

Assets & Finance: Intellectual Property in Mergers and Acquisitions

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Intellectual Property Library

Assets & Finance: Intellectual Property
in
Mergers and Acquisitions

by David M. Klein

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To my children
Adam Gabriel, Brian Everett, Haley Rose and Samantha Grace
Who should know that I always love them

About the Author

David M. Klein is a partner in the Intellectual Property and Technology Transactions Group at Shearman & Sterling, and leads the Group's technology transactions and outsourcing practices. Mr. Klein is an expert on the structuring and negotiation of complex technology transactions, including mergers & acquisitions, joint ventures, outsourcing, strategic alliances, licensing and other transactional matters. Mr. Klein also performs strategic trademark prosecution and counseling, and patent prosecution and counseling in the fields of Internet, e-commerce, computer hardware and software, electronics, semiconductors, medical devices, and mechanical/electromechanical machinery.

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Mr. Klein's practice was highlighted on the front page of the New York Law Journal in an article entitled "*Shearman Seeks Patent for Partner's Practice Innovation.*" Mr. Klein was also a featured author in "*Inside the Minds: Privacy Matters,*" Aspatore Books, 2002. Mr. Klein has written numerous articles and speaks regularly on all aspects of technology transactions and outsourcing.

Mr. Klein invites comments or questions on this book and may be reached at (212) 848-4882 or by e-mail at "dklein@shearman.com."

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Preface

This book is intended to provide a desk reference for lawyers and businesspeople who handle intellectual property issues in the context of M&A transactions. The book takes a pragmatic approach to the subject, offering various options for handling issues depending on certain variables, such as the type and size of the transaction. The book also highlights the importance of intangible issues, such as the relative negotiating leverage of each party. In addition to providing “ideal” approaches to solving issues, the book provides guidelines for determining realistic or “reasonable” solutions to problems. Where drafting issues are concerned, the book provides multiple examples of how language may be narrowed and broadened to fit the circumstances of a particular transaction.

The initial chapters provide the reader with an overview of the fundamentals of intellectual property and M&A transactions so that those with little or no familiarity with either may utilize the book. The book has other chapters devoted to each of the key phases in the lifecycle of an M&A transaction, i.e., due diligence, the main transaction agreement, and ancillary documents related to closing. Model agreements for various types of transaction documents are provided as a useful reference. A more complete guide to how this book should be used is provided in Chapter 1.

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