

McDermott
Will & Emery

Intellectual Property

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European Intellectual Property, Media and Technology

WHAT OUR CLIENTS AND PEERS SAY

- “This team is doing very well and punches well above its weight”.
— *Chambers UK* 2011
- Rohan Massey is “approachable, knowledgeable”. — *Chambers UK* 2010
- Boris Uphoff “provides excellent advice”.
— *European Legal 500* 2010
- Wolfgang von Frentz, is described by peers as “an expert who knows what he’s doing”. — *Chambers Europe* 2010
- Hiroshi Sheraton is recommended for Patent Litigation in the UK and Ralf Weisser for Media in Germany.
— *PLC Which Lawyer?* 2010
- Clients praise the “quality and timeliness” of McDermott Will & Emery UK LLP’s “superb” team. — *Legal 500 UK* 2011
- *Chambers Global* 2009 ranks our IP practice in Tier 1.
- “The lawyers are responsive and give clear-cut solutions. It was a joy working with them.” — *Chambers Europe* 2011 (Germany — TMT)
- Our German telecom, media & technology practice provides “cutting-edge advice and solutions [that] perfectly match our needs”.
— *Chambers Europe* 2009
- The Italian Intellectual Property practice is ranked by *Chambers Europe* 2009 and *European Legal 500* 2010. Francesco Mattina is mentioned in *Chambers Global* 2011 as “a name to note in Rome”. *European Legal 500* 2011 describes him as “outstanding”.

Our European Intellectual Property, Media and Technology (IPMT) Group in Brussels, London, Munich, Paris and Rome consists of more than 20 professionals.

We offer an integrated service across all areas of intellectual property (IP) media and technology, including patents, trade marks, copyrights, designs, trade secrets, data protection, privacy and media (contentious/non-contentious). We have a strong industry focus with clients in sectors such as health care and life sciences, information technology, food and beverage, manufacturing, media, sports and entertainment. As the IPMT field is increasingly impacted by other legal disciplines such as competition, tax, regulatory, employment and finance, we regularly work alongside those departments with a view of better servicing our clients.

OUR CAPABILITIES

Our European IPMT lawyers are recognised leaders in their particular fields, which cover all aspects of IP, including patents, trade marks, copyrights, designs, trade secrets, data protection, privacy and media. Our experience is broad because our clients are diverse, ranging from *Fortune* 500, FTSE and DAX 100 companies to private companies, academic institutions and trade associations. These clients cover a wide breadth of businesses, from cutting-edge, high-technology industries such as semiconductors, biotechnology, life sciences, software, electronics, chemical and pharmaceutical, to established industries such as manufacturing, food, beverage, machine tool, transportation, entertainment, recreation, advertising, marketing and management consulting. Most importantly, we have the professional skills and local knowledge to undertake that diverse range of work.

Disputes

Our disputes work includes cases before national courts (at first instance and appeal level), the European Court of Justice and before national and regional patent offices such as the European Patent Office and OHIM.

We regularly handle patent litigation that involves multiple parallel jurisdictions across Europe and we are well versed in co-ordinating and formulating strategies that take account of different approaches and procedures throughout Europe.

European Intellectual Property, Media and Technology



Many of our lawyers have scientific degrees or doctorates, which allow us to advise on the most complex of technologies, whether in the electronics, software or life sciences industries. We have extensive experience in the interface of such matters with European regulatory and competition laws, particularly in the electronics and pharmaceutical industries.

Our trade mark litigation experience includes working for household brand names in litigation and enforcement matters. We conduct cases before the national courts and also work with trading standards and customs authorities on enforcement matters. Many of our matters have involved complex and rapidly developing areas of the law, such as the extended protection of well-known marks, use of AdWords and issues of international jurisdiction. We integrate our approach to litigation and enforcement with our trade mark prosecution and portfolio management service. In this way, we can truly understand the brands we are protecting.

Our lawyers also regularly handle disputes concerning trade secrets, commercialisation of technology, licensing and other issues usually involving technology or exploitation of IP rights. We have significant experience in conducting arbitrations of this type of dispute under various rules of procedure.

Commercialisation and Transactions

Our commercialisation and transactions practice has significant experience dealing with IP and media rights using a variety of legal mechanisms, whether by licensing, acquisition or divestment, via distribution agreements or involving more complex and creative arrangements. Our lawyers have the experience and knowledge to draft and negotiate complex contractual arrangements across a range of industries and jurisdictions, taking account of European competition laws. We have particular experience in dealing with software and brand licensing and in tax-efficient structuring of IP portfolios.

Our IPMT lawyers have such wide-ranging experience, we often conduct stand-alone due diligence projects in relation to transactions or investments that are heavily dependent on technology or brands and perform the same type of IP audit for our clients' own IP.

Our European practice also has significant experience advising clients on advertising, e-commerce, data protection and privacy issues, often on a Europe-wide basis, and on issues at the forefront of developing legislation and regulation.

IP Portfolio Management

We have a dedicated European trade mark and design prosecution and portfolio management capability. We regularly advise clients on a European and/or global basis on trade mark and design filing strategies, and are able to file, prosecute and defend applications in the national registries or at the European Registry (OHIM). Our experienced professionals regularly conduct opposition procedures before those registries, enabling us to provide seamless service on the enforcement and defence of our clients' brands.



European Intellectual Property, Media and Technology

OUR APPROACH

Cross-Discipline

The IPMT field is increasingly impacted by other legal disciplines, whether in competition, tax, regulatory, employment or finance law. We are able to draw on our extensive mergers and acquisitions experience across the United States, Europe and Asia in legal fields in which we are recognised as leaders.

Industry Specific

Many issues that we deal with are increasingly industry specific. Professionals in the European IPMT practice are members of cross-discipline groups focussing on life sciences, energy, electronics, e-commerce and data privacy. This allows us to see the wider picture affecting particular industries and to provide tailored advice suited to our clients' business. We pride ourselves on knowing our clients and their business.

Cutting Edge

Much of the work we do is truly at the forefront of legal, commercial and technical developments. For example, we are undertaking such work in the fields of supplementary protection certificates, cloud computing and implications of tax developments on IP rights. By staying ahead of the game, we can quickly provide up-to-the-minute advice to our clients.

Global Perspective

Almost all of the issues facing IPMT are international and many of the matters on which we work are truly global in their nature. With lawyers in 16 offices worldwide and a strategic alliance with MWE China Law Offices in Shanghai, McDermott's European IP practice is truly international in its scope.

However, we understand that while IP may be "harmonised" across Europe, it is not the same in every country. Cultural differences are still important, the court systems vary and enforcement is not the same. Our diverse resources enable us to work seamlessly across Europe to meet the individual needs of our clients in the countries that are relevant to them. We regularly conduct and co-ordinate litigation, transactions and strategic advice on a pan-European and/or global level. Where we do not have offices, we have the experience and contacts to select and work with the best local counsel for our client and the project.

Our global reach and extensive skills enable us to offer truly integrated service.

Representative German Experience



- Advising **Deutsche Telekom AG** and **T-Online France** in connection with movie licensing agreements with major US film studios for the offering of video-on-demand as well as electronic sell-through
- Advising **Deutsche Telekom AG** in connection with several IT-related licensing and litigation projects
- Advising **Gorenje d.o.o.**, a Slovenian manufacturer of domestic appliances, in several patent infringement cases
- Representing **RTL Group** in copyright, trade marks and unfair competition in connection with its television program broadcasts pending before the Court of Venice.
- Advising **RTL Group** on gambling law in connection with its interactive services.
- Advising **Intergraph Corporation** on day-to-day IP matters
- Advising **Kraft Foods Deutschland GmbH** on contentious and non-contentious IP matters (competition law, trade mark law, etc.)
- Advising **Max-Planck-Gesellschaft** in connection with the formation of a Max Planck Institute in West Palm Beach, Florida, including the drafting of an IP policy for securing and exploiting Max Planck's IP ensuing from its research work
- Advising **RTL Group (RTL Television, RTL II and Vox)** in litigation against shift.tv, an online video recorder
- Advising **Recticel SA**, an automotive supplier from Brussels, Belgium, on day-to-day IP matters
- Advising **TomTom International B.V.** on several disputes of industrial property rights, including illegal downloads of navigation software
- Advising a consulting firm on negotiating licensing agreements with a major German bank and drafting the licensing agreement for a special training programme
- Advising a German IT group on negotiations for a cooperation agreement with a US credit card company, advising on issues regarding a general public licence and negotiating a SmartCard development agreement with a Scandinavian partner
- Drafting of all German standard contracts for the German subsidiary of a US software company, including software licence and service agreements, professional services agreements, non-disclosure agreements and consulting partner agreements
- Advising a German IT group on the negotiations for a cooperation agreement with a US credit card company, advising on issues regarding a general public licence and negotiating a SmartCard development agreement with a Scandinavian partner
- Advising a US software company on web applications software, the customisation of licensing agreements for the German market and negotiations with a major German bank
- Advising a Luxembourg bank on an action against a trade mark pirate who had registered the bank's commonly used abbreviation as a trade mark in Germany, then blackmailed the company to pay a licence fee
- Advising a cable operator in litigation in the first German trial before the Schiedsstelle beim Deutschen Patent- und Markenamt (copyright arbitration panel) regarding a cable distribution contract dispute
- Advising a leading solar cell manufacturer in a patent litigation matter pending with the District Court Düsseldorf

Representative United Kingdom Experience



- Advising thetrainline.com on the internationalisation of their e-commerce business
- Representing online gaming company **32 Red plc** in brand protection issues, including High Court litigation against William Hill
- Representing **Amgen** in patent litigation
- Representing **CIBA Vision** in patent litigation against Johnson & Johnson concerning extended wear contact lenses in the UK High Court and Court of Appeal and assisting in the co-ordination of global litigation in the US, Europe and Asia
- Representing **Document Security Systems** in co-ordinating patent litigation against the European Central Bank in 10 European jurisdictions concerning anti-forgery technology
- Representing **Novartis Vaccines & Diagnostics** in litigation matters against GlaxoSmithKline Biologicals S.A. and SmithKline Beecham Plc regarding numerous vaccines
- Representing **Porton Capital** in a High Court dispute concerning commercialisation of technology
- Representing **SanDisk** in patent and antitrust litigation relating to MP3 standards
- Advising **Visto Corporation** in patent litigation in relation to RIM's BlackBerry system
- Advising **The Absolut Company**, owners of the ABSOLUT brand, on brand protection matters including UK High Court litigation
- Advising a major global information services provider on the restructuring and development of its global brand
- Advising an international electronics manufacturer on tax-efficient structuring of its IP portfolio
- Advising several global pharmaceutical companies on IP aspects of due diligence on potential acquisitions
- Advising a major financial institution on IP aspects of due diligence in a biotech investment
- Advising several well known consumer goods manufacturers on brand protection issues
- Advising a major online retailer on e-commerce issues throughout Europe
- Advising a leading online gaming company in the securitisation of its IP assets
- Drafting standard software licensing and software services agreements and standard statements of work for a US software group
- Advising a major international research centre on the corporate establishment and IP holding structure for innovative clinical trials to be undertaken in the United Kingdom
- Advising leading technology provider on control issues and consumer protection issues in the online games sector
- Advising a large multinational fruit producer on its global data protection strategy
- Drafting policies for international data transfer for large US/UK health insurance provider
- Advising global investment bank on consumer and regulatory data privacy issues
- Advising leading knowledge service provider on structure of IP holding to protect IP and enhance commercial value

Contact Us

GERMANY



BORIS UPHOFF
+49 89 12712 0
buphoff@mwe.com



RALF WEISSER
+49 89 12712 0
rweisser@mwe.com



**WOLFGANG FREIHERR
RAITZ VON FRENZT**
+49 89 12712 0
wfrenzt@mwe.com



CHRISTIAN MASCH
+49 89 12712 0
cmasch@mwe.com



VINCENT SCHRÖDER
+49 89 12712 0
vschroeder@mwe.com



ALEXANDER HARGUTH
+49 89 12712 0
aharguth@mwe.com

UNITED KINGDOM



ROHAN MASSEY
+44 20 7575 0329
rmassey@mwe.com



HIROSHI SHERATON
+44 20 7575 0324
hsheraton@mwe.com

Office Locations

BOSTON

28 State Street
Boston, MA 02109
USA
Tel: +1 617 535 4000
Fax: +1 617 535 3800

BRUSSELS

Avenue des Nerviens 9 - 31
1040 Brussels
Belgium
Tel: +32 2 230 50 59
Fax: +32 2 230 57 13

CHICAGO

227 West Monroe Street
Chicago, IL 60606
USA
Tel: +1 312 372 2000
Fax: +1 312 984 7700

DÜSSELDORF

Stadttor 1
40219 Düsseldorf
Germany
Tel: +49 211 30211 0
Fax: +49 211 30211 555

HOUSTON

1000 Louisiana Street,
Suite 3900
Houston, TX 77002
USA
Tel: +1 713 653 1700
Fax: +1 713 739 7592

LONDON

Heron Tower
110 Bishopsgate
London
EC2N 4AY
Tel: +44 20 7577 6900
Fax: +44 20 7577 6950

LOS ANGELES

2049 Century Park East,
38th Floor
Los Angeles, CA 90067
USA
Tel: +1 310 277 4110
Fax: +1 310 277 4730

MIAMI

333 Avenue of the Americas
Suite 4500
Miami, FL 33131
USA
Tel: +1 305 358 3500
Fax: +1 305 347 6500

MILAN

Via dei Bossi, 4/6
20121 Milan
Italy
Tel: +39 02 78627300
Fax: +39 02 78627333

MUNICH

Nymphenburger Str. 3
80335 Munich
Germany
Tel: +49 89 12712 0
Fax: +49 89 12712 111

NEW YORK

340 Madison Avenue
New York, NY 10173
USA
Tel: +1 212 547 5400
Fax: +1 212 547 5444

ORANGE COUNTY

4 Park Plaza
Suite 1700
Irvine, CA 92614
USA
Tel: +1 949 851 0633
Fax: +1 949 851 9348

PARIS

23 rue de l'Université
75007 Paris
France
Tel: +33 1 81 69 15 00
Fax: +33 1 81 69 15 15

ROME

Via A. Ristori, 38
00197 Rome
Italy
Tel: +39 06 462024 1
Fax: +39 06 489062 85

SHANGHAI

MWE China Law Offices
Strategic alliance with
McDermott Will & Emery
28th Floor Jin Mao Building
88 Century Boulevard
Shanghai Pudong New Area
P.R.China 200121
Tel: +86 21 6105 0500
Fax: +86 21 6105 0501

SILICON VALLEY

275 Middlefield Road,
Suite 100
Menlo Park, CA 94025
USA
Tel: +1 650 815 7400
Fax: +1 650 815 7401

WASHINGTON, D.C.

600 Thirteenth Street, N.W.
Washington, D.C. 20005
USA
Tel: +1 202 756 8000
Fax: +1 202 756 8087

Boston Brussels Chicago Düsseldorf Houston London Los Angeles Miami Milan Munich New York Orange County Paris Rome Silicon Valley Washington, D.C.
Strategic alliance with MWE China Law Offices (Shanghai)

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The following legal entities are collectively referred to as "McDermott Will & Emery," "McDermott" or "the Firm": McDermott Will & Emery LLP, McDermott Will & Emery AARPI, McDermott Will & Emery Belgium LLP, McDermott Will & Emery Rechtsanwálte Steuerberater LLP, MWE Steuerberatungsgesellschaft mbH, McDermott Will & Emery Studio Legale Associato and McDermott Will & Emery UK LLP. These entities coordinate their activities through service agreements. McDermott has a strategic alliance with MWE China Law Offices, a separate law firm.



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