



Sunny J. Kumar

Special Counsel

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OVERVIEW

Sunny Kumar is special counsel at the firm's London office. He is a member of the IP procurement and portfolio management practice group.

Prior to joining the firm, Sunny served as a senior associate for a magic circle law firm based in London. Sunny is an intellectual property lawyer and advises on contentious and non-contentious trademark, copyright, patent, design, advertising, licensing, commercial and data privacy matters. He has extensive experience in working with clients on their strategic IP projects across multiple jurisdictions.

Sunny has drafted a variety of technology transaction agreements, either for standalone IP transactions or as part of wider transactions, including mergers and acquisitions, divestitures and private equity investments. Sunny also helped clients to negotiate IP and technology transfers, IP licenses, development & collaboration agreements, joint ventures, acquisitions/sales documentation, and other commercial contracts (such as supply and distribution agreements). In addition to these transactions Sunny regularly advises clients across a plethora of cutting edge and complex technologies ranging from AI, blockchain, data analytics, digital health and mobile payment systems.

Sunny has also significant litigation experience having represented his clients before the High Court, Court of Appeal and Supreme Court. Additionally, Sunny regularly works with his clients to manage and enforce international trademark and design portfolios and regularly advises on related clearance issues. His broad range of experience includes acting and appearing in contentious trademark opposition proceedings before the UKIPO, EUIPO and CJEU.

Sunny has worked in house as a lawyer at the BBC and has particular experience in the field of media and entertainment law, having advised national broadcasters and independent studios on a plethora of strategic IP and commercial matters.

Sunny's background in medicine and neuroscience has allowed him to add considerable value to matters of a scientific or technical nature. He regularly advises pharmaceutical, biotechnology and medical device companies on regulatory issues concerning their business.

PROFESSIONAL / CIVIC ACTIVITIES

- International Trade Mark Association
- AIPPI
- Marques
- Tech UK

EDUCATION

- PGD, University of Oxford, 2015
- Legal Practice Course, College of Law, Birmingham, 2011
- CPE, University of Sussex, 2010
- B.Sc., University of Sussex, 2009
- B.M.B.S., Brighton and Sussex Medical School, 2008

ADMISSIONS

- Solicitor of the Senior Courts of England and Wales

LANGUAGES

- German
- Gujarati
- Hindi

THOUGHT LEADERSHIP POWERED BY HUB

- 30 June 2021, EU-UK Adequacy Decisions Finalized (*Alerts/Updates*)
- 29 October 2020, K&L Gates Black History Month Panel (*Webinar*)
- 13 October 2020, The Future of Work in a Post COVID-19 Work Environment (*Webinar*)
- 30 September 2020, Deep Fakes, Inventorship and Ethics – WIPO Revised Issues Paper on Artificial Intelligence (*BlogPost*)
- 7 January 2020, More than financial – blockchain’s potential in the healthcare and life sciences industries (*BlogPost*)
- 18 December 2019, Does AI generated work give rise to a copyright claim? (*BlogPost*)

OTHER PUBLICATIONS

- "International Trademark Licensing," *Wolters Kluwer Legal & Regulatory*, 12 August 2021

NEWS & EVENTS

- 5 August 2021, K&L Gates Advises Proxima Group on EST Partners' Support for Proxima's Buy and Build Programme (*Noteworthy Work*)
- 27 May 2021, K&L Gates Advises Dianomi PLC on AIM Admission and Fundraising (*Noteworthy Work*)
- 4 November 2020, K&L Gates Assists Prenetics in Acquisition of Oxsed RaViD's Rapid Coronavirus Diagnostics Technology (*Noteworthy Work*)
- 29 October 2020, K&L Gates Black History Month Panel (*Event*)
- 28 October 2020, K&L Gates AIM Update (*Practice & Regional News*)
- 13 October 2020, K&L Gates Advises Fonix Mobile plc on AIM Admission and Fundraising (*Noteworthy Work*)
- 18 September 2020, K&L Gates Advises Red Ventures on USD \$500 Million Acquisition of CNET Media Group from ViacomCBS (*Noteworthy Work*)

AREAS OF FOCUS

- IP Procurement and Portfolio Management
- Data Protection, Privacy, and Security
- Digital Health
- Mergers and Acquisitions
- Technology Transactions and Sourcing

INDUSTRIES

- Artificial Intelligence and Machine Learning
- Blockchain
- Consumer Products
- Cybersecurity and Privacy
- Data Analytics
- Luxury Products and Fashion
- Technology

- Telco

REPRESENTATIVE EXPERIENCE

- Advised a regional water company on an extensive internal GDPR project to ensure all policies were in place before the new regulations came into force. Subsequent work included specific advice relating to policy formation for the management and transfer of employee data to third party service providers and providing in-house training on GDPR to relevant employees.
- Advised a leading energy supplier on how to engage with consumers via email and online marketing strategies whilst being compliant with the Data Protection Act 2018.
- Advising the Cobalt Institute on the retention of sensitive personal information concerning its members and the necessary consents required under the GDPR. We are also currently clearing their entire website for any potential data protection and copyright infringement risks.
- Acted for a leading Energy company in outsourcing all of its HR functions to a third party services provider. I drafted all outsourcing agreements including the drafting and negotiations of the service level agreement which was also required.
- Acted for BlackRock Ltd on the sale of its pension administration business to Aegon Plc. I drafted and negotiated the transitional services agreement which was necessary for the transaction as well drafted various software licence agreements. I also negotiated and drafted all the IP warranties in the main Sale Agreement.
- Acted for two major utility companies on data protection breaches concerning its customer's personal data. Worked with the client to immediately put into place an action plan and guided the client through all communications and interactions with the ICO. In both cases fines were avoided and revised data protection breaches strategies were drafted in case of future accordance and to mitigate risk.
- Acted for various software companies based in the UK, the US, Europe and Asia to deliver their bespoke software as a service applications to UK consumers, ensuring that in each SaaS agreement, the terms are tailored to the client's individual needs and negotiated in a way to meet the clients' objectives.
- Acted on behalf of the world's leading defence and missiles manufacturer on a joint venture with a Middle Eastern entity. IP was critical to this particular transaction and I led a complicated IP audit.
- The Carlyle Group in their acquisition of Accolade Wines which includes the brands, "Hardy's" and "Banrock Station". Managed all aspects of the IP due diligence and advising on appropriate action needed to be mitigate high risk brands which were to be acquired.
- Acted for a Saudi entity on the formation of a JV to launch a free to air channel in the Kingdom of Saudi Arabia and Dubai. Advising on all aspects of the Brands Licence, Programme Supply Agreement, Editorial Policy and Regulatory compliance with Ofcom's Broadcasting Code.
- Providing ongoing advice to a Malaysian digital broadcaster on possible anti-piracy initiatives against suppliers of pre-loaded KODI boxes.

- Acted for Sky Pharma Plc on a complex due diligence exercise in connection with its all share merger with Vectura Group Plc. I reviewed all its IP assets, predominantly relating to collaboration and licensing agreements of various medicinal products.
- Advised a Dutch pharmaceutical company on the best possible way to terminate negotiations relating to the development of a statin-based drug.
- Acted for Imagem CV, one of Europe's largest music publishers on its sale to Ole Music Management of Canada. I drafted the copyright assignment agreements.
- Provided regulatory advice to a German pharmaceutical company on the advertising and marketing of its medicinal product and device in the UK and advice on how to oppose misleading advertising claims concerning the drug of a competitor company.
- Acted for a in-vitro medical devices company in the UK on a pre-auction VDD report. I have been responsible for drafting the regulatory section and specifically checking that the company has complied with the requirements of the In Vitro Diagnostic Medical Devices Directive 98/79/EC as well as compliance with US equivalence (subject to review by our US lawyers).
- Astex Therapeutics v AstraZeneca AB matter relating to a contractual dispute concerning a candidate drug and whether it is captured by the terms of the collaboration agreement.
- Acting on behalf of the Government of Cyprus enforcing their rights against infringers of its UK certification mark and EUTM collective trade mark for HALLOUMI cheese.
- Instructed external counsel on an extended form passing off action including drafting instructions to counsel. This matter has also included, drafting grounds for invalidation based on bad faith and relative grounds and drafting all replies as well as a settlement agreement in our client's favour.
- Trade marks portfolio work for a global bank and undertaking various trade mark clearance searches and compiling reports assessing the risk of any possible opposition, infringement and/or passing off action being initiated.
- Acting on behalf of a Middle Eastern sovereign government to develop a Media City in its capital. An interesting project involving the drafting of broadcasting, publishing, data protection and intellectual property regulations; and drafting all necessary media agreement templates including content licenses, distribution and carriage agreements and prop hire agreements.
- Acted on behalf of a leading private equity house in their acquisition of an international wines business including a portfolio of international wine brands. Managed all aspects of the IP due diligence and advising on appropriate action needed to be mitigate high risk brands which were to be acquired.