

Intellectual Property

Practice Overview





Intellectual Property

Today's complex technological landscape demands that businesses take a more robust approach to the management and protection of their intellectual property rights.

Seyfarth Shaw LLP's intellectual property attorneys have the strategic vision and broad-based experience to help clients meet that demand by protecting clients' intangible assets and turning their creativity into a lasting competitive advantage. Our capabilities span the country, with more than 40 attorneys practicing in the areas of patent, trademark, copyright, Internet law, privacy and security, trade secrets, and advertising, promotions, and sweepstakes.

The firm represents a diverse roster of clients, from multi-national corporations to cutting-edge start-up companies. Whether we are acting as counselors or high-stakes litigators, Seyfarth is committed to obtaining our clients' desired results promptly and efficiently. We constantly examine the strategy at each phase of the case until resolution. We also ensure that our cases and matters are staffed with the right team of lawyers and personnel, which offers clients both cost efficiency and a dedicated team backed by the strength and resources of one of the nation's premier law firms.

A Committed Team With Solid Experience

Our group is recognized nationally by peers and clients alike for its collective experience and knowledge, which span numerous industries, including apparel, biotechnology, chemical, cosmetics, consumer products, food and beverage, e-commerce, electronics, financial services, housewares, life sciences, medical devices and medical equipment, pharmaceutical, professional sports and entertainment, nutraceuticals, and restaurant services.

The majority of our intellectual property attorneys hold technical degrees in engineering and the sciences, and several have served as expert witnesses in high-profile litigation and faculty at prestigious academic institutions. Because of our attorneys' diverse technical backgrounds, we are uniquely positioned to help clients navigate the intersection between science, technology, and the law.

Members of our group are actively involved in professional intellectual property organizations such as the International Trademark Association, American Intellectual Property Law Association, and American Bar Association Section of Intellectual Property Law. In addition to speaking engagements and legal scholarship, these organizations have opened doors for our attorneys to write amicus curiae briefs on behalf of trade and industry associations and draft legislation, including portions of the United States Trademark Act and the Illinois state anti-counterfeiting statute.

We also have an extensive group of foreign associate intellectual property counsel with whom we have dealt for many years in patent, trademark, and copyright procurement and enforcement activities. We have utilized our foreign associates (in Europe, Asia, Africa, and North and South America) to help our clients navigate foreign proceedings relating to all aspects of intellectual property. This network of foreign associates continually evolves parallel to the needs of our clients, ensuring our ability to represent clients effectively overseas.

Patent

The firm's intellectual property practitioners—most of whom are licensed patent attorneys—bring years of experience to every phase of the patent process, including litigation and prosecution. We are experienced in a wide range of technologies, including the electrical, electronic, image-processing, telecommunication, mechanical, automobile, biotechnology, pharmaceutical, immunology, bioinformatics, e-commerce, computer hardware, and software arts.

Among our ranks are attorneys who served as former in-house patent counsel and former examiners at the U.S. Patent and Trademark Office. Several of our professionals have served as expert witnesses in cases, and some hold Ph.D.s and other advanced degrees.

Patent Prosecution and Counseling

The intellectual property attorneys at Seyfarth know that successful protection of new technologies requires a comprehensive strategy that contemplates a company's current position in the marketplace, short- and long-term business objectives, and the emerging technological landscape, among other things. To that end, we advise clients on optimal strategies for procuring patents and managing their portfolio. We also counsel on regulatory exclusivity and provide opinions with regard to patentability, freedom-to-operate, validity, and potential infringement. Our attorneys are well versed in the laws and regulations of all the major patent countries, and have experience preparing and filing international patent applications under the Patent Cooperation Treaty. We also regularly:

- Prepare and prosecute patent applications, domestically and internationally
- Draft and negotiate licensing and confidentiality agreements
- Integrate patent protection with trademark, copyright, and trade secrets
- Draft and negotiate technology transfer and research and development agreements

- Conduct intellectual property audits and due diligence for mergers and acquisitions
- Coordinate maintenance of patents pursuant to overall business objectives

Patent Litigation

While we always first investigate time-efficient resolutions to disputes, our intellectual property attorneys also have substantial experience litigating cases in order to aggressively protect our clients' rights. The patent team possesses exceptional courtroom prowess, both at the trial level and in the Court of Appeals for the Federal Circuit, because our attorneys not only understand complex scientific details, but can communicate those ideas succinctly to juries and judges alike.

We are aware that intellectual property litigation, particularly patent litigation, imposes a heavy burden on the client. It is expensive, time-consuming, and it forces company personnel to direct their attention away from realizing business objectives to less productive areas such as document collection, fact investigation, and deposition preparation and participation. To minimize such disruption, we gain a thorough understanding of our clients' objectives, fully evaluate their position, then formulate the most strategic way to achieve their goals. We aim to develop a strategy that allows us to dispose of cases at an early stage, by focusing on legal issues and techniques that facilitate a prompt, cost-effective disposition including:

- Summary Judgment Motions
- Settlement Negotiations
- Mediation
- Arbitration

Each year, we are involved in many patent litigation actions across the country. Our attorneys have a record of success before the U.S. Patent and Trademark Office, International Trade Commission, and state and federal courts nationwide.

Trademark

Seyfarth knows that a company's brand is more than just a logo—it is an identity, a reputation, and ultimately a key to profitability. When that mark is endangered, as a result of infringement, dilution, or use in ways the company never intended, it can have grave consequences. Our national practice works to identify, evaluate, and protect important trademark properties,

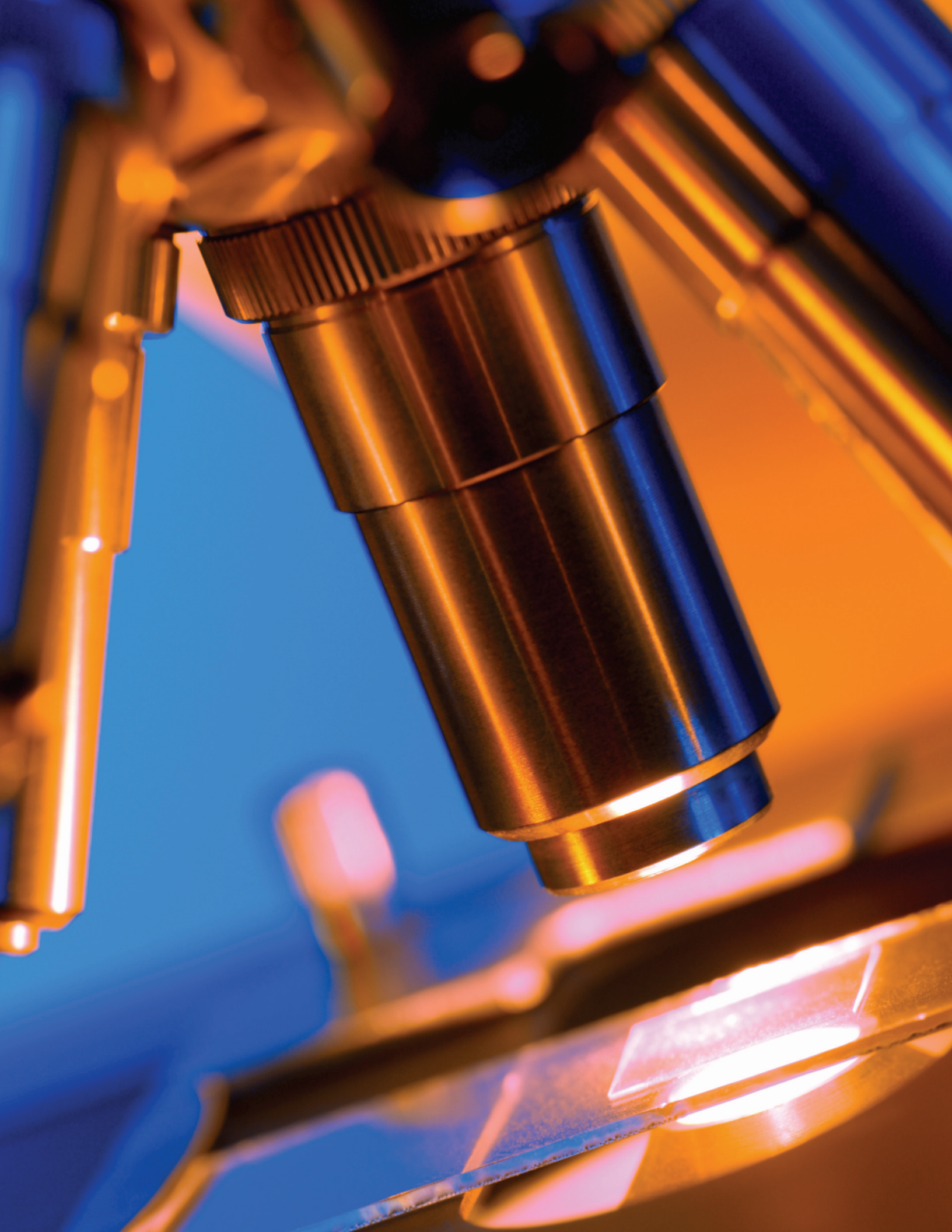
FIGHTING FOR FAVORABLE PATENT CLAIM CONSTRUCTION

A subsidiary of the world's largest sports equipment company was involved in a patent claim construction hearing in a case involving a pioneering patent on an elliptical trainer. The other side relied heavily on expert evidence to try to establish the meaning of critical claim terms. Our attorneys developed a strategy of:

- ▶ Convincing the district court that the intrinsic evidence (the patent and its prosecution history) was most compelling in understanding what the inventor intended the terms to mean
- ▶ Showing that the opposing expert's claim interpretation was in conflict with the intrinsic evidence

We focused our proof on that intrinsic evidence and, in particular, on cross-examining the opposing expert on the inconsistencies of his claim interpretations with that evidence.

The district court agreed with our interpretation of every claim term and discredited the opposing expert and the defendant's position.



including those that are web-based or that involve other electronic media. We have experience handling both domestic and foreign trademark matters.

Trademark Prosecution and Counseling

As trusted advisors, it is our responsibility to make sure our clients are in the best possible position at every phase of the trademark process, which means helping them to develop an airtight trademark, service mark, or trade name; obtaining clearance and proper licensing of that mark; and thinking ahead to identify potential points of infringement. Our national presence allows us to better evaluate appropriate jurisdictions in which to seek protection and ultimately develop more comprehensive trademark protection and enforcement programs for our clients.

We also provide other trademark transactions and counseling services. We regularly:

- Prepare and prosecute trademark applications, domestically and internationally
- Handle the trademark aspects of corporate acquisitions, including due diligence and negotiation of asset purchase agreements
- Conduct trademark portfolio audits and appraisals
- Record trademarks with U.S. Customs and assist in the interception of counterfeit merchandise
- Conduct trademark training programs for attorneys, paralegals, and marketing professionals

Trademark Litigation

Seyfarth has distinguished itself as a leader in trademark litigation by combining our attorneys' technical knowledge and deep experience to provide clients with superior representation in the courtroom. We understand that oftentimes trademark cases involve high-stake, bet-the-company issues, and we are prepared to take immediate, decisive action to address them.



Our intellectual property team regularly litigates trademark and unfair competition disputes in federal and state courts. We have a proven record of success in obtaining temporary restraining orders, injunctions, and seizure orders in cases where every hour is crucial

to the client's bottom line. Consistent with our client-focused strategy, these avenues often result in early settlement and less costly outcomes. We also handle oppositions, cancellations, and appeals before the U.S. Patent and Trademark Office and enforce trademarks in foreign countries.

Copyright

Whether the subject matter is a literary creation or cutting-edge multimedia content, clients look to Seyfarth to protect and enforce their copyrights in an increasingly complex marketplace. We help clients strategically review and assess the value of their copyrightable material and, if appropriate, prepare and prosecute a copyright registration through the U.S. Copyright Office. Furthermore, we ensure those rights remain protected by prosecuting and defending infringement actions in the federal district courts. With nine offices across the country, we know the jurisdictions and can assess which courts are most favorable for our clients. If appropriate, we advocate for expedited proceedings in order to quickly obtain temporary restraining orders, including impoundment orders for pirated works.

Our attorneys also understand the value of legally using creativity owned by others. We regularly counsel clients on fair use of copyrighted materials, and negotiate and draft license agreements on behalf of technology, medical, and educational institutions. We are especially well-versed in assisting computer software companies with the unique issues they face in the development and licensing of their products. We help them through the registration process, which can be somewhat nuanced and complex with international overlays due to the Berne Convention (an international copyright treaty); special issues in seeking registration of multiple versions of software code; complex regulations regarding the registration of databases; and the use of specialized deposit allowances designed to achieve copyright registration while maintaining trade secret protection.

PROTECTING CLIENTS FROM COUNTERFEITERS

Our client, a *Fortune* 100 consumer electronics manufacturer, discovered counterfeit merchandise was being sold at the international Consumer Electronics Show (CES) and various other locations. After extensive preparation, our attorneys "walked" the CES with a private investigator and a corporate representative, and:

- ▶ Within three hours, our attorneys filed two complaints and motions for a temporary restraining order and seizure order in federal court in Las Vegas. Within 24 hours we had obtained temporary restraining orders and seizure orders.
- ▶ Less than 36 hours later, we executed two seizure orders at the CES.

One defendant settled, agreed to a permanent injunction and has paid a substantial settlement, in excess of the attorneys' fees and costs incurred in the action. Following this initial action, we designed and implemented a national anti-counterfeiting program for the client which, to date has resulted in settlements in excess of \$100,000 and successful civil and criminal actions throughout the United States and generating information useful to combat counterfeiting overseas.

In addition, we regularly:

- Investigate copyright ownership issues
- Conduct due diligence in corporate acquisitions involving copyright
- Counsel on issues related to the Digital Millennium Copyright Act
- Conduct in-house copyright training programs
- Coordinate criminal proceedings for copyright infringement

Internet Law

Seyfarth offers a cross-disciplinary team of attorneys that is on the forefront of Internet law, helping clients across the globe make sense of the emerging legal principles governing conduct and commerce in cyberspace. Our attorneys are committed to being as forward-thinking as the clients they serve. They understand that this seemingly boundless medium raises issues that touch every aspect of intellectual property law, and they have extensive experience helping businesses of all types establish and manage their presence in the virtual marketplace.

For our clients, we regularly draft terms and conditions for Internet websites, and acquire and register domain names. We are also experienced in resolving domain name disputes, either by bringing traditional trademark claims in the courts, or an administrative procedure through the Internet Corporation for Assigned Names and Numbers (ICANN). We help clients devise and implement Internet and extranet business strategies and negotiate and structure Internet-related transactions.

Privacy and Security Law

With the evolution of the Internet has come increased accessibility to consumers' personal information, as well as a groundswell of laws governing data privacy and security. As a result, the protection of customer and employee data is now an integral part of every company's compliance program.

Seyfarth's intellectual property attorneys work with clients to proactively avoid security breaches that could lead to costly litigation, fines, audits, and an immeasurable loss of consumer trust. Our attorneys

PROTECTING CLIENTS FROM COMPUTER SOFTWARE PIRACY

Our client discovered an underground network where individuals illegally shared computer software to hack into communication devices. Members of our Intellectual Property Practice group coordinated attorneys from four different offices and were able to quickly:

- ▶ Obtain a court order to enter the offices of third party Internet Service Providers and mirror the records relating to all activities that occurred on specified websites in which the illegal activities were advertised and transacted
- ▶ Obtain a temporary restraining order, impoundment order, and a discovery order, which forbade the Internet Service Providers from notifying their customers so that our client could gather the appropriate evidence
- ▶ Coordinate, within 48 hours, seizures and impoundments in four locations across the country so that the defendants did not become aware of our activities while we were working toward identifying them

We identified and obtained permanent injunctions against eight individuals and website operators who actively assisted in the dissemination and sale of the pirated computer software.



help design and implement global strategies to collect, use, and protect personal information. We can also conduct privacy and data transfer audits and establish internal company policies, procedures, and training programs designed to maintain the security of this information. We monitor compliance with privacy laws, including the Health Insurance Portability and Accountability Act (HIPAA), and counsel on international data compliance programs.

If a security breach occurs, we are prepared to investigate the incident and advise clients on how to best communicate the breach in accordance with the applicable state security breach notification laws. We also defend Federal Trade Commission (FTC) investigations and enforcement actions; prosecute and defend actions involving defamation, misappropriation, disparagement, and “spoofing” on Web sites; and litigate matters involving hacking into computer networks and e-mail systems.

RESOLVING DOMAIN NAME DISPUTES HERE AND ABROAD

Our client, in the business of designing and selling jewelry over the Internet, discovered that two competitors, one domestic and the other foreign, had established similar domain names that redirected customers to the competitors’ websites. Our attorneys worked diligently to:

- ▶ Bring claims of cybersquatting and trademark infringement against the domestic competitor in federal court and request a preliminary injunction
- ▶ Initiate an ICANN proceeding against the foreign competitor before the domain dispute tribunal at the World Intellectual Property Organization

The domestic competitor agreed to an injunction, removed their website, signed over the domain name, and are paying money to our client. The foreign competitor was ordered by a WIPO Administrative Panel to transfer the cybersquatting domain names to our client.

INVESTIGATING AND IDENTIFYING COMPUTER HACKERS

Our client received an e-mail from an external e-mail account stating that a message sent to the CFO of the company was returned because the account was full. The client suspected that someone had hacked into the e-mail account. We immediately conducted an investigation and:

- ▶ Filed a John Doe lawsuit
- ▶ Obtained an order from the Federal Court permitting us to conduct expedited discovery to identify the owner of the external e-mail account on a shortened time frame without notifying the owner of the e-mail account

Our investigation determined that a senior executive had, in fact, hacked into the e-mail system and was forwarding e-mails sent by and to the company’s CEO and CFO to an external e-mail account. We presented the case to the FBI for investigation.

The client was able to fire the employee and obtain a permanent injunction and six figure settlement. The former employee pled guilty to a crime.

Advertising, Promotions & Sweepstakes

Advertising and promotion is crucial to success in the global marketplace. Seyfarth understands the need for clear, consistent, and sometimes aggressive marketing communications. We have helped clients design and implement complex print, broadcast and online national and international promotions, including drafting sweepstakes rules, registering sweepstakes, and reviewing coupons, rebates and other consumer offers. We also negotiate joint-promotion and cross-marketing agreements aimed at achieving the most efficient, profitable promotions possible for our clients.

Our attorneys regularly prosecute and defend false advertising and deceptive trade practice actions before the FTC, the National Advertising Division of the Better Business Bureau (NAD), and other federal and state courts and agencies. We also handle matters before government agencies relating to product labeling and packaging.

Since this is an area of law that is particularly susceptible to liabilities due to continual changes in the legal framework, we regularly conduct advertising and promotion training programs for marketing professionals that address the industry's latest developments. ■

About Seyfarth Shaw

Seyfarth Shaw LLP ("Seyfarth") was founded in 1945 by three lawyers and has grown to more than 800 lawyers across 13 markets in the U.S. and abroad. We handle issues for our clients in all key areas including labor and employment, litigation, construction, corporate, employee benefits, environmental, government contracts, intellectual property, commercial litigation, real estate, securities litigation, trade secrets, trusts and estates, and workouts and bankruptcy, among others.

Our success is the result of a constant, unrelenting focus on the needs of our clients. Our commitment to excellence and our belief in the strength of a team-based approach to the delivery of our services offers an atmosphere of creative and innovative thinking.

Our clients are our partners in business and we are committed to listening to their needs and to aligning the skills and abilities of our people to respond to those needs. Our clients range from *Fortune* 100 to midsize companies, and include publicly traded and privately held companies and various types of funds. We represent clients of all sizes across all industries and we are diligent in providing the same level of commitment to each client.



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