



## → Michael D. Orlando

### Partner

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Michael Orlando is a corporate and intellectual property transactions attorney in the firm's San Diego (Del Mar) office. He is Team Leader of the firm's Technology Transactions Team.

Michael founded a software-as-a-service (SaaS) business prior to attending law school and brings a practical, business-oriented approach to his engagements that focuses on problem solving. Clients trust and enjoy working with him because he looks to understand the business objective behind his clients' decisions, focuses on what's important and works tirelessly to achieve those objectives. He is responsive to his clients' needs and keeps involved throughout each transaction.

### Areas of Practice

Michael advises clients on intellectual property development and licensing, outsourcing, joint ventures, mergers and acquisitions, venture capital financing and commercial transactions, including international transactions. He is particularly experienced in cross-border transactions in Europe and spent several months on secondment in Germany. He is consistently a ranked attorney in *Legal 500* in the Media, Technology and Telecoms category.

Michael's cross-disciplines in both intellectual property and corporate law allow him to leverage both practice areas when structuring transactions for his clients, including the use of joint ventures and strategic alliances in the financing, development and licensing of technology.

Michael's legal practice spans across multiple industries, including software, hardware, medical devices, biotechnology/pharmaceuticals, healthcare IT, financial services, consumer products, sports equipment, apparel, telecommunications, aerospace, automotive, food and beverage, energy and real estate.

Michael has extensive experience assisting companies with their intellectual property and commercial transactions, including:

- patent licenses, development and collaboration agreements, clinical trial agreements, and supply, manufacturing, distribution and other outsourcing agreements for pharmaceutical, biotechnology and medical device companies;
- software and hardware technology licenses, development agreements, SaaS agreements, maintenance and support agreements, service level agreements, cloud computing arrangements, strategic alliances, joint development agreements, manufacturing and supply agreements, OEM, VAR, reseller and distribution agreements;
- outsourcing agreements, including information technology outsourcing (ITO), business process outsourcing (BPO), technology development, manufacturing and supply agreements; joint ventures; and offshoring

arrangements;

- online advertising agreements, privacy policies, terms of service, website and mobile application development agreements, hosting agreements and e-commerce fulfillment agreements; and
- trademark licenses, merchandising agreements, distribution agreements, endorsement/sponsorship agreements, marketing agreements and sweepstakes/content agreements.

## Honors

Media, Technology and Telecoms, *Legal 500*, 2016-2020

## Experience

### Representative Transactions

#### *Technology Transactions, Outsourcing and Joint Ventures:*

- Represented a drug development company in an asset sale, license and commercialization agreement with Mayne Pharma Group Limited (ASX: MYX) regarding an FDA-approved dermatology product for treating plaque psoriasis.
- Represented R1 RCM (Nasdaq: RCM) in a strategic outsourcing agreement with Intermountain Healthcare to take over revenue cycle management operations for Utah's largest healthcare system.
- Represented Shanghai Fosun Pharmaceutical Co., Ltd., in a series of strategic investments in U.S. diagnostic companies and related exclusive license, manufacturing and distribution agreements for the technology in China.
- Represented Heritage Provider Network in the intellectual property licensing aspects of a large joint venture with Trinity Health for population health management.
- Represented Atara Biotherapeutics, Inc., in structuring a joint venture with Amgen and Kleiner Perkins Caufield & Byers for developing innovative therapies for patients with chronic diseases.
- Represented Elcelyx Therapeutics, Inc., in a spin-off of assets into Nazura BioHealth, Inc.
- Represented Amgen (Nasdaq: AMGN) in a large number of transactions with CROs, universities and research institutions around the world for clinical trials of several novel drug candidates.
- Represented a publicly traded pharmaceutical company in a series of development and manufacturing agreements (both clinical and commercial) in Europe and Asia.
- Represented Spy Optic in its licensing, endorsement, sponsorship, international distribution and manufacturing transactions.
- Represented Zeebo, Inc., in a joint venture with Qualcomm for the development of a video game console, as well as in its international distribution and licensing transactions.
- Represented Electronic Arts (EA) (NASDAQ: ERTS) in the license and development of mobile video game applications.

#### *Mergers and Acquisitions:*

- Represented adidas AG in the sale of Taylor Made Golf Company, including all transition services arrangements worldwide.

- Represented Ingram Micro (NYSE: IM) in its intellectual property licenses and transition services arrangements for the acquisition the Odin Service Automation platform and associated cloud management technologies from Parallels.
- Represented Diageo plc in its transition services and supply arrangements for the sale of its wine business to Treasury Wine Estates Ltd.
- Represented DJO Global in the acquisition of certain medical device assets from Zimmer Biomet, including post-acquisition transition services, supply and licensing arrangements.
- Represented Aduro BioTech, Inc., in the acquisition of all GVAX vaccine assets from BioSante Pharmaceuticals, Inc., and related technology transfer and licensing.
- Represented Taylor Made Golf Company in the acquisition of Adams Golf, Inc.
- Represented Alcatel-Lucent (NYSE: ALU) in the purchase of a software solutions provider.
- Represented VF Outdoor (NYSE: VFC) in the acquisition of adventure travel gear company, Eagle Creek.
- Represented Rusty Surfboards and the majority shareholder in the sale of the Rusty surf apparel company and post-acquisition licenses and services arrangements.

#### Venture Capital:

- Represented emerging companies in connection with their convertible note and seed financings and Series A preferred and later-stage financing rounds, including Cameo, Nanomedical Diagnostics, Symic Biomedical, Atara Biotherapeutics, Dart NeuroScience and Celula.
- Represented various inventors in connection with preferred stock financings, including Kleiner Perkins Caufield & Byers, Enterprise Partners, Accelerate-IT Ventures, Shanghai Fosun Pharmaceuticals, JAFCO, Nextech Ventures and Liquid Tribe.

## Articles

- "Using Term Sheets to Optimize Important Licensing Transactions," *Intellectual Property Licensing Strategies 2016 ed.* (Thomson Reuters/Aspatore Books), 2016
- "Key Contract Considerations and Governance Issues for Managing Outsourcing Risks," *Best Practice for Managing Outsourcing Transactions* (Thomson Reuters/Aspatore Books), 2014
- "Put Your Commission Contracts In Writing - It's The Law," *TransWorld Business*, May 24, 2012
- "Using Stock Options and Other Equity Incentives to Retain and Attract Talent," *TransWorld Business*, February 29, 2012
- Author, "Where Do You Want To Go Next? Evaluating Exit Strategies For Your Business," *TransWorld Business*, October 2007

#### Healthcare Law Blog Posts

- "HIMSS19 Kicks-Off Addressing Leading Topics in Healthcare Information Technology," February 13, 2019

## Speaking Engagements

"Health Wearables and Mobile Medical Devices: Keeping Pulse on Legal Issues," International Technology Law Association (ITechLaw), Speaker, November 10, 2016

"Cross-Border Issues," International Technology Law Association (ITechLaw), Panelist, May 19, 2016

"Know how and trade secrets - a global view," Terralex, Presenter, June 2015

"Managing Sourcing Successfully," Connect, Panelist, April 22, 2014

"What's New in China Pharma Partnering," BioPharma Partnering Forum, Panelist, April 29, 2013

"Venture Capital Financing in the Life Science Industry," Cal State San Marcos, Master of Biotechnology Program, Guest Lecturer, November 2012

"Legal Issues for Sports Startups," San Diego State University, Sports MBA Program, Guest Lecturer, 2011

"Increasing Income and Profit By Outsourcing Professional Help," ASR Tradeshow, Panelist, February 4, 2010

"Doing Business in China," California Society of CPAs, October 22, 2009

"Financing and Managing Your Business in a Down Economy," IASC Skateboarding Industry Summit, Panelist, April 4, 2009

"Bridging the Gap for Transactional Lawyers," San Diego County Bar Association, Panelist, June 24, 2008

"Internet Business Agreements: Key Issues and Practical Advice," Whittier Law School, Guest Lecturer, 2008

"Trials and Tribulations of Bringing a Product to Market," CEO Strategy Forum (Connect), Panelist, March 27, 2008

## Events

Licensing Basics

Third Thursday Emerging Company Webinar

09.17.2015

Licensing Basics

Third Thursday Emerging Company Webinar Series

via WebEx, 10.16.2014

Basics of IP Commercialization & Licensing

Third Thursday Emerging Company Webinar Series

via WebEx, 06.20.2013

## Memberships

San Diego County Bar Association

State Bar of California

Hawaii State Bar Association

American Bar Association (Business Section, Cyberspace Law and IP Committees)

National Eagle Scout Association

Software San Diego

International Technology Law Association

## Practices

Corporate

Emerging Company & Venture Capital

Joint Ventures and Strategic Alliances

Mergers and Acquisitions

Healthcare

Intellectual Property

IP Licensing, Technology and Commercial Transactions

International Reach

Technology Transactions

Trade Secrets

## Industries

Emerging Company & Venture Capital

Entertainment and Digital Media

Esports & Games

Fashion, Apparel and Beauty

Food and Beverage

Healthcare

Life Sciences and FDA

Sports

## Education

M.B.A., University of San Diego, 2003

J.D., University of San Diego, 2002

B.A., University of California, San Diego, 1998

## Admissions

California

Hawaii

## Languages

French