PRODUCT DEVELOPMENT AND COMMERCIALIZATION

LeClairRyan regularly represents banded and non-branded companies concerning licensing of pharmaceutical products and technologies. Our attorneys often negotiate discovery and research collaboration agreements with domestic and international entities. We regularly represent companies in connection with clinical research agreements, mergers and acquisitions of start-up/venture entities and negotiating joint development venture agreements. Our experience spans pre-clinical to late phase development and often involves co-developing with academic institutions. We have represented clients in a wide variety of acquisition and disposition transactions relating to the transfer of assets, regulatory approvals, intellectual property and other facilities/equipment.

Representative transactions include:

- Represented licensor of a once-daily Ciprofloxacin product. The licensee was a large branded company.
- Represented licensor of a Phase II statin product.
- Represented client in a global drug discovery and research collaboration. The co-development partner was a large branded company.
- Represented client in the formation and documentation of a drug discovery joint venture providing for pre-clinical and clinical drug discovery and development.
- Represented client in the formation and documentation of a drug discovery joint venture providing for pre-clinical and clinical drug discovery and development with the objective of licensing product development candidates to third parties upon the completion of Phase II clinical studies. The co-development partner was a large public university.
- Represented client in a global drug discovery and research collaboration. Our client performs preclinical and early clinical research and discovery with the co-development partner providing late stage clinical development, regulatory approval, manufacturing and distribution. The co-development partner was a large branded company.
- Represented numerous clients in a variety of acquisition and disposition transactions relating to pharmaceutical assets, regulatory approvals, intellectual property and facilities/equipment. Counter parties in these transactions included large branded pharmaceutical companies.
- Represented licensee in a license and supply agreement relating to a late stage product candidate for BPH.
- Represented licensee in a license and supply agreement for a generic Acutane product candidate.
- Represented licensor in a license and development agreement relating to a portfolio of abuse-deterrent opioid product candidates.
- Represented numerous generic and branded-generic companies in partnering/co-development and licensing transactions relating to the development, regulatory approval, supply and distribution of a variety of generic and branded-generic pharmaceutical products.
- Represented client in material transfer agreements, research license agreements, and commercial license agreements between agricultural biotechnology companies relating to transgenic plant technology.
- Handled technology development agreements between companies relating to microfabricated chemical analytical technology.
- A sponsored research agreement between a state agency and a biotechnology company relating to bacterial detection technology.

University Technology Transfers

LeClairRyan provides leading public and private academic institutions across the nation with a multidisciplinary approach to handling the myriad of legal challenges related to academic inventions and intellectual property rights.
Our distinctive strengths include:

- Patent prosecution and issuance
- Post-issuance interference practice
- Trademarks, copyrights and licensing
- Technology transfer agreements
- The commercialization of academic inventions
- Emerging company business counsel

We are well-versed in the magnitude of issues related to university technology transfer agreements, delivering business solutions—not just legal strategies—for our college and university clients. Our multidisciplinary team is composed of education industry as well as intellectual property and technology attorneys who possess extensive knowledge of the legal intricacies pertaining to university-related intellectual property matters, including university-inventor disputes, multi-patent portfolios, commercializing medical research, and license arbitrations. In addition, our venture capital attorneys are well respected for their proven ability to assist entrepreneurs in securing business financing when the university technology transfer process is complete.

Our attorneys skillfully handle university technology transfer matters pertaining to a range of technologies in the biotechnology, life sciences, chemistry, electrical, mechanical, optical, and computer science fields. We also provide clients with a unique strategic advantage through our insider's perspective, as our deep bench of attorneys includes individuals who have experience working for the university technology transfer offices at the Virginia Commonwealth University the University of Rochester.

From the beginning of the university technology transfer process through the launching of a business based on an invention, our multidisciplinary team of attorneys consistently delivers business-driven results that protect our clients' best interests. The following materials provide an overview of our team's experience related to academic inventions, intellectual property rights and entrepreneurial business growth opportunities.

Representative matters:

- Represent university technology transfer clients in their intellectual property matters, including the procurement of U.S. and foreign patents, licensing of university-owned technology, reexamination and reissue of patents, and patent litigation. Patent work encompasses a variety of different technology areas, including computer software and hardware, internet and electronic commerce, business methods, communications, semiconductor technologies, electrical, electromechanical, optical, medical related technologies, clean energy technologies, microfluidics, MEMS, and other mechanical disciplines.
- Represent university clients in post issuance practice matters, such as oppositions, reexaminations, reissues and interferences involving their patent applications.
- Negotiate licensing agreements and defend university intellectual property matters.
- Represented consortium of major research universities in biotechnology transfer licensing dispute.
- Successful patent infringement defense of university clients to infringement claims made by a non-practicing entity related to distance learning applications.
- Advised state university faculty members on academic inventions, including disclosure obligations, ownership and sponsored research.
- Negotiated agreements for the out-licensing of university-developed patents and know-how and advised clients regarding the scope of license rights.
- Advised university patent offices in connection with audits of royalty payments due to a public university.
- Developed and managed patent portfolio of about 30 domestic and international applications for a tier 1 national university on applications of silk-based materials in different areas, including biomedical device, bodelivery device, electrical and optical device, biosensing platform, pharmaceutical compositions, and tissue engineering materials.
- Resolve an inventorship dispute and develop a patent portfolio on behalf of a university client relating to the discovery of over a thousand antibacterial agents.
- Develop a multi-patent portfolio for a university client covering chemical syntheses of peptide mimics.
- Represented consortium of major research universities in biotechnology licensing arbitration.
- Represented university client in arbitration with licensee, resulting in the parties entering into a new, more favorable license.
- Counseling individuals and businesses on IP matters in a university context, including advising on the outlicensing of university-developed technology and the rights of state university faculty members in connection with disclosure obligations and intellectual property ownership issues.
- Advising “America's first research university” on commercializing medical research.
- Successfully defended a university in an arbitration involving an inventorship dispute based on interdisciplinary technology developed at the university.