



Renato Smith-Bornfreedom

He | Him | His

Partner

New York

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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

Biography

Renato, co-chair of Barclay Damon's Data Security & Technology Practice Area, focuses his practice on counseling clients in the areas of data privacy, cybersecurity, intellectual property, and commercial transactions. Renato applies his engineering background and grasp of technology to help bring clarity and practical solutions to complex interplays between technology and law. Leveraging his experience as a registered patent attorney and a Certified Information Privacy Professional (CIPP/US)[1], Renato assists companies and entrepreneurs with contracts; licensing; privacy and cybersecurity policies and programs; complex business transactions; dispute resolution; intellectual property strategies; and patent, trademark, and copyright applications. He has counseled clients in a wide array of industries, including health care, financial services, education, software-as-a-service (SaaS), gaming, telecommunications, and electric power utility. Stemming from his passion for innovation, Renato finds joy in guiding clients in the research, development, and prelaunch stages with respect to regulatory compliance and risk mitigation. Notably, Renato performs design reviews to help clients identify design changes to better align their offerings with applicable laws and legal strategies relating to privacy, data security, automated decision-making, intellectual property, and advertising.

Practices & Industries

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

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, cookie policies, accessibility policies, platform services agreements (PSAs), SaaS agreements, end user license agreements (EULAs), service level agreements (SLAs), data protection agreements (DPAs), 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; the use and marketing of artificial intelligence (AI) tools; product development; manufacturing; distribution; brand development; and copyright releases.

In addition, Renato counsels clients in highly regulated sectors, including financial services, with respect to their privacy and data practices, including the development and implementation of written information security programs (WISPs), incident response plans (IRPs), and other data-related policies and procedures. In this area, Renato addresses compliance with an array of privacy laws, data security laws, and AI-related laws, including the California Consumer Privacy Act (CCPA) and other state laws focused on comprehensive consumer privacy, the European Union's General Data Protection Regulation (GDPR), the Gramm-Leach Bliley Act (GLBA), the New York State Department of Financial Services Cybersecurity Requirements for Financial Services Companies (DFS Cybersecurity Regulation), the US Health Insurance Portability and Accountability Act (HIPAA), and the US Family Educational Rights and Privacy Act (FERPA).

Admitted to Practice

- New York
- Illinois
- US Patent and Trademark Office

Renato has conducted dispute resolution and contract negotiations in the United States and abroad, including in Australia, Europe, and Taiwan, drafting settlement, termination, and amendment agreements involving infringement and breach of contract disputes. In connection with infringement disputes, Renato has performed analyses related to intellectual property infringement, design-around, and invalidity strategies. Renato has also assisted clients with responding to music license demands from performing rights organizations, and Renato has submitted complaints to social media platforms, resulting in the takedown of infringing content.

Additionally, Renato has drafted and prosecuted hundreds of patent applications for inventions in the software, electrical, and mechanical industries that include software-based solutions, mobile apps, medical devices, surgical systems, telecommunication devices, antennas, electronic gaming devices and systems, vehicles, power equipment and machinery, computer hardware, and consumer appliances.

In addition to his own practice, Renato serves as DEI advisor to Barclay Damon's Summer Associate Program.

[1] The Certified Information Privacy Professional/United States (CIPP/US) certificate, issued by the International Association of Privacy Professionals, is not a requirement to practice law in Illinois. The Supreme Court of Illinois does not recognize certifications of specialties in the practice of law.

Bar Associations

- Illinois State Bar Association
- National Bar Association, Intellectual Property Law & Criminal Law, Juvenile Justice Sections
- New York State Bar Association

Selected Memberships & Affiliations

- International Association of Privacy Professionals, Certified Information Privacy Professional/United States (CIPP/US)
- American Intellectual Property Law Association
- Chicago Lawyers' Committee for Civil Rights, Pro Bono Referral Source
- 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

- *Corporate Compliance Insights*, “Top Stories of 2024”
- 1851 Franchise, “The Impact Data Privacy Laws Will Have on Franchising”
- *Buffalo Business First*, “Beyond the Breach: How WNY Companies Reacted to Cyber Attacks”
- 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

- Fake Consumer Reviews, Testimonials, and Influence Indicators: Prohibitions and Penalties Under the Federal Trade Commission’s Rule
- Personal Financial Data Rights Rule: Consumer Financial Protection Bureau Compliance
- Connecticut Joins the Ranks of States Proposing Landmark AI Legislation
- EU Leads the Way on Artificial Intelligence Regulation
- ELVIS Act Puts Users of Artificial Intelligence on Notice