

# Intellectual Property



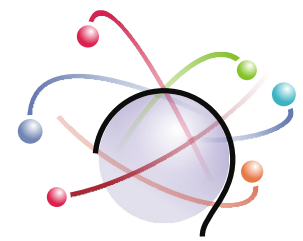
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## PROFILE OF EXPERTISE

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Nishith Desai Associates (NDA) has an extensive research-oriented and industry-focused approach towards its practice areas. NDA's Intellectual Property Law Team is led by an engineer-turned-lawyer and is comprised of individuals with the requisite skills to tackle the complex legal challenges associated with the protection of intellectual property in the 21st century. The team has formulated comprehensive strategies to help clients leverage their intellectual property and unlock the value of their intellectual assets in the current competitive marketplace. The IP Team has unique expertise in drafting and reviewing a diverse range of intellectual property assignment and licensing agreements. In addition, the team has assisted clients in drafting and filing copyright, trademark, design and patent applications in India and internationally.

NDA's Intellectual Property practice is currently focused on the following broad areas:

- **Strategy**

The IP Team advises clients across a vast spectrum of industries, identifying their intellectual property and formulating comprehensive strategies to help clients protect and leverage their intellectual property. The team endeavors to understand the nature of the industries in which clients operate, the organization of the intellectual property, and the policies that apply for the management and use of those assets to meet certain specific business goals. With respect to patents, the team develops comprehensive offensive and defensive strategies that involve conducting extensive searches, identifying the technology of clients and their competitors, and devising strategies to protect the clients' core and ancillary technologies.

- **Scope of Intellectual Property**

The IP Team is experienced in drafting, filing, and prosecuting registration applications for all types of intellectual property. This includes drafting complex patent specifications for a wide array of technologies, filing and prosecuting national patent applications in India and overseas, and prosecuting PCT Applications. A brief scope of our services include -

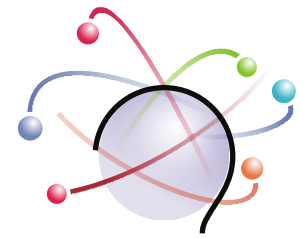
(i) Liaising and globally negotiating trademark disputes and coordination with foreign attorneys for resolving cross border trademark matters, (ii) Identifying / structuring strategy(ies) for leveraging client IP in global markets, (iii) Drafting, reviewing and negotiation of agreements in the retail sector, (iv) Restructuring of IP ownership(s) from a tax perspective, (v) Advising on IP issues under cross-border employment contracts, (vi) Advising media houses on their disputes in relation to copyrights.

- **Due Diligence**

The IP Team implements a structured process for conducting due diligence that involves a detailed review and documentation of intellectual property. In doing so, the team helps clients evaluate their risks, liabilities, and opportunities involved with their intellectual property.

- **Opinions and Documentation**

The team provides both Indian and international clients with legal opinions on complex intellectual property issues arising from emerging technologies. Furthermore, the IP Team drafts and reviews a diverse range of intellectual property and technology agreements to meet the specific needs of wide-ranging industries in India and abroad.



- **IP Related Litigation and Enforcement**

The IP Team assists clients in dispute resolution (arbitration and litigation), sending and responding to cease and desist notices and devising strategies for both Indian and cross border dispute resolution mechanisms. The IP team can also co-ordinate with private agencies for enforcement of IP rights.

## **EXPERIENCE**

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The IP Team has a vast array of experience working with a diverse group of clients and industries.

In respect of transactions related to IP, the IP team acted as counsel for I-Flex Solutions Limited in its acquisition of IP of a Belgian company. We also represented Glenmark Pharmaceuticals India in structuring a major intellectual property transaction involving assignment of rights.

In respect of the entertainment business, the IP team acted as production counsel to one of the most acclaimed Indian films called "Black". On a regular basis we assist various media houses such as MGM, Warner Brothers, Reliance Entertainment, Times Group etc. on their various IP issues. We have also provided advisory services to international publishing houses in the launch of the Indian editions of their magazines.

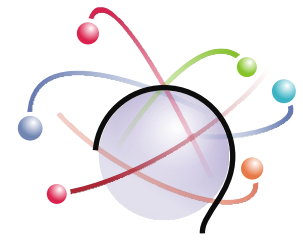
We continue to assist companies like Compulink, Codexis, Directi, Dun & Bradstreet, Four Interactive, Garmin, Gebrueder Heller Maschinenfabrik GmbH, Geodesic Information Systems Limited, Larson & Toubro, Miles Software, Playboy, Reliance, Reva Electric Car Company, Salesforce.com Inc. etc., in respect of their IP products and other issues relating to their business.

On the patenting front, the team has advised clients in drafting and filing of both domestic and international patent applications. Among others these clients include Johnson & Johnson, Sasken Communication Technologies, Motorola, Inc., Beceem Communications, I-flex Solutions, ITFinity Solutions Private Limited, Bilag Industries Pvt. Ltd., Geodesic Information System Ltd., VAAKYA Technologies Pvt. Ltd, Yasu Technologies, and Softjin Technologies Pvt. Ltd.

For pharma companies we consistently continue to advise various multinational companies on regulatory issues and compliances pertaining to the conduct of clinical trials in India along with the import/promotion of pharmaceutical products. We also provide strategies for protecting IP / confidential information along with the drafting of necessary documents as per industry standards.

The team has represented StemCyte Inc, USA, a leading cord blood banking and research company in their JV with Apollo Hospital and Cadila Pharmaceuticals, India to render services into the area of Umbilical Cord Blood banking.

We assist Indian and foreign clients like EuroKids India Private Limited, Blue Star Limited, iDream Production Private Limited, Give Foundation, Franchising Association of India, Collabnet Inc., Monitor Group, Navicore Ltd., MobiTV Inc., Pack & Send Systems Pty. Ltd., Submarino, GlobeOp Financial Services LLC, International Justice Mission etc in filing and prosecuting their trademark / service mark applications.



The team has represented Bennett Coleman & Co. Limited. in one of the first Indian domain name disputes at the World Intellectual Property Organization (WIPO) and has also represented Cox & Kings, Wipro Limited, and Eenadu Group in their domain name disputes. On IP Litigation, we have acted as counsel and successfully represented EuroKids, the exclusive licensees of Tin Tin comics in India, in a cross border copyright dispute in the High Court, relating to parallel import and market of TinTin comics in India. The firm was successful in restraining such parallel imports. Some of the firm members also have experience in criminal/police enforcement.

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