactional matters.

Time Warner Inc. – Irell & Manella represented America Online, Inc. in establishing a joint venture in Japan with the Mitsui and Nikkei companies to create a Japanese version of America Online’s commercial online service, as well as a joint venture in Latin America with the Cisneros Group for a version of this service for countries in Latin America. Irell & Manella advised AOL during negotiations for its merger with Time Warner to form AOL/Time Warner. Irell & Manella has also advised Time Warner with respect to the incorporation of new technologies, such as wireless internet access, into its core services.

Western Digital Corp. – Irell & Manella represents this leading information storage management company in its maintenance of strong protection of its worldwide trademarks.

For more information, please contact Matthew Sant.