

Leaders in licensing

Four months of research undertaken by IAM has found that when it comes to the provision of top-class licensing advice, certain law firms are mentioned time and time again

By Alastair Mitchell

IAM believes that in large part the quality of a law firm offering services in IP is determined by the quality of the individuals who work there. In the recently published *IAM Licensing 250* we have identified the market's leading licensing experts. However, during the course of our research, a group of firms emerged as the "go-to" practices that are instructed to work on the most valuable and most challenging deals in their respective marketplaces. Their names cropped up time and again, and so we have decided to list them on the following pages.

The firms featured tend to house the largest groups of licensing practitioners and are, with few exceptions, multi-site practices that belong to major international networks. This has emerged as a crucial aspect of leading regional firms' capabilities, as clients are keen to instruct "one-stop shops" on complex cross-border arrangements. In Australia and Canada, global reach takes a back seat to local market expertise for both domestic and international clients. Worldwide, the picture is dominated by firms from the United States and the United Kingdom – the only markets that have so far successfully exported high-end legal services around the world.

Asia

With offices in Beijing, Hong Kong, Shanghai and Singapore, **Bird & Bird** maintains a

strong presence across the region, bolstered by its strategic alliance (for contentious work) with Chinese mainland IP boutique Xiang Kun Law Firm. The firm's licensing practice undertakes a range of work for small and medium-sized enterprises, including the settlement of disputes via licensing agreements and the licensing of know-how in the electronics, chemicals and general manufacturing sectors to manufacturers on the Chinese mainland. **DLA Piper**'s reach extends into China (Beijing and Shanghai), Japan, Singapore, Thailand and Hong Kong, where 11 professionals and the hub of the practice are found. The bulk of the firm's licensing work in the region concerns inbound licensing of telecommunications technology to China for distribution and work for international companies licensing research, development and production to China. **Freshfields Bruckhaus Deringer** primarily advises and represents inbound foreign licensors to mainland Chinese licensees. Sectors covered include telecommunications, renewables, chemicals and IT outsourcing (often for financial institutions). The firm's regional focus is on China and Hong Kong, from where its practice extends into India, Vietnam and Indonesia. Recent highlights include working with China Telecom on a licence with

Asia	Bird & Bird
	DLA Piper Hong Kong
	Freshfields Bruckhaus Deringer LLP
	Hogan Lovells
	Jones Day
	Morrison & Foerster

BlackBerry infrastructure owner Research In Motion to roll out the BlackBerry service on the CDMA-2000 network in China and advising Morgan Stanley on the complex IP aspects of its investment in Atlantis Resources Corporation. Commended for its “great reputation and deep resources”, **Hogan Lovells** operates in Hong Kong, Shanghai and Tokyo, where it has one of the most mature IP practices of any foreign firm; it represents the likes of Panasonic, Takeda Pharmaceuticals, Sharp and Shimano. The firm provides pan-regional representation on major IT outsourcing contracts, often for financial institutions, and know-how licensing for high-tech manufacturing. **Jones Day** fields “very strong, responsive and competitively priced” teams in Hong Kong and Shanghai, with offices in Singapore, Tokyo and Taipei ensuring consistent regional coverage. The firm’s work covers licensing arrangements following patent litigation; IP and patent due diligence; licensing, franchising and distribution; and research and development contracts. Clients include heavy engineering, vehicle, eye care, semiconductor, electronics, software and IT, pharmaceutical, cosmetics, healthfood, toy, hotel, food, restaurant and chemical companies. **Morrison & Foerster’s** formidable global network of “high-quality lawyers” extends across Asia, with sites in Beijing, Hong Kong, Shanghai and Tokyo. It provides the full range of licensing advice and representation on matters in the electronics, software, telecommunications, life sciences and chemicals industries, and recently worked with Advanced Micro-Fabrication Equipment, Novartis, Mitsubishi, Advantest, Hitachi and Elpida Memory. ■

Australia

Prominent market player **Allens Arthur Robison** handles technology and patent licensing through its IP and communications, media and technology groups. Practitioners provide representation on deals in the pharmaceutical, biotech, chemical minerals, food, electronics and consumer products, communications, media and IT industries. **Francis Abourizk Lightowlers** is acclaimed for its technology transfer practice. Fielding two partners, a special counsel and seven associates with licensing expertise, **Griffith Hack** has recently been active on cross-licensing arrangements following patent opposition disputes, with a significant percentage of this work occurring in the mining sector. The firm acts for a wide range of largely domestic blue-chip clients,

Australia

Allens Arthur Robison

Francis Abourizk Lightowlers

Griffith Hack

Mallesons Stephen Jaques

Spruson & Ferguson

including players in the life sciences, defence, automotive, renewables and software fields. It recently represented a major Australian solar energy developer and manufacturer in the preparation and negotiation of agreements with the federal and state governments, and with certain suppliers and solar energy customers. The firm also worked with an Australian biotechnology player in the preparation and negotiation of agreements for the licensing of software and products relating to tissue transplants in humans in the United States, South America and Europe. **Mallesons Stephen Jaques** is an established licensing powerhouse, with the Commonwealth Scientific and Industrial Research Organisation (CSIRO) and major Australian universities praising its “excellent people and expansive infrastructure”; “we doubt any other firm could meet all of our patent licensing needs,” they confide. The team counts several technically qualified lawyers among its number, all of whom are also involved in litigation, giving them a valuable breadth of experience. The team recently acted for CSIRO on patent licensing involving Mine Site, Cybersonose, Benitec, Hydrodec, Trantek, Opticool and many other cutting-edge technologies; Microsoft is another important client. Although some might question the depth of its team, **Spruson & Ferguson** boasts a prolific patent filing practice and attracts significant licensing and technology transfer work from major universities and other public research bodies, as well as clean energy, carbon reduction and other energy-related companies. ■

Canada

With a substantial prosecution and patent litigation practice, full-service firm **Bennett Jones** is well placed to serve clients on the commercialisation of their intellectual assets, with licensing playing a key role in this process. Telecoms, biotechnology, cleantech, information technology and industrial manufacturing are among the firm’s areas of strength; it has “highly competitive” teams in

Toronto and Calgary. With practitioners in Calgary, Ottawa, Toronto and Montreal, **Blake Cassels & Graydon** is credited with one of the most potent patent and technology licensing groups at a full-service firm. It has around 25 professionals handling licensing deals, enhanced by back-up from the firm's range of commercial practice groups. A focus on high-end IT and software matters has enabled it to take a leading position in advising players in those fields. **Fraser Milner Casgrain's** centre of gravity is in Edmonton, where it has seven licensing practitioners; elsewhere, it fields experts in Toronto, Ottawa and Vancouver. It handles matters across a broad range of industries, including energy, information technology, telecoms, natural resources and nanotechnology. **McCarthy Tétrault** is widely acknowledged as having one of the "strongest and most competitive" patent and technology licensing practices in Canada. The breadth and depth of its expertise impress: it fields many of the country's leading practitioners in offices spanning the country. Its most notable areas of strength are financial services, energy, life sciences and healthcare. **ROBIC** is a longstanding IP-focused firm, with around a dozen licensing experts in its Montreal office; for many, it is "the firm of choice in Quebec and a serious licensing player". **Smart & Biggar/Fetherstonhaugh** also has a practice in Montreal, with further licensing experts based in Ottawa, Toronto and Calgary. Its IP focus is noted by clients who praise its "valuable technical credentials" – though licensing is not generally considered to comprise a very large proportion of the firm's practice. However, the quality of its client base and work ensures it a position in the upper echelons of the market. Another "active and strong competitor", **Torys** has carved a niche advising on licensing arrangements relating to the financial services industry, though it also has a foothold in the life sciences sector. Reflecting

the practice and culture of the firm, practitioners focus on the most complex and valuable deals in the market. The firm's "profound understanding of business and user-friendly preparation of documents" win plaudits from clients. ■

Europe

With individuals ranked in the United Kingdom, Germany and France, **Baker & McKenzie** has established presences in key jurisdictions across the continent; reflecting its expansive reach, it also has a strong practice in Russia, where the *IAM Licensing 250* recognises one of its practitioners. The licensing aspects of franchising and IT outsourcing deals are perhaps its strongest suits, though it covers a comprehensive range of matters, including in the pharmaceuticals sector. **Bird & Bird** has one of Western Europe's most extensive networks, advising and representing clients in patent and technology licensing deals in the United Kingdom, Finland, France, Germany, Italy, the Netherlands, Spain, Sweden (in all of which it has individuals recognised by the *IAM Licensing 250*) and elsewhere. The firm's full-service commercial practice, with a heavy emphasis on intellectual property and high-technology industries, enables it to provide the complete spectrum of services to clients; sources confirm that it has "an extremely strong licensing practice" across the region. **DLA Piper** stands out across the continent, with *IAM Licensing 250*-recognised players located in Austria, the United Kingdom, Italy and Russia. Characteristically for such a large practice, DLA assists clients across a broad range of industries. Commentators are particularly impressed by its life sciences practice, where recent investment seems to be paying off for the firm. **Hogan Lovells** has an extensive network, with its strongest showings in the United Kingdom, France, Germany, Italy, the Netherlands and Russia. Interviewees admire its "high-quality team, with licensing integrated well into its wider IP and commercial practices". The firm represents a diverse array of clients, including players in the pharmaceutical, clean technology, chemicals, IT, telecoms and aviation industries. **Linklaters** remains the firm that other practices would "refer the biggest pieces of work to", given the depth of its resources and its extensive network of offices. Reflecting the firm's wider practice, its licensing work covers a diverse array of industries, including chemicals, industrial manufacturing, IT and banking, which has been particularly busy of late. The *IAM*

Canada

Bennett Jones LLP

Blake Cassels & Graydon LLP

Fraser Milner Casgrain LLP

McCarthy Tétrault

ROBIC LLP

Smart & Biggar/Fetherstonhaugh

Torys LLP

Licensing 250 identified the firm’s licensing practitioners in France, the United Kingdom and Russia. **Simmons & Simmons** is a formidable force in two of Europe’s most important technology and patent licensing markets: the United Kingdom and the Netherlands. The firm’s clear sector focus and its well-integrated network prove popular among clients in the life sciences, TMT, energy and financial services fields. “Simmons has the edge,” say clients; “they are great at building client relationships and they know how to work with other departments at the firm – for example, to minimise the tax impact on a deal.” **Taylor Wessing** proves strongest in its twin centres (and key licensing forums) of the United Kingdom and Germany. The firm acts on sophisticated licensing arrangements, with recent highlights in the pharmaceutical and digital printing industries. Clients commend the broad scope of its IP practice, into which licensing is well integrated. The Cambridge office wins plaudits and is well placed to work with emerging high-technology companies in the region, while the German arm has recently been active in the automotive industry. ■

Europe	Baker & McKenzie
	Bird & Bird
	DLA Piper
	Hogan Lovells
	Linklaters
	Simmons & Simmons
	Taylor Wessing

United States

Cooley Godward Kronish is the “most sophisticated practice and the best in town”, according to commentators in California and Colorado, where the firm has significant presences. It boasts 28 licensing practitioners, largely based on the West Coast; life sciences, telecoms and information technology are key areas of strength for the firm. **Fenwick & West** is another “major competitor” in California, where it has practices in Mountain View and San Francisco. Some 25 licensing practitioners work on technology transactions, with expertise in the technology and life sciences industries. The firm’s practice is broad, taking in customer, reseller, value-added reseller, original equipment

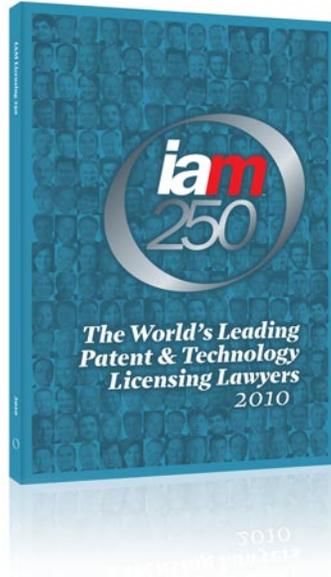
United States	Cooley Godward Kronish LLP
	Fenwick & West LLP
	Greenberg Traurig LLP
	Kirkland & Ellis LLP
	Knobbe Martens Olson & Bear LLP
	Morrison & Foerster LLP
	Weil Gotshal & Manges LLP
	Wilmer Cutler Pickering Hale and Dorr LLP
Wilson Sonsini Goodrich & Rosati	

manufacturer, outsourcing and manufacturing agreements; in-bound software and technology licences and acquisitions; standards bodies, alliances, joint ventures and university licensing. Clients include Electronic Arts, SAP, Symantec, BitTorrent, Cisco Systems, Corium International, Twitter, Google, Palm and Virgin America. **Greenberg Traurig** is feted for the quality of its service; clients confide that the firm “provides an invaluable level of support, works closely with clients and has the resources for our biggest projects”. The firm has licensing professionals recognised by the *IAM Licensing 250*; based in California, Massachusetts, Washington DC, New York and Arizona – a wider array of states than any other firm. It has an equally diverse practice, recently advising players in the retail, energy and mining sectors. The “excellent” **Kirkland & Ellis** is headquartered in Chicago, where four practitioners are ranked by the *IAM Licensing 250* elsewhere, it has players in New York and California. A large, full-service commercial firm, it caters to clients in a range of industries, recently including pharmaceuticals and software. IP boutique **Knobbe Martens Olson & Bear** is “a major competitor in California”, with five *IAM Licensing 250*-ranked practitioners in the state. Its broad licensing practice covers all areas of technology. **Morrison & Foerster** is one of the premier go-to firms in the United States for technology companies; its licensing expertise is highly respected by market sources. The firm has a particularly strong presence on the West Coast and maintains “brilliant and creative” patent and technology licensing experts at offices in San Francisco, Palo Alto, Los Angeles and San Diego. **Weil, Gotshal & Manges’** New York office is perhaps best known for its bankruptcy

expertise, but commentators acknowledge that the office is also home to a number of “extremely skilled lawyers” in the licensing and technology transfer area. The group’s high degree of specialisation in this sphere is a major draw for international clients.

Wilmer Cutler Pickering Hale and Dorr LLP has a significant following in the patent and technology licensing field; its specialised lawyers handle licensing in almost all technology categories. The firm’s clientele is diverse, and as well as advising major national and international technology players, the firm is equally adept at serving start-up technology clients. **Wilson Sonsini Goodrich & Rosati** is a marquee name in the technology sector and commentators remark that it is “still the big boy on the block”. The firm’s client roster is enviable; the patent and technology licensing expertise housed in particular at its Palo Alto base is rated highly by executives and peers nationally and overseas. *iam*

The IAM Licensing 250, including a full research methodology, is available for download at <http://www.iam-magazine.com/licensing250/>



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The advertisement features a large, dark grey shark fin on the left side, pointing towards a small, round glass fishbowl in the center. The fishbowl contains blue gravel and a single green artificial plant. The text 'How well does your IP Management fit your needs?' is positioned above the fishbowl. To the right of the fishbowl is the DENNEMEYER logo, which consists of a dark grey circle with a small 'TM' symbol, followed by the name 'DENNEMEYER' in a bold, sans-serif font. Below the name is the tagline 'First choice in IP' and 'Customized Solutions.' in a smaller font. At the bottom of the advertisement, there are three categories of services: 'PORTFOLIO SERVICES' in green, 'SOFTWARE SOLUTIONS' in blue, and 'IP CONSULTING' in orange. The website address 'www.dennemeyer.com' is located at the bottom right.

How well does your IP Management fit your needs?

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