

## ALAN S. WERNICK

ATTORNEY AT LAW – LICENSED IN IL, NY, OH, AND DC

**INFORMATION TECHNOLOGY, INTELLECTUAL PROPERTY, & DATA PRIVACY LAW**

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**ALAN S. WERNICK**, a Partner in the law firm of [FSB FisherBroyles, a Limited Liability Partnership](#), and a member of the bars in IL, NY, OH & DC, has a nationally recognized practice focused since 1982 on providing practical and strategic legal advice to clients on significant technology, electronic commerce and intellectual property transactions, data privacy and security. His experience in large law firms and as an in-house general counsel includes virtually every type of information technology contract and transaction, as well as serving as a counselor and advocate for his clients in the management and resolution of a wide range of legal disputes, including analysis of potential risks, dispute avoidance, negotiation of settlements, and guidance through litigation, appeals, and the arbitration/mediation processes. Supplementing his private practice experience, Alan has been an arbitrator/mediator for more than 25 years and has served on numerous panels involved with technology user/vendor disputes, IP, and/or licensing disputes, where he has been able to observe how other parties put technology deals together, how they fall apart, and how other lawyers do their lawyering.

A frequent lecturer and writer, Alan writes an *Info Tech Law* column for *Chicago Lawyer* magazine, and serves as Editor of the American Bar Association Business Law Section Cyberspace Law Committee *eNewsletter*. His writings have been published in a number of publications including the *National Law Journal*, *Licensing Law & Business Report*, *Business First*, *Electronic Commerce & Law Report*, *CCH Guide to Computer Law*, *Ohio Lawyer*, *Cyberspace Lawyer*, *Computer Negotiations Report*, *Journal of AHIMA*, and *Hamline Law Review*. Alan has been invited to lecture by numerous organizations including the American Bar Association, Illinois Institute for Continuing Legal Education, Ohio State Bar Association, The Conference Board Council of Chief Legal Officers, International Technology Law Association, Licensing Executives Society, The Ohio State University MBA Program, USC Law Center, International Association for Information and Data Quality, The Copyright Society of the USA, and the National Business Institute.

Alan has been recognized as a leader in his field through his selection as a *Leading Lawyer in Computer & Technology Law* (Leading Lawyers Network), as a Martindale-Hubbell® AV rated attorney, in the International Who's Who of Internet & e-Commerce Lawyers 2009. He serves on numerous Advisory Boards including Chairman of the Advisory Council for the *Guide To Computer Law* (Wolters Kluwer), [Fellow at Ponemon Institute](#), *Electronic Commerce & Law Report* Advisory Board (BNA), and the [Alumni Board for the Fisher College of Business at The Ohio State University](#).

In addition to his J.D., Alan has a B.S. in Accounting. His background and experience include having worked as an auditor, and as a Research Assistant doing computer programming and consulting at The Ohio State University Fisher College of Business and the College of Pharmacy.

## **LEGAL PROFILE**

General business law attorney highly experienced in information technology / intellectual property law (licensing, copyright, trademark, and trade secret), and data privacy/security, with both large law firms and in-house counsel experience. Publications, lectures, and transaction details available at [WWW.WERNICK.COM](http://WWW.WERNICK.COM).

### ***Highlights:***

- Counseled C-level executives on compliance and legal risk management of intellectual property assets and technology acquisitions. Created internal policies and procedures to enhance legal compliance and minimize legal risks. Resulted in improvements in client's legal risk management.
- Represented clients as primary negotiator and drafter for major, business critical, licensing and computer systems acquisition transactions involving millions of dollars of computer hardware, software, and systems. *To date, every major computer system acquisition agreement negotiated and drafted by Alan has gone to "system works" and none of them has ended in litigation.*
- Represented universities, nonprofit organizations, manufacturers, health care and research organizations, and other businesses in the acquisition of business critical computer systems and related matters.
- Represented retailer with 100+ stores to create e-commerce Internet site. Successfully negotiated with world's largest on-line shopping site for implementation.
- Represented major online courseware development consortium in negotiating and drafting multiple licenses and related agreements to deliver online continuing education courses.
- Represented retailer with 100+ stores in acquiring satellite communications services to connect all their stores back to their home office with real time data and communications (as well as in-store Internet connectivity).
- Represented clients in addressing legal issues involving the Internet including web site development agreements, web site hosting agreements, framing and linking legal concerns, content acquisition and protection, applications service provider agreements.
- Represented clients in addressing open source code legal issues.
- Represented non-profit and for profit businesses in navigating their e-commerce legal and compliance issues. Resulted in the successful implementation of their e-commerce Internet sites.
- Represented insurance company in the outsourcing of its data processing department. Successfully negotiated with one of the world's largest outsourcing provider for a money-back guarantee (indemnity) on portions of the project.
- Created uniform alert methodology, registration, and monitoring process to minimize trademark and copyright misuse for clients including addressing the legal risks of individual employees creation of several hundred Internet domain names used by large retailer. Resulted in improved client controls and protection of ownership interests in their copyrights, trademarks and domain names.
- Represented major metropolitan libraries in acquisition of computer systems.
- Developed computer vendor form agreements on behalf of Fortune 500 company for e-commerce sale and distribution of computer hardware and software. Agreements addressed scope of use, warranties, limitation of liabilities and other relevant terms resulting in increased efficiencies and improved risk management for the vendor.
- Since 1984 served as an arbitrator and/or mediator in a number of cases involving disputes concerning major computer system failures, computer contract user/vendor disputes, infringement, and licensing disputes.

## **TRANSACTIONAL EXPERIENCE: Information Technology Law/E-Commerce/Internet Law and Intellectual Property Law and Data Privacy Law**

**Information Technology:** Negotiating and drafting of technology transfers and licensing agreements; outsourcing agreements; acquisition of business critical computer systems agreements; cloud computing agreements; open source software licensing; data breach matters; privacy law compliance; national and international software licensing; custom computer software development projects; marketing and distribution of computer-based and on-line information, computer programs, and data; U.S. software export regulations compliance; government software contracts; software ownership agreements; system integration projects; hardware and software maintenance agreements; acceptance certifications; source code escrow agreements; private branding agreements. Counseling of clients in the information technology law and intellectual property law aspects of buyers' and sellers' due diligence in mergers and acquisitions. Representation of clients in user-vendor disputes litigation, arbitration, and mediation.

**E-Commerce/Internet Legal Matters:** Negotiating and drafting of contracts for content licensing; protection of clients' intellectual capital on the Internet; DMCA issues; data privacy issues; web site development agreements; web site hosting agreements; domain name acquisitions; linking agreements; portal and exchange development projects.

**Copyright:** Negotiating and drafting copyright licenses; obtaining copyright in works for hire; counseling clients on statutory compliance with copyright laws, content acquisition and portfolio management; obtaining a security interest in copyrighted works; assignments of copyrights; representation of clients in copyright infringements; representation of authors in publishing contracts; prosecution of copyright registrations including online registration of copyrights.

**Trademark:** Counseling clients on compliance with trademark laws and trademark portfolio management; trademark and Internet domain name issues; trademark portfolio management; UDRP compliance; trademark acquisitions; licensing of trademarks; prosecution of federal and state trademark registrations; representation of clients in trademark infringements.

**Trade Secret:** Negotiating and enforcing confidentiality and non-disclosure agreements; advising on legal methods to protect trade secret intellectual capital and data privacy; employee exit interview procedures.

**Data Privacy:** Counseling clients on regulatory compliance with various data privacy laws, drafting of various privacy policies including company information privacy policy, data protection policy, Internet usage policy, business partner privacy policy, and data breach compliance policy, as well as providing related training.