



Renato Smith

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Partner

Syracuse

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Education

- University of Illinois College of Law, JD
- University of Illinois, BS
- Wharton School of the University of Pennsylvania, Certificate: Introduction to Financial Accounting
- Synopsys, Inc., Certificate: Black Duck Software Audit Process

Practices & Industries

- Communications & Networking Technology
- Corporate
- Data Security & Technology
- Emerging Technologies
- Medical Devices
- Outdoor & Wildlife
- Patents & Prosecution
- Technology
- Trademarks, Copyrights & Licensing

Admitted to Practice

- New York
- Illinois
- US Patent and Trademark Office

Biography

Renato serves as co-chair of Barclay Damon's Data Security & Technology Practice Area. Primarily focused on commercial transactions involving licensing and technology-based products and services, Renato assists companies and entrepreneurs with contracts, licensing, complex business transactions, dispute resolution, intellectual property strategies, and patent and copyright applications. He has counseled clients in a wide array of industries, including health care, education, software, cloud computing, telecommunications, and electrical power utility.

For online and offline transactions, Renato counsels clients and drafts and negotiates numerous types of contracts, including website and online terms of use, privacy policies, privacy notices related to the California Consumer Privacy Act (CCPA), cookie policies, cookie consent banners, accessibility policies, platform services agreements (PSAs), cloud services agreements, software as a service (SaaS) agreements, end user license agreements (EULAs), service level agreements (SLAs), mobile app license agreements, master services agreements (MSAs), master license agreements (MLAs), sponsored research agreements (SRAs), and material transfer agreements as well as agreements involving confidentiality; patent, trademark, and copyright licensing; collaboration; joint development, technology transfers; asset purchases; sponsored research; software; mobile apps; product champions; product development; manufacturing; distribution; brand development; and copyright releases. In drafting and negotiating many of these contracts, Renato addresses cyber-risk liabilities, data protection obligations, and compliance with data privacy laws, including the CCPA, the European Union's General Data Protection Regulation (GDPR), the US Health Insurance Portability and Accountability Act (HIPAA), and the US Family Educational Rights and Privacy Act (FERPA).

Renato has conducted dispute resolution and contract negotiations in the United States and abroad, including

negotiations in Australia, Europe, and Taiwan, drafting responses and settlement, termination, and amendment agreements involving infringement, breach of contract, Better Business Bureau (BBB) complaints, and credit card payment disputes. In connection with infringement disputes, Renato has performed analysis related to intellectual property infringement, design-around, and invalidity strategies.

Additionally, Renato has drafted and prosecuted hundreds of patent applications for inventions in the software, electrical, and mechanical industries that include medical devices, surgical systems, telecommunication devices, antennas, software, mobile apps, electronic gaming devices and systems, vehicles, power equipment and machinery, computers, consumer appliances, database structures, e-commerce systems, and business methods.

In addition to his own practice, Renato serves as DEI advisor to the Summer Associate Program.

Bar Associations

- Illinois State Bar Association
- National Bar Association, Intellectual Property Law & Criminal Law, Juvenile Justice Sections
- New York State Bar Association
- Onondaga County Bar Association, Diversity and Inclusion Committee

Selected Memberships & Affiliations

- American Intellectual Property Law Association
- International Association of Privacy Professionals
- National Society of Black Engineers, Intellectual Property and Entrepreneurship Special Interest Groups
- Northwestern Mutual Black Founder Accelerator®, Mentor

Representative Experience

- Drafted, negotiated, and closed a \$10 million asset-purchase agreement representing a Fortune 500 company in its acquisition of a solar-power generation site.
- Drafted and negotiated military supply, development, and license agreements with the governments of Pakistan and Hungary involving radar technologies.
- Led post-suit settlement discussions and drafted and negotiated settlement agreements for clients charged with breach-of-license agreements and intellectual property infringement.

- Managed international patent portfolios of Fortune 500 companies for an array of product lines, including medical devices, consumer appliances, air purifiers, gaming devices, and tractors.
- Executed design-around strategies for companies charged with patent infringement.
- Built invalidity defenses for companies charged with patent infringement.
- Drafted and negotiated multi-million product-development and patent-license agreements representing pharmaceutical manufacturers.
- Drafted and negotiated a worldwide brand-development agreement for a Fortune 500 consumer-product manufacturer.
- Performed an onsite intellectual-property audit of a food manufacturer and prepared IP procedures and policies for the manufacturer.
- Conducted IP due diligence for numerous mergers and acquisitions.
- Performed in-person contract negotiations in Asia related to the development, manufacture, and licensing of electronic products.
- Co-founded a start-up venture that patented an electronic product, manufactured the product overseas, and successfully brought the product to the marketplace with worldwide sales.
- Serves as outside intellectual property and licensing counsel for a provider of cloud-based health care solutions.
- Serves as outside intellectual property and licensing counsel for a global clinical trial data management company.
- Serves as outside intellectual property and licensing counsel for a software and hardware manufacturer in the media and broadcasting industry.
- Served as outside intellectual property and licensing counsel for a software manufacturer.
- Served as outside intellectual property and licensing counsel for a financial technology company.
- Serves as outside intellectual property and licensing counsel for a learning platform provider.
- Served as outside intellectual property and licensing counsel for a medical device manufacturer.
- Serves as outside intellectual property and licensing counsel for a university.
- Served as outside intellectual property and licensing counsel for a network of high schools.
- Served as outside intellectual property and licensing counsel for a gaming software manufacturer.

- Served as outside counsel for a multinational automobile and defense manufacturer.
- Serves as outside intellectual property and licensing counsel for a hospital system.
- Served as outside intellectual property and licensing counsel for a Fortune 500 energy company.
- Served as outside counsel for a Fortune 500 energy company.
- Served as outside intellectual property and licensing counsel for a publicly traded pharmaceutical manufacturer.
- Represented a client in asserting its trademark rights against a tour management company relating to the title of its nationwide hip-hop concert tour, which featured several top Billboard artists, resulting in the company's rebranding of the tour, settlement payment, abandonment of its pending trademark applications, and agreement to cease use of our client's trademark.

Prior Experience

- FisherBroyles, LLP, Partner
- Originatic LLC, General Counsel and Co-Founder
- K&L Gates LLP, Partner
- Holleb & Coff, Associate

Selected Community Activities

- New York State Science & Technology Law Center at Syracuse University, Advisory Board Member

Selected Speaking Engagements

- Strategic Health Information Exchange Collaborative, "Protecting IP and Avoiding Disputes" webinar
- Licensing Executives Society, "Strategies for Intellectual Property License Agreements – Thorny Issues, Case Law, and Drafting Techniques" CLE
- Biomedical Engineering Society, "Tech Transfer and Licensing: Best Practices in Transferring Technologies From Academia and the Clinic Into Industry," Moderator
- StartFast Venture Accelerator, "Open Source Legal Considerations for Proprietary Software Development"
- Chicago Bar Association, "Buying and Selling a Business: Intellectual Property Considerations"

Selected Media

- Law360 Pulse, "Barclay Damon Restructures Cybersecurity, IP Groups"
- *Buffalo Business First*, "Three Key Legal Obligations to Consider With Digital Twins"
- Law360, "New Strategies for Licensing of Multicomponent Inventions"

Selected Alerts & Blog Posts

- ELVIS Act Puts Users of Artificial Intelligence on Notice
- Updated Bulletin on Tracking Technologies in the Health Care Industry
- FTC Amends Safeguards Rule to Require Reporting of Data Security Breaches to the FTC
- Recent NYS Attorney General Data Security Settlement Highlights Importance of Addressing Security Deficiencies and Managing Vendor Relationships
- New York State Labor Law Amended: New Provision Regarding Employee Inventors