

Venable provides IP Counsel for Private Equity Firms

VENABLE SNAPSHOT

More than 600 attorneys in nine offices

American Lawyer's AmLaw Global 100

More than 50 IP attorneys, many of whom have Ph.D.s or other advanced science degrees

More than 30 registered patent attorneys and patent agents

Five members of the American College of Trial Lawyers

Challenge

Private equity firms often struggle with how to value, protect and enforce the IP of a portfolio company in which they are investing; to ensure the return on that investment; and how to manage its IP assets.

Often the management of the portfolio company's IP assets is spread across multiple U.S. and foreign law firms and there is no one go-to resource for all IP-related issues. Thus, a private equity shop's posture when handling the IP assets of the companies they acquire can be reactionary and often lacks consistency.

Solution

When facing such challenges, private equity firms need to seek outside counsel that can assist with managing and evaluating its IP global assets. Venable has demonstrated its ability to assist private equity companies in quickly evaluating the assets in the enterprise's IP portfolio and

has been instrumental in offering the following solutions:

- 1) Assessing what's needed to organize their IP portfolio;
- 2) consolidate all outside counsel;
- 3) develop and implement an IP strategy for its portfolio companies that is aligned with the business objectives of both the private equity firm and the portfolio company;
- 4) review and update the portfolio company's IP strategy periodically, as their business goals and objectives continue to develop and grow;
- 5) offer support as a one-stop solution to manage the overarching strategy; and
- 6) offer alternative fee arrangements to manage the cost expectations of the private equity firm and the portfolio company.

Results and Benefits

- Controlled decision-making about which IP assets are beneficial, which assets should be monetized through sale/licensing, and which assets contain areas that need strengthening.
- Enable proactive IP oversight by a seasoned team of attorneys that will ensure continued alignment with the goals and business objectives of both the private equity firm and its portfolio company.
- Achieve a cost savings by consolidating outside counsel.
- Realize greater cost certainty.
- Benefit from the advance preparation of the private equity firm's IP assets in the event that the portfolio company is sold.



KEY CONTACT

Frank M. Gasparo
 Partner, Intellectual Property Litigation
E fmgasparo@Venable.com
T 212.370.6273