

CRONIN

A PROFESSIONAL LIMITED LIABILITY COMPANY

Intellectual Property Law
Including Business and Technology Transactions,
Patents, Trademarks, Copyrights and Social Media

KIRBY CRONIN

Kirby Cronin's primary expertise is in intellectual property and other technology-related transactions and related litigation, as well as trademark matters. However, Mr. Cronin is often also consulted by his clients for their various other intellectual property needs, and he has significant experience in a variety of additional areas, such as commercial litigation, commercial and general business transactions, and employment matters.

In almost 25 years of legal practice in private law firms and as in-house counsel for Computer Sciences Corporation, Mr. Cronin has developed extensive experience preparing custom agreements, adapting existing agreements to address his clients' needs, and acting as lead negotiator for his clients in hundreds of transactions involving a wide variety of simple and complex software and hardware, e-commerce, ASP, SaaS, outsourcing, joint marketing, asset acquisition, and similar transactions. He routinely leads or assists in negotiations opposite Fortune 100 U.S. companies, such as ExxonMobil, AT&T, Dell, HP, Hewlett Packard Enterprises, J.P. Morgan Chase, IBM, Capital One, Microsoft, Dow Chemical, United Airlines, Delta Air Lines, Intel, Cisco, Wells Fargo, and Oracle, as well as other notable entities, such as J.D. Power and Associates, VMware, Wolters Kluwer, Rackspace, Symantec, salesforce.com, Workday, Aramark, Halliburton, KPMG, Nabors, Emerson, Ericsson, Sony, the University of Texas, and the University of Oklahoma.

Mr. Cronin's transactional experience includes hundreds of matters involving financial institutions and vendors serving those entities. Mr. Cronin's financial institution clients specifically look to him for guidance on their transactions because he spent a significant portion of his legal career as in-house counsel for Computer Sciences Corporation in its Financial Services Group. There he developed an understanding of how vendors approach their agreements, including such things as revenue recognition concepts and other quarter-end considerations that often influence negotiations. As a result, Mr. Cronin is regularly called on to negotiate agreements opposite common financial industry vendors serving both large and small financial institutions, such as Fidelity, Wolters Kluwer, SunGard (now part of Fidelity), CGI, Cardtronics, Equifax, Experian, Fiserv, Moody's, NCR, Finastra (formerly Misys and D+H), SEI, Visa, Mastercard, Yodlee, Jack Henry & Associates, Accuity, Bloomberg, PULSE Network, CoStar, Datacard, Dunbar, eFunds, First Data, Harland Financial Services, Garda, Loomis, Brink's, McKinsey & Company, and Rochester Armored Car.

A small sample of Mr. Cronin's transaction-related experience includes:

- Performing all legal functions for one of the largest information technology companies in the world for the acquisition of a next generation expert software system developed in Australia, including performing pre-acquisition due diligence, drafting necessary agreements, leading the negotiating team, and ensuring compliance by the seller with its post-acquisition obligations;

- Leading negotiations for a banking client in its hardware acquisition transactions with leading international hardware providers in support of its establishment of a brand new, state-of-the-art technology center;
- Leading negotiations for a supplier of ATMs and ATM software to supply a full feature software system to one of the nation's leading financial institutions on an enterprise-wide basis to operate and manage such institution's entire fleet of ATMs in the U.S.;
- Leading negotiations for a large municipal utility provider to obtain and implement a SaaS solution to manage hundreds of thousands of new smart meters from a Canadian vendor.
- Leading negotiations for a client to convert its payroll and employee benefits systems for approximately 4,000 employees onto a SaaS platform hosted by a leading human resources management vendor;
- Leading negotiations for a bank on an exclusive branding agreement with an ATM operator to double the client's fleet of branded ATMs;
- Drafting a data license agreement for, and leading negotiations on behalf of, a publishing and television information company to complete a long-term relationship with a large, national television service provider;
- Leading negotiations for an ATM manufacturer to develop a next generation of multi-function ATMs for one of the largest U.S. banks;
- Assisting a small software development company with a multi-million-dollar service agreement to enable a large, international chemical manufacturer to reverse engineer and then migrate its outdated, legacy software systems used in its manufacturing process into a more sustainable programming language;
- Assisting a specialty lending entity with structuring a multi-vendor, end-to-end replacement of the lending entity's in-house loan origination system, including leading negotiations with multiple vendors to obtain thorough contractual coverage of the resulting multi-tool system and integration services;
- Assisting multiple clients in negotiating advertising agency agreements with marketing agencies;
- Assisting a client with multiple sports sponsorship agreements with public and private universities;
- Assisting a large bank with the transfer or termination of dozens of agreements from another bank as part of a merger of the two banks, including leading negotiations with international credit card providers and credit card processors;
- Assisting a large restaurant chain with a sponsorship agreement for an NBA team, including leading related negotiations with the arena operator for the right to operate concession stands during the team's games played in that arena;

- Leading negotiations for an alumni association to continuing its use of a private university's trademarks as part of the settlement of a high-profile lawsuit between the alumni association and the university;
- Leading negotiations with a major U.S. airline for a small specialty software provider to apply unique software translation tools to assist the airline in redeveloping its reservation system to a newer, more sustainable programming language;
- Leading negotiations for a small software provider to renew and extend its agreement with a major U.S. airline for the continued long-term licensing and maintenance of the software provider's fleet and passenger management system;
- Crafting and leading negotiations for a specialty lending institution with a major international software provider for a one-off incentive agreement related to the timely and accurate development of a software system for the lender's core business operations;
- Leading negotiations for a large regional restaurant chain to license its trademarks to multiple manufacturers of varying affinity products for resale to consumers; and
- Developing form agreements for a small, start-up SaaS provider that facilitates detailed wayfinding functionality on third-party websites, including leading negotiations for same with major universities for application to their newly launched medical centers.

In addition, Mr. Cronin has a busy and ever-growing trademark practice. Mr. Cronin is now lead counsel on more than 600 domestic and foreign marks for more than three dozen clients. Mr. Cronin's trademark practice includes clients in a variety of industries, such as restaurants, banks, home décor manufacturers, utility providers, telecommunication providers, software developers, distillers, consumer product retailers, consumer packaged goods manufacturers, and several charitable entities. In addition, Mr. Cronin regularly assists his clients in policing and enforcing their trademark rights, as well as defending against other parties attempting to enforce their trademark rights against his clients.

General intellectual property counseling is an additional important part of Mr. Cronin's practice. The firm's clients have sought his counsel on a variety of matters, like intellectual property due diligence related to pending mergers and acquisitions, potential legal issues implicated by the development of new software, strategies for responding to requests for proposals from governmental entities, strategies for protecting and monetizing new intellectual property, issues related to privacy laws, and strategies to avoid costly litigation, to name just a few. He also is consulted frequently regarding social media issues and issues related to contests and other promotions.

Mr. Cronin also has a broad litigation background. Prior to practicing in-house, he was part of a busy trial and appellate practice handling employment, construction, insurance, admiralty and intellectual property matters. Once in-house, his Fortune 500 employer relied on him to manage a number of complex litigation matters, including a large multi-defendant class action. As a result, he has extensive experience in the identification, preservation, and collection of discovery materials, counseling business professionals about litigation, and managing litigation teams.

Mr. Cronin studied international business and marketing as an undergraduate at the University of Texas, where he received a Bachelor of Business Administration with honors in 1991.

He received his Juris Doctor with honors from the University of Texas School of Law in 1995. He is admitted to practice before the United States District Courts for the Northern, Southern, and Western Districts of Texas, the United States Court of Appeals for the Fifth Circuit, and Texas state courts, and is a Fellow of the Texas Bar Foundation.

In 2020, Mr. Cronin began teaching a course in Transactional Drafting at the University of Texas School of Law.