

Intellectual Property

STATEMENT OF CAPABILITY

2011

Nishith Desai Associates

Legal & Tax Counseling Worldwide

Mumbai • Silicon Valley • Bangalore • Singapore • Basel • New Delhi

Nishith Desai Associates (NDA) is a research based international law firm with offices in Mumbai, Bangalore, Silicon Valley, Singapore, Basel and New Delhi. We specialize in strategic legal, regulatory and tax advice coupled with industry expertise in an integrated manner. We focus on niche areas in which we provide significant value and are invariably involved in select highly complex, innovative transactions. Our key clients include marquee repeat Fortune 500 clientele, of which over 60 per cent are US corporations.

Core practice areas include International Tax, International Tax Litigation, Litigation & Dispute Resolution, Fund Formation, Fund Investments, Capital Markets, Employment and HR, Intellectual Property, Corporate & Securities Law, Competition Law, Mergers & Acquisitions, JVs & Restructuring, General Commercial Law and Succession and Estate Planning. Our specialized industry niches include financial services, IT and telecom, education, pharma and life sciences, media and entertainment, real estate and infrastructure.

Our Tax, Investment Funds and Technology-Media-Telecom (TMT) practices have been consistently ranked in tier 1 by Legal 500, while Chambers & Partners have ranked us # 1 for Tax, TMT and Real Estate - FDI. We've received honorable mentions in Asian - Counsel Magazine for Alternative Investment Funds, International Arbitration, Real Estate and Taxation for the year 2010. We have been adjudged the winner of the Indian Law Firm of the Year 2010 for TMT by IFLR. We have won the prestigious "Asian-Counsel's Social Responsible Deals of the Year 2009" by Pacific Business Press, in addition to being Asian-Counsel Firm of the Year 2009 for the practice areas of Private Equity and Taxation in India. Indian Business Law Journal listed our Tax, PE & VC and Technology-Media-Telecom (TMT) practices in the India Law Firm Awards 2009 as also Legal 500 (Asia-Pacific) that has ranked us #1 in these practices for 2009-2010. We have been ranked the highest for 'Quality' in the Financial Times – RSG Consulting ranking of Indian law firms in 2009. The Tax Directors Handbook, 2009 lauded us for our constant and innovative out-of-the-box ideas. Other past recognitions include being named the Indian Law Firm of the Year 2000 and Asian Law Firm of the Year (Pro Bono) 2001 by the International Financial Law Review, a Euromoney publication. In an Asia survey by International Tax Review (September 2003), we were voted as a top-ranking law firm and recognized for our cross-border structuring work.

Our research oriented approach has also led to the team members being recognized and felicitated for thought leadership. Consecutively for the fifth year in 2010, NDAites have won the global competition for dissertations at the International Bar Association. Nishith Desai, Founder of Nishith Desai Associates, has been voted 'External Counsel of the Year 2009' by Asian-Counsel and Pacific Business Press and the 'Most in Demand Practitioners' by Chambers Asia 2009. He has also been ranked No. 28 in a global Top 50 "Gold List" by Tax Business, a UK-based journal for the international tax community. Nishith Desai is listed in the Lex Witness 'Hall of fame: Top 50' individuals who have helped shape the legal landscape of modern India.

Our Intellectual Property Practice Expertise

The Intellectual Property Law team of Nishith Desai Associates is led by an engineer-turned-lawyer and comprises 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 protect and 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.

With the advent of the knowledge and information technology era, intellectual capital has gained substantial importance. Consequently, intellectual property (IP) and intellectual property rights (IPRs) attached thereto have become precious commodities and are being fiercely protected. Since IPRs are country-specific, it is imperative, in a global economy, to ascertain and analyze the nature of protection afforded to IPRs in each jurisdiction. In tune with the world scenario, India too has recognized the value of IP, which recognition has been consistently upheld by legislators, courts and the industry. India is now a signatory to various IP treaties and conventions and there are well-established statutory, administrative, and judicial frameworks for safeguarding IPRs in India. Historically, the enforcement of IPRs in India was not particularly effective. However, recent judicial rulings and steps taken by various enforcement agencies demonstrate that India is gearing up for effective protection and enforcement of IPRs.

We undertake top bracket, high-end complex IP work, and serve to address the entire range from global project management registrations and searches, IP litigation including patent litigation, pre-grant and post-grant opposition, complex IP transactions such as licensing, joint developments and collaborations.

Currently, we represent 8 of the top 20 pharmaceuticals companies in the world. We also have a significant expertise in cross border IP litigation and we were the first Indian law firm to initiate film copyright licensing litigation in a Singapore court which involved 3 jurisdictions, namely Cyprus, Singapore and India. We also undertake global IP portfolio management projects along with providing assistance on cross border IP transactions. We also make external presentations on various IP topics, make contributions to various IP articles and regularly contribute to IBLJ, WTR and WMLR.

Vaibhav Parikh, Partner in charge of our IP practice has been nominated as one of the world's leading practitioners in 'Who's Who Legal' for Regulatory Communications. He has authored several papers and lectured at several prestigious gatherings on a worldwide basis. He has also been acknowledged as a 'Highly Recommended Lawyer' for Outsourcing, and Telecom and IT and 'Recommended Lawyer' for Intellectual Property by the PLC Which Lawyer? 2009.

Gowree Gokhale is a Solicitor and a registered Patent & Trade Mark attorney and has been practicing for the last 14 years. She is a visiting faculty at Institute of Intellectual Property Law Studies at Mumbai. She has authored research reports and articles on variety of subjects and has presented at various national and international seminars and conferences on IP, pharmaceutical, media and technology laws.

Scope of Services

NDA's Intellectual Property practice focuses on

Strategy

The IP Team advises clients across a vast spectrum of industries, identifying and structuring their intellectual property and formulating comprehensive strategies to help them protect and leverage their intellectual property in global markets. 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.

Intellectual Property filing and prosecution

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. We also liaise and coordinate with foreign attorneys for resolving cross border IP matters

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. The IP Team also undertakes the following:

- drafting, reviewing and negotiation of agreements in the retail sector,
- restructuring of IP ownership(s) from a tax perspective
- advising on IP issues under cross-border employment contracts,
- advising media houses on their disputes in relation to copyrights.

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.

Representative Clients

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 (now Oracle Financial Services) 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.

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, , InTFinity 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 advice 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, in filing and prosecuting their trademark / service mark applications. relating to their business Navicore Ltd., MobiTV Inc., Pack & Send Systems Pty. Ltd., Submarino, GlobeOp Financial Services LLC, International Justice Mission etc

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 Tin Tin comics in India. The firm was successful in restraining such parallel imports. Some of the firm members also have experience in criminal/police enforcement. So, our clients include:

Oracle Financial Services, MGM, Warner Brothers, Reliance Entertainment, Times Group, 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

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