



**Mark C. Lehberg**

**Partner**

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Mark Lehberg focuses his practice in the area of business and legal counseling in connection with complex business and technology related transactions, including outsourcing transactions, cloud computing and software as a service (SaaS), intellectual property license agreements, strategic alliances, joint research and development agreements, joint ventures and other commercial transactions involving intellectual property assets.

Mark also works with clients to identify and develop creative solutions for managing key risk allocation issues in complex business and technology related transactions. He advises large public companies, startup companies and nonprofit companies in the development of intellectual property strategies, including strategies for the protection, licensing and other exploitation of intellectual property assets.

Mark also provides his clients with strategic counseling regarding structuring, negotiating and ultimately documenting:

- License agreements for patents, software, copyrights, trademarks and trade secrets
- Internet-related business agreements, including cloud computing and software as a service (SaaS) transactions
- Outsourcing agreements
- Agreements for product distribution, including OEM, distribution, sales representative and reseller agreements
- Manufacturing and purchase and supply agreements

- Intellectual Property and Technology
- Corporate
- Trademark and Copyright
- Mergers and Acquisitions
- Emerging Growth and Venture Capital
- Technology Transactions and Strategic Sourcing

- Life Sciences
- Technology
- Industrials
- Energy and Natural Resources
- Media, Sport and Entertainment

## RECENT MATTERS

- Represented leading wireless chip manufacturer in connection with the purchase of technology and intellectual property assets from

- an Israeli company that developed proprietary camera technology. The transaction involved complex intellectual property and technology issues, including licenses to technology, patent licenses, other patent rights, and technical services agreements
- Represented leading wireless chip manufacturer in connection with the purchase of technology and intellectual property assets from a Dutch company that developed proprietary antenna tuner products. The transaction involved complex intellectual property and technology issues, including licenses to technology, patent licenses, other patent rights, and technical services agreements
  - Represented leading wireless chip manufacturer in connection with the purchased technology and intellectual property assets from a Silicon Valley company that developed proprietary network on a chip (NoC) interconnect IP technology. The transaction involved complex intellectual property and technology issues, including licenses to technology, patent licenses, other patent rights, and technical services agreements
  - Represented a leading provider of content delivery network (CDN) services, in connection with an information technology and outsourcing transaction whereby the provider would provide its CDN services to one of the other leading CDN providers on a private label basis
  - Represented Dutch content security technology and service provider in connection with the preparation and negotiation of a master services agreement and multiple statements of work and service level agreements with a top three cable television company located in the United States. Under the agreement, the cable provider outsourced to the service provider the provision of certain keys and credentials provisioning services, including managing the creation, secure delivery, and archiving of keys accompanying security data such as certificates, credentials and files all for the purposes of securing content
  - Represented developer of massively multi-player online game (MMOG) in connection with the license and deployment of an online voice communications technology and service for multiple users of the MMOG. The technology is integrated into the game allowing gamers to communicate with each other while playing the game
  - Represented gemological laboratory in connection with the negotiation and preparation of a Patent License and Settlement Agreement, including payments for allegations of past infringement and royalties for licenses under certain patents.
  - Represented one of the world's leading content protection technology companies in a licensing transaction with one of the largest cable television operators in the United States in connection with securing content distributed by the cable operator
  - Represented New Zealand children's book publishing company in connection with transactions with large United States publishers
  - Represented a large outsourcing service provider in the preparation of a business process outsourcing (BPO) agreement with a Fortune 50 technology company outsourcing its finance and accounting functions on a worldwide basis
  - Represented a venture capital-backed private analytics company in connection with a license agreement with MasterCard International for fraud detection technology
  - Assisted a semiconductor chip packaging company with preparing and negotiating a patent license agreement with a Taiwan-based company to settle alleged patent infringement claims
  - Represented a multimedia broadcast company in the preparation and negotiation of license agreements, services agreements, hardware purchase agreement, service level agreements and hosting agreements with vendors and providers of (i) conditional access systems (CAS), (ii) customer relationship management (CRM) solutions, (iii) technology that enables the distribution of premium video content to portable wireless devices and (iv) call centers in connection with the launch of subscription services to consumers
  - Represented a private, venture-backed company in the preparation and negotiation of software license agreements with customer premises equipment (CPE) manufacturers and cable operators
  - Assisted clients in the preparation and negotiation of cross-license agreements for purchased and retained intellectual property in asset purchase transactions
  - Represented a joint venture established to market and sell HDTV products, including the preparation and negotiation of agreements with large retail chains, with third-party licensors of technology used in the HDTV products and with providers of warranty and reverse logistics services
  - Assisted a private company in the preparation and negotiation of a license agreement with a Fortune 100 company for certain nanotechnology
  - Assisted the largest US-based supplier of semiconductor test handling equipment used by semiconductor manufacturers in final test operations in connection with joint development agreements, product purchase and sale agreements and license agreements for new technology and software solutions
  - Represented a Fortune 100 consumer products company in the formation of a joint venture with a private venture-backed company to develop and commercialize new disinfectant products, including the preparation and negotiation of a development services

agreement, a license agreement between the joint venturers and a license agreement with The Regents of the University of California

- Assisted a radio frequency identification (RFID) technology provider in the preparation and negotiation of product sales agreements
- Represented a fingerprint sensor company in connection with development and license agreements
- Assisted a multinational wireless telecommunications company in the development of its OEM strategy for dealing with construction equipment manufacturers and the equipment owners' ability to collect operating statistics and location information about the equipment, including the preparation of form OEM agreements
- Assisted a DVB-H semiconductor company in the preparation and negotiation of development and licensing agreements
- Represented an outsourcing service provider in connection with customer contracts for the use of a proprietary web-enabled/hosted outsource solution for securely capturing, managing, delivering and preserving information and documents. Some of the client's customers host the solution in-house, and some use the client as the outsource service provider. Customers include large financial institutions and insurance companies
- Assisted a large theme park in the purchase and deployment of a new point-of-sale system for the park's retail locations, including outsourcing certain hosted services related to the system
- Represented a multinational wireless telecommunications company in the preparation of agreements with wireless device manufacturers, wireless telecommunications network operators and independent software developers in connection with the wireless downloading of games and other software applications to wireless devices
- Assisted a multinational wireless telecommunications company in the preparation of agreements with wireless telecommunications network operators in connection with broadcasting multimedia content to wireless devices
- Assisted an industry leading nonprofit entity in the development and implementation of an intellectual property strategy
- Assisted the largest developer of master planned residential communities in the United States in strategic alliances and co-marketing arrangements for the marketing and deployment of broadband, cable and telecommunications services within the developer's master planned communities. Assisted the developer with the formation and winding up of a joint venture for the deployment of Intranet solutions within those communities
- Represented the developer of digital communications technology solutions for the motion picture industry in the sale of the client's interest in a joint venture to the other joint venture partner, including the assignment and licensing of certain patents and technology to the other joint venture partner
- Represented a manufacturer of non-lethal weapons in the marketing and sale of the weapons in the consumer market

## CREDENTIALS

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### Admissions

- California

### Recognitions

The highly-regarded legal directory, *Chambers USA* has recognized Mark for his outsourcing work and noted, "[h]is outsourcing expertise is buttressed by his experience on technology commercialization. Clients state that he 'finds extremely creative and unique ways to solve issues.'" Mark has also been recommended by the respected legal directory, *The Legal 500 United States* for his patent work and was described as an "[e]xceptional attorney." Furthermore, the directory has recognized him for his technology work and noted he is "an excellent draftsman and a strong and professional negotiator."

In 2012, *Intellectual Asset Management* magazine recognized Mark for his patent licensing practice in its *IAM Patent 1000—The World's Leading Patent Practitioners*, which, the IAM editors note, "identifies world-class patent expertise at both the individual and firm level."

### Education

- J.D., Wake Forest University 1996  
*magna cum laude*  
Order of the Coif

- M.B.A., University of Rochester 1991  
Hugh H. Whitney Award for Academic Excellence
- B.A., University of San Diego 1982  
*summa cum laude*

## Memberships

- California Bar Association Intellectual Property Section
- Licensing Executive Society
- San Diego Software Industry Council
- CommNexus San Diego

## Civic and Charitable

- Provide advice and counsel to Sky Ranch Christian Camp
- Board of Directors, San Diego Software Industry Council (SDSIC)
- Provide advice and counsel to Horizon Christian Fellowship
- Instructor, San Diego High School Student Program, "When You Become 18"
- Prepared summary of Article 2 of the UCC for California Public Counsel
- Volunteer, Interfaith Community Services Legal Clinic
- Advise Food Research and Action Center (FRAC) regarding commercial transactions

## INSIGHTS

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## Publications

- 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

## Events

- Panelist, "Understanding Software as a Service (SaaS) 101," webinar, hosted by Knowledge Congress
- Instructor, Licensing Executive Society, Intellectual Asset Management (IAM) Professional Development Series, including IAM 205, "Licensing" and IAM 104, "Living with the Deal"
- Instructor, Licensing Executive Society, Professional Development Series Workshop, "Indemnification: Don't Bet the Company!"
- Instructor, San Diego State University, Intellectual Property seminar for Class on Entrepreneurship
- Association of Corporate Counsel, seminars regarding software licensing, cloud computing, off-shore outsourcing and open source software
- Panelist, Proformative Seminars, seminar dealing with cloud computing and software as a service (SaaS) applications for financial and accounting systems