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White and
Williams LLP

White and Williams Assists Japanese IT Client in Cross-Border Joint Patent Application Agreement

11.12.20

White and Williams recently represented a Japanese manufacturer of document scanning equipment, sold worldwide, in a cross-border joint patent application agreement. Our client is collaborating with a Taiwan business partner in the development of an optical character recognition (OCR) component of our client's scanners. The invention that is the subject of the agreement was discovered by our client's engineers, who subsequently applied for a patent on the invention in Japan.

The White and Williams team worked with the client's internal legal department and Japanese patent counsel, with instructions partially in Japanese, to draft a joint patent application agreement in English, but governed by Japanese law, that met the client's criteria for ensuring the transfer of all rights to our client upon the withdrawal of the Taiwan partner as a co-applicant. Frank Bruno provided the IP expertise for the project, Patrick Devine handled the initial drafting, and Bruce MacLennan's fluency in Japanese enabled seamless communications with the client.

