



Buchalter

University, Research Institution and Technology Transfer Practice

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OVERVIEW OF BUCHALTER'S UNIVERSITY, RESEARCH INSTITUTION, AND TECHNOLOGY TRANSFER PRACTICE GROUP

Buchalter has a dedicated team of intellectual property, corporate, data privacy, litigation, and tax attorneys that focus on the legal needs of universities, nonprofit research institutions, academic institutions and other nonprofit organizations.

The attorneys in our University and Technology Transfer Group represent these clients (including universities, other nonprofit research institutions, and research hospitals) as well as private sector technology companies that collaborate with, or were spun out of, these institutions.

Our firm represents these clients regarding intellectual property, licensing, technology transfer/commercialization, research, corporate, e-commerce/internet, data sharing, data privacy, tax, policy-formation, litigation, and general commercial law matters.

Our familiarity with representing both universities/research institutions and private sector technology companies uniquely enables our attorneys to understand the cultural nuances involved with transactions between universities/research institutions and private sector companies. This experience allows our attorneys to more efficiently and effectively find the appropriate legal solutions and optimum alliances for our clients.

MORE DETAILS REGARDING BUCHALTER'S LEGAL SERVICES IN THIS FIELD

• TECHNOLOGY TRANSFER & INTELLECTUAL PROPERTY LICENSING

Our attorneys have extensive experience representing universities/research institutions concerning license arrangements involving an array of technologies and their overall technology transfer/technology commercialization strategies and arrangements. We also have significant experience representing private sector companies that collaborate with, or are spun out of, these institutions. This background provides us with a unique perspective in knowing what makes these transactions successful for all parties.

This experience includes:

- Assisting universities/research institutions with invention-disclosure policies and overall technology commercialization strategies and procedures.
- Extensive experience preparing/negotiating agreements (both domestic and international) for licensing out of inventions/other technology between universities/research institutions and private sector companies.
- Licensing experience related to a wide range of technologies:
 - A wide variety of patent-protected technologies, including hardware devices, semiconductor-related inventions, drug therapeutics, medical devices, and agricultural-based inventions.
 - A broad range of software apps.
 - Other copyright-protected works.
 - Databases and a wide variety of trade secrets/know-how.
- Counseling universities/research institutions in technology transfer transactions in which clients receive a mixture of royalties and equity in the licensee.
- Assisting university/research institution clients in developing reusable templates for their licensing/technology transfer program.

- **RESEARCH COLLABORATIONS / TECHNOLOGY CONSORTIA / OTHER TECH ALLIANCES**

Buchalter is well positioned to address the special needs that universities/research institutions encounter when they engage in complex technology or other research collaborations, consortia, and other alliances with other universities/research institutions and private sector technology companies.

We have assisted universities/research institutions regarding:

- Inter-institutional arrangements with other nonprofit institutions.
- Research collaborations or other technology alliances between multiple institutions.
- Sponsored research arrangements with private sector technology companies.
- Forming technology consortia involving private sector technology companies.

We have a group of attorneys that assist universities/research institutions regarding these complex collaborations and alliances. Our experience includes:

- Developing organizational structure of these collaborations/consortia.
- Negotiating contract terms or other policies governing ownership and cross-licensing of IP arising out of these collaborations/consortia.
- Domestic and international collaborations/consortia.
- Counseling universities regarding participation in global technology standards-setting organizations, or similar technology consortia.

- **OTHER RESEARCH AND DEVELOPMENT MATTERS**

Assist university/research institution clients regarding other issues that arise during research and development stages, including:

- Preparing/negotiating clinical trial agreements.
- Preparing/negotiating material transfer agreements.
- Preparing/negotiating material/specimen evaluation agreements or other types of beta test agreements.
- Counseling clients regarding proper use of open-source software or other freely-available technology in their research efforts.

- **UNIVERSITY/RESEARCH INSTITUTION POLICIES**

Represent universities/research institutions in creating internal policies, including:

- Intellectual property ownership.
- Technology transfer, sponsored research arrangements, and other commercialization matters.
- Researchers'/ professors' conflicts of interest.
- Policies providing guidelines for university's equity interest in start-up companies.

- **"SPIN-OUT" COMPANIES FROM UNIVERSITY/RESEARCH INSTITUTION**

Represent universities/research institutions in forming new "spin-out" start-up companies that are granted licenses to commercialize the university/research institution's inventions. This experience includes:

- Corporate formation, securities, and tax counseling.
- Structuring university/institution's equity investment in the spin-out companies.

- **ADDITIONAL CORPORATE AND TAX COUNSELING FOR UNIVERSITY/RESEARCH INSTITUTIONS AND OTHER NOT-FOR-PROFIT ENTITIES**

Our attorneys represent universities/research institutions, other nonprofit entities, and their related entities (such as their foundations), concerning a broad range of corporate, tax, and general business matters:

- Representing not-for-profits regarding corporate governance matters, including counseling the Boards of Directors.
- Counseling regarding a variety of tax issues, including unrelated business income tax issues.
- Representing universities/research institutions regarding the formation of affiliated not-for-profit entities and other joint ventures.

In particular, we have experience representing universities/research institutions concerning tax and corporate issues regarding the formation of a separate not-for-profit affiliate organized to commercialize that university/research institution's intellectual property.

- **OVERALL PROTECTION AND MAINTENANCE OF INTELLECTUAL PROPERTY RIGHTS**

Domestic and international protection and maintenance of patents, copyrights, trademarks, trade secrets, and other IP rights. Our services include:

- **Patents:** U.S. and foreign patent applications covering a wide variety of technology fields. Monitoring and enforcement.
- **Trademarks:** U.S. and foreign registrations. Monitoring and enforcement.
- **Copyrights:** Registrations of copyright-protected work in U.S. and evaluate scope of overseas copyright protection. Monitoring and enforcement.
- **Trade Secrets/Know How:** Development of proper steps to maximum worldwide trade secret protection.
- **Retention of IP Rights:** Procedures and documentation for retaining ownership of IP rights developed by employees and contractors (including visiting researchers).
- **Data Rights and Data Sharing:** Evaluate IP rights and other legal rights regarding data (particularly analytics-derived data sets) and analyze IP and other legal issues related to data sharing and cross-licensing of data.

- **SOFTWARE MATTERS**

Our attorneys have extensive experience regarding a broad range of legal and business issues related to the development, licensing, and other distribution of software programs. We have experience with software programs used in a broad range of industries and for a broad range of uses, including enterprise-wide software programs. In particular, we represent a broad range of clients, including university/research institution clients, regarding the following issues associated with software programs:

- Preparing and negotiating software-related agreements, including software licenses for downloadable software and agreements providing end users access to the client's software in cloud-based environments (such as software-as-a-service /SaaS).
- Preparing and negotiating a broad range of other agreements related to the distribution and commercialization of software programs, including reseller agreements and distribution agreements.
- Representation of application developers, open source developers, and licensees of enterprise software, as well as bundling and distribution with well-known industry leaders.
- Experience regarding legal issues associated with open-source software, which goes back several years to the Portland office's representation of the Linux Foundation. Our work in the open source software space includes the following:
 - Evaluating the legal implications of using certain open source software licenses.

- Preparing open source software compliance policies.
- Preparing and reviewing open source software licenses.
- Assisting clients with analyzing other open models, including structuring agreements for the open development/distribution of proprietary software using other open-source type models.
- Our team has experience representing clients in large scale software procurement contracts. In particular, we have represented several Oregon agencies in negotiating contracts (many worth hundreds of millions of dollars) in which the state entity engaged third-party developers to design and implement (and, in some cases, also operate) large scale technology systems (which include hardware and software products) for the state agency.

• **E-COMMERCE / INTERNET RELATED MATTERS**

Our attorneys provide a wide array of internet, e-commerce, and cyber law-related counseling to our clients regarding a broad range of business and legal issues faced by entities that have internet or cloud-based operations or presences, including:

- Preparing the numerous agreements and policies necessary to govern the use of the client's website or other ecommerce activities, including Website Terms of Use and Privacy Policies (see separate section on Privacy).
- Online compliance with applicable Internet statutes and regulations, such as the Federal Trade Commission, the Children's Online Privacy Protection Act, the Electronic Communications Privacy Act, and the Americans with Disabilities Act.
- Analysis of tax implications of conducting business over the Internet.
- E-commerce transaction agreements, such as online Terms of Service, marketing and partner agreements, and other click-wrap and web-wrap agreements.
- E-commerce site development, including website development agreements.
- Content and online service provider agreements.
- Domain name registration, protection and disputes, including cybersquatting.

• **PRIVACY AND DATA SECURITY**

The attorneys in our Privacy practice group help our clients navigate local, state, federal, and international privacy and data security laws. We address multi-state and multi-national compliance issues and industry-specific self-regulatory frameworks.

We advise on privacy issues across a broad range of industries and contexts – from preparing privacy policies (to comply with the expanding number of state privacy laws), to responding to data subject requests, to analyzing legal and business issues related to data collection, storage, use, and disclosure, to internal privacy compliance program planning, and to data breach notification requirements.

In particular, our attorneys provide the following services in the privacy and data security field:

- Preparing Privacy Policies (including Notice of Collection and Do Not Sell or Share My Personal Information documents) for compliance with the California Consumer Privacy Act (CCPA), the Oregon Consumer Privacy Act (OCPA), and other new state privacy laws.
- Assisting with Consumer Requests under state data privacy laws.
- Assisting with data mapping, including mapping of data collection, storage, use, and disclosure.
- Preparing internal data privacy and security compliance programs and policies.
- Assisting with data breaches, including preparing and filing data breach notifications required under state laws.

- Preparing Data Processing Addendum, Data Security Agreements, and other related security agreements.
- Preparing Cookie Policies.
- Assisting with compliance with the European Union/UK's GDPR, such as the GDPR Informed Consent and issues associated with the transfer of Personal Data of an EU Resident (including standard contractual clauses).
- Addressing telecommunication issues, including Text Messaging Policies and TCPA Class Actions.
- Assisting with other Federal Trade Commission compliance issues as they relate to use of personal information of consumers.
- Assisting with issues related to personal information of employees, including regulation of employee personal information under the California Consumer Privacy Act (CCPA).

KEY ATTORNEYS PROVIDING LEGAL SERVICES IN THIS FIELD



FRANK X. CURCI – Frank is a Shareholder in the firm's Intellectual Property, Health Care, Privacy/Data, and Corporate practice groups. He represents universities, other research institutions, medical institutions, bioscience companies, high-tech industry companies (ranging from emerging growth companies to global companies), technology accelerators, global technology consortia, and other technology-based entities. He assists these entities on a range of technology, scientific, research, intellectual property, data, privacy, governance/policy, corporate, and business matters. In particular, he counsels universities, research institutions and academic entities regarding patent/software/technology licensing, other technology commercialization/transfer matters, research collaborations, technology consortia/initiatives, sponsored research, additional research issues, overall intellectual property strategies for the development or public use of the entity's research/discoveries, internal policies/governance, data rights, data sharing, and privacy/cybersecurity. As a result of his experience, Frank has developed a recognized practice representing: (i) a number of universities/research institutions and other bioscience entities in the Western United States; and (ii) global high-technology industry consortia. For nearly 12 years he has been on the Board of Directors of the Cancer Research And Biostatistics institute, a Seattle-based nonprofit bioscience institution. For several years he was on the Board of Directors of OTRADI/Oregon Bioscience Incubator, a Portland-based bioscience incubator. Frank was an Adjunct Professor of Law for several years teaching intellectual property and technology transfer courses at California, Oregon, and Arizona law schools. He has received the peer-review distinction of *Best Lawyers in America*® in the categories of Technology Law and Biotechnology Law from 2009 to 2025.



L. DAVID CONNELL – David, who is a Shareholder in the firm's Corporate, Tax and Health Care practice groups, focuses his practice on tax, business, health care, and nonprofit law. David works closely with many tax-exempt/not-for-profit organizations, including universities/research institutions and global nonprofit technology consortia, to provide practical solutions to complex issues, with a focus on achieving the client's business and tax objectives. He counsels these tax-exempt organizations in all tax matters, including qualifying for and maintaining tax-exempt status, minimizing unrelated trade or business income, public charity/private foundation status, compensation issues, financing issues, limitations on lobbying, and transactions with other entities. He also regularly advises these organizations on governance and other day-to-day matters.



DANIEL P. LARSEN – Daniel Larsen is a Shareholder in Buchalter’s Intellectual Property, Commercial Litigation, and Health Care Practice Groups. Within these practice areas, Mr. Larsen advocates and advises clients in nearly all varieties of business disputes and risk assessment. He represents research institutions/universities, as well as companies doing business with research institutions/universities, regarding disputes involving patent/intellectual property rights, license agreements, research agreements, and other academic-related contracts. With nearly 30 years of experience, Mr. Larsen’s substantive expertise applies to most commercial relationships and transactions, including commercial healthcare relationships, and operations of businesses that create disputes and risks arising from contractual and statutory obligations, duties of directors, officers, and managers of businesses, shareholder rights, and intellectual property rights, particularly involving trade secrets, trademarks, and copyrights.



MICHAEL FILLINGAME - Michael is in the firm’s Corporate practice group and a Senior Counsel. Michael represents public and private companies, as well as some of the firm’s university/research institution clients, in a broad range of complex corporate transactional matters, including mergers and acquisitions, joint ventures, private equity investments, corporate governance, start-up spin-outs of research institutions, and equity investments in start-ups by research institutions.



AKANA K.J. MA – Akana, who is in the firm’s Corporate and Intellectual Property practice groups, chairs the firm’s Global Trade Group. He works with clients, including our university/research institution clients and global technology consortia, regarding legal issues associated with conducting business in the global marketplace, including export compliance regulations (such as analyzing the Export Administration Regulations/EARs and other regulations governing controlled technical information and compliance with other customs and import law and regulations), structuring international joint ventures, compliance with foreign laws and regulations, the licensing and protection of IP rights overseas, agreements regarding the sale and distribution of products and services overseas, and establishing foreign offices.



CHRISTINA MORGAN - Christina is in the firm’s Litigation and Privacy practice groups. Christina is a Certified Information Privacy Professional. She was an in-house corporate attorney prior to joining the firm. She is well-versed in federal, state, and international privacy laws, including the California Consumer Privacy Act (CCPA) and the EU’s General Data Protection Regulation (GDPR). Christina routinely conducts privacy reviews for the firm’s clients, counsels these clients on privacy compliance, and drafts privacy policies.



MICHELLE PHAM – Michelle, who is a shareholder in the Intellectual Property and Litigation practice groups, focuses her practice on the development and protection of intellectual property in the U.S. and abroad. She helps clients strategically develop and protect their intellectual property. She routinely advises clients regarding copyright and trademark protection, acquisitions, licensing, risk assessments, and due diligence investigations. She manages domestic and international intellectual property portfolios for clients and regularly implements cost-effective copyright and trademark clearance, procurement, and protection strategies for her clients. She also represents clients regarding data privacy, domain name, rights of publicity, trade dress, trade secrets, social media, and digital and print advertising matters.



ERNIE BOOTSMA – Ernie is in the firm’s Corporate and Intellectual Property practice groups. He represents start-up to mature technology companies, and university/research institution clients, in a broad range of corporate and intellectual property matters. He serves on the Advisory Board for the Oregon State University Advantage Accelerator. His practice encompasses corporate formation, financing, corporate governance, mergers and acquisition, intellectual property, and other business matters. He has negotiated and closed complex merger and acquisition transactions, planned and counseled clients with regard to intellectual property protection and maintenance, structured and implemented licensing and distribution arrangements, and handled debt and equity financing transactions for clients in a wide variety of industries. He has been very active with the Oregon Entrepreneurs Network for more than 15 years, having served as the Chair of Angel Oregon. He has been selected as an Oregon *Super Lawyer* and received a listing in *Best Lawyers* several times.