

# Sean C. Fifield Partner

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Sean's understanding of intellectual property law and his pivotal role in significant transactions, such as representing a global pharmaceutical company's acquisition of a specialty firm and negotiating critical platform licenses, make him a trusted advisor for protecting and leveraging intellectual assets.

# **OVERVIEW**

Sean focuses on intellectual property matters, including the protection and licensing of copyrights, trademarks, and trade secrets. He represents clients across various industries, such as consumer food products, manufacturing, specialty chemicals, digital media, banking, insurance, hospitality, and entertainment.

Sean assists clients with the selection, screening, registration, and protection of trademarks, and assists with negotiating and drafting patent, trademark, and software licenses. His work extends to information technology agreements, including application service provider arrangements and outsourcing transactions. He also has significant experience preparing and responding to cease and desist letters involving trademark, copyright, and patent infringement.

Sean also advises clients on mergers and acquisitions, general business contracts, and financing transactions involving significant intellectual property assets. He represents clients in significant deals, such as the negotiation of master agreements for platform-as-a-service solutions, technology licenses for drilling rig monitoring systems, and the acquisition of specialty pharmaceutical companies.

Clients appreciate Sean's comprehensive approach and his dedication to their success. They often highlight his ability to navigate complex legal landscapes, helping to ensure robust protection and strategic utilization of their intellectual property assets.

# REPRESENTATIVE MATTERS

### **Intellectual Property**

- Advised a health insurance company in connection with licensing a dedicated LLM artificial intelligence tool for use across internal systems.
- Represented an online food delivery service in negotiation of agreements for the acquisition and implementation of an automated robotic system for warehouse operations.

- Represented a pharmaceutical company in a cross-border licensing and technology transfer transaction with a pharmaceutical development and commercialization partner.
- Represented a diversified metal service center firm in the protection of its trademark portfolio and other intellectual property.
- Represented a health insurer in the negotiation of master agreement for platform-as-a service solution.
- Represented an energy infrastructure company in the disposition and license back of water purifying technology.
- Represented an oilfield services company in the negotiation of a development agreement and technology license for drilling rig monitoring systems and software.
- Represented a health care benefits company in connection with the negotiation of an alliance agreement involving the development of wellness software apps for wearable personal devices.
- Represented a specialty food product manufacturer in the negotiation of a merchandising license agreement with a major film studio.
- Represented a public transit agency in the negotiation of agreements with vendors and other public transit agencies for the development and operation of a mobile application for fares across multiple transit systems.
- Represented a component manufacturer in the negotiation of a joint development and supply agreement with a *Fortune* 500 white goods appliance manufacturer.

# Merger and Acquisitions, General Corporate

- Represented a bicycle manufacturer in the sale of its subsidiary operating bicycle sharing systems.
- Represented a temperature control technology firm in the divestment of a portfolio of patents and related technology transfer to a consumer goods company.
- Represented a newspaper publisher in the sale of its printing facility and the negotiation of printing services agreement with new owner.
- Advised a family-owned multinational manufacturing company in the overhaul of shareholders buy-sell agreement.
- Represented a global pharmaceutical company in the acquisition of a commercial-stage specialty pharmaceutical company.
- Represented a hearing care product manufacturer in the acquisition of a provider of business and performance management solutions to an independent hearing care practices for approximately \$150 million.
- Represented a payment processing services provider in the sale of its business to a private equity purchaser for \$225 million.
- Represented a health insurance company in the \$65 million acquisition of a health information technology service company.
- Represented a hearing care product manufacturer in connection with the establishment of joint venture and financing arrangements with distributors of its products.

# **AWARDS**

- The Best Lawyers in America®: Insurance Law (2025-2026)
- World Trademark Review WTR 1000 (2023-2025)

# **TOP AREAS OF FOCUS**

- Corporate
- Intellectual Property

- Mergers + Acquisitions
- <u>Technology</u>
- Trademark + Copyright

# **ALL AREAS OF FOCUS**

- Corporate
- Intellectual Property
- Marketing + Advertising
- Mergers + Acquisitions
- <u>Technology</u>
- Trademark + Copyright

## PROFESSIONAL/COMMUNITY INVOLVEMENT

- Member, Chicago Bar Association
- Member, Los Angeles County Bar Association
- Member, American Bar Association

# **EDUCATION AND CERTIFICATIONS**

#### **EDUCATION**

- University of Michigan Law School, J.D., 1996, Michigan Journal of International Law
- University of Michigan, B.S.E., cum laude, 1993

## **BAR ADMISSIONS**

- California
- Illinois

# SPEAKING ENGAGEMENTS

 Speaker, "Managing the Impact of the Coronavirus Outbreak on the Supply Chain," International Chamber of Commerce, March 2020.

# **PUBLICATIONS**

- Author, "<u>The Madrid Protocol</u>," *Troutman Pepper Locke*, September 2, 2025 updated annually since September 2020.
- Author, "Registering Trademarks Under the Madrid Protocol", The Global Trade Law Journal, November-December 2024.