



SpencerFane®

Intellectual Property

## Translating creativity into marketable products and services.

**Innovation is not static. Neither are market opportunities. Always aware of the rapid pace of both business and technology, the Spencer Fane Intellectual Property team develops a detailed understanding of a client's business and IP assets while focusing on maximizing long-term value.**

### Overview

#### Protecting, commercializing, and monetizing IP

The Spencer Fane Intellectual Property team possesses both the technical knowledge and legal experience necessary to protect inventors, entrepreneurs, and businesses of all sizes, allowing them to translate their creativity into marketable products and services.

Our team guides individuals and businesses through preparation and prosecution of complex patent, copyright, and trademark matters in patent offices around the world. We also assist our clients with more general technology issues, including licensing, product development, due diligence, cybersecurity, innovation, IP theft, and assignment of ownership.

**We know science and technology.** We have attorneys with backgrounds in medical science, molecular bioscience, biochemistry, civil engineering, mechanical engineering, electrical engineering, physics, computer science, and biology to advocate for clients in a variety of industries, including extensive experience with coatings, inks, food processing, lasers, medical and telecommunications products, and mattresses.

**Industries.** Our experience working with clients in a variety of industries – from health care and financial services to automotive and aerospace – strengthens our clients' competitive advantage in the market.

**Clients of all sizes.** Our IP team serves global corporations with extensive IP portfolios as well as individual inventors, entrepreneurs, and emerging companies.

**All areas of IP.** Our attorneys are well-versed in patents, trademarks, copyrights, trade secrets, unfair competition, enforceability of noncompete provisions, internet law, privacy requirements, and security breach liability, giving us the ability to advocate for the best interests of clients both in and out of the courtroom to protect their intellectual property from infringement and defend their products and services from infringement allegations.

### Experience

#### Intellectual Property Defense and Enforcement Litigation

- Represented manufacturing company before the ITC leading to a finding of non-infringement of a patent and withdrawal of another ITC investigation of a second patent.
- Represented telecommunications company before the USPTO in an *inter partes* review, successfully invalidating the patents asserted against the company in federal district court.
- Represented durable goods manufacturer filing patent infringement suits against nine defendants in multiple district courts, leading to settlements with licenses or cessation of manufacturing for each.

### **Licensing, Copyrights, and Software**

- Assisted major IT service provider in developing universal MSA with provision options to tailor the MSA for unique clients nationwide.
- Assisted nationwide shipping and logistics company with software development agreement maintaining future flexibility for expansion and selection of future vendors.
- Assisted international coatings manufacturer with joint product development agreement providing a balance of patent ownership and commercialization rights, leading to successful development and commercial product launch.
- Negotiated resolution of allegations of online copyright infringement.
- Addressed compliance with National Advertising Review Board product advertising regulations.

### **Patents and Trademarks**

- Represented medical device company acquiring multiple U.S. and international patents, providing continuing advice on broadening its patent portfolio.
- Represented food processing company acquiring multiple U.S. and international patents and trademark registrations, and assisted in international enforcement efforts.
- Represented personal defense product manufacturer in acquiring and maintaining its international trademark portfolio and assisted it in defending its intellectual property interests worldwide.

## **Areas of Focus**

### **Intellectual Property Defense and Enforcement Litigation**

**Understanding the full picture of a client's company, market, innovations, and competitors.** Our attorneys know how crucial IP is to a business, and we work to develop a big picture view of a client's company, IP assets, and business environment in order to develop defense and enforcement strategies and recommend a course of action.

We defend clients against patent, copyright, and trademark claims, as well as enforcing claims against infringers.

Crucial to success is our deliberate process of research and preparation, which offers an extreme tactical advantage when litigation is necessary. In addition, our team may suggest alternatives to litigation to achieve the desired result in a cost-effective manner.

We represent clients:

- **In court.**
- **Before the U.S. Patent and Trademark Office**, in appeal, opposition, cancellation, reexamination, *inter partes* review, and post-grant proceedings.

- **Before the Federal Trade Commission, International Trade Commission, and U.S. Customs and Border Enforcement** to halt the import of infringing goods.

Our approach to intellectual property litigation blends technical proficiency with trial experience. Each member of our litigation team draws from the strength of the firm's creative and imaginative personnel to achieve success for our clients.

## **Licensing, Copyrights, and Software**

**Creating effective IP protection that can hold up against challenges and in litigation.** We assist clients – manufacturers, entrepreneurs, software developers, product developers, and companies that have software needs – to protect their innovations, handling needs ranging from simple copyright registration to software licensing, complex joint development agreements, and manufacturing agreements. For companies with high volumes of copyright work, we provide training to allow them to effectively take over registration work in-house.

In the field of software development, our attorneys:

- **Work to balance the interests** of parties on either side of a software development project.
- **Help clients requisitioning software** to protect their unique creation and maintain their rights as a consumer, allowing them to work with their choice of developer in the future.
- **Create software development agreements**, which include benchmarks that allow clients to hold vendors accountable.
- **Establish copyright ownership for vendors** that allows them to maintain innovations within their business, including iterations of software.
- **Help businesses mitigate risks related to their online presence**, including compliance with COPPA and ADA as well as proper use and registration of trademarks.
- **Review websites to identify and eliminate use of protected works.**

## **Patents and Trademarks**

**Protecting innovations worldwide.** Spencer Fane helps clients establish, protect, and maintain patents and trademarks. We work with business leaders to define an IP program and, in situations where employees invent or develop IP, we work with individuals to pursue patents in accordance with a company's IP program.

For companies working internationally, we facilitate IP protection in foreign patent and trademark offices and have experience maintaining thousands of patents and trademarks across more than 50 countries.

Our work includes:

- **Patent prosecution and defense**
- **Patent opinions**
- **Trademark registration and defense**
- **Demand letters**
- **Examination procedures**
- **Coexistence agreements**
- **Appeal processes and boards**
- **Post-grant challenges at the U.S. Patent and Trademark Office**
- **Special processes associated with software patents**
- **Advising on purchase and sale of patents and trademarks**

We serve clients in industries including manufacturing, technology, software, health care, medical devices, financial services, chemical coatings and inks, and many more.

## **Technology and Intellectual Property Transactions**

The Spencer Fane Technology and Intellectual Property Transactions team combines deep knowledge in technology, corporate, bankruptcy, finance, tax, licensing, antitrust, patent, copyright, trademark, and trade secret law to offer clients a comprehensive, efficient, and effective solution for expert representation in transactions that involve technology and intellectual property.

Technology transactions have the potential to affect the value and enforceability of intellectual property assets. This specialty group advises on transactions from the outset to protect clients' intellectual property portfolios and maximize their value, including through due diligence in corporate mergers, acquisitions, and reorganizations; formation of standard-setting organizations; collateralization of intellectual property; and bankruptcy proceedings.

Examples of specific services include the following:

- Technology and IP transfers and licensing
- Investing in, financing, and insuring IP enforcement and defense
- Intercompany assignments and licenses
- Acquisition and grant-back IP licenses
- Know-how transfers and licenses
- Joint venture agreements
- Sponsored research agreements
- Proprietary information and inventions agreements (startups)
- Tax planning
- Entity formation and antitrust issues for standard-setting groups, patent pools, and joint research projects.
- E-Commerce: terms of service, SaaS, EULAs, data, and IP ownership policies
- Employee confidentiality and proprietary rights agreements, including employment issues in different states
- Organization-level technology and IP policies/handbooks (including for AI)