



James M. Vickery

Partner

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James Vickery concentrates in technology licensing, strategic alliances, business contracts and intellectual property strategic planning and counseling, representing clients from emerging technology companies in venture funding stages to public companies in merger and acquisitions transactions.

James has been the partner in charge of the Intellectual Property and Technology Transactions group in DLA Piper's Austin office since 1999.

EXPERIENCE

- Negotiated buy- and sell-side spinouts of business units or product families involving division of IP assets, cross-licenses for fields of use or retained businesses, ongoing services and manufacturing agreements and non-compete provisions
- Managed IP issues for multiple mergers and acquisitions in the semiconductor field, including coordination of patent, licensing, IP litigation, trademark and product liability diligence and negotiating IP representation and warranties
- Negotiated major customer-side outsourcing transactions for IT services in the health care services field and worldwide deployment of a VoIP system
- Assisted a client in the transition from a product commercialization business model to a licensing business model involving a substantial patent portfolio, inbound patent licenses from multiple sources and the implementation of an outbound licensing strategy
- Drafted and negotiated numerous agreements for software as a service companies, including internationalization of end user agreements in more than 20 jurisdictions and negotiation of reseller and private label agreements for complementary applications
- Represented industry-standard-setting groups in the development of intellectual property policies and drafted membership, testing certification and licensing agreements
- Negotiated manufacturing and development agreements for integrated circuits, semiconductor, manufacturing tools and electronic devices

RELATED SERVICES

- Trademark and Copyright
- Mergers and Acquisitions
- Intellectual Property and Technology
- Corporate
- International Trade, Regulatory and Government Affairs

RELATED SECTORS

- Media, Sport and Entertainment
- Life Sciences

- Negotiated exclusive license and purchase option for a wireless technology spinout
- Negotiated and structured a complex field-of-use IP license for ultra-wideband technology
- Assisted clients in exploring various joint venture, partnership, or alliance relationships and structures
- Performed contractual and license right assessments for dispute resolution and advised clients on procedures to minimize legal risks
- Drafted and negotiated enterprise software licensing agreements and channel agreements
- Negotiated an international joint development and exclusive license agreement in display technology field
- Assisted in structuring special purpose vehicles to insulate intellectual property assets

CREDENTIALS

Admissions

- California
- Texas

Recognitions

The respected research publisher Chambers & Partners lists him in *Chambers USA*, saying he "is an excellent, deal-oriented attorney" and noting that clients praise his "fantastic negotiating and contract drafting skills." Chambers also hailed him for his "business sense, responsiveness, negotiation skills and sector knowledge" and quoted one client who said "he would be first on my list of lawyers I would recommend."

Prior Experience

Before joining DLA Piper, James practiced in the field of intellectual property transactions and litigation in the Bay area.

Education

- University of Texas

Memberships

- American Bar Association, Intellectual Property Section
- American Intellectual Property Law Association
- State Bar of California (1990)
- State Bar of Texas (1997)

INSIGHTS

Publications

Contract analysis in a crisis: flowcharts

7 April 2020

Flowcharts providing considerations for analyzing commercial contracts in the context of the COVID-19 pandemic through a logical process flow that can serve as a practical checklist.

The age of growing viral outbreaks: key contract considerations in a world facing the latest outbreak –

COVID-19 (Global)

13 March 2020

The effect of viral outbreaks on overall business continuity and performance as a priority in assessing operational, reputational and contract risks and their potential consequences and liabilities.

- Co-author, "COVID-19 Contract Issues Reach Beyond Force Majeure," *Law 360*, March 13, 2020
- Co-author "INSIGHT: Coronavirus Contract Considerations Beyond 'Act of God' Issues," *Bloomberg Law*, March 13, 2020