

## Overview

The IP lawyers at Steptoe & Johnson know that efficient business solutions to intellectual property problems are critical to business success. Our IP practice focuses on providing clients with the highest quality work in the areas of patent, trademark, copyright, trade secrets, and advertising issues. Our firm's IP lawyers consistently stay up to date on regulatory advertising requirements and substantive trademark developments to not only assist clients in navigating the trademark and copyright registration processes, but to help them enforce rights in their registered IP assets while decreasing the likelihood of unexpected litigation.

### **Steptoe and Johnson's IP lawyers are positioned to help businesses in the following areas:**

**Trademark and Copyright Infringement Litigation** – Owners of rights arising under trademark or copyright laws have not only a right, but a duty to enforce those rights by monitoring and stopping unauthorized third-party uses. Our IP team helps clients “police” marks and pursue actions against offenders in a principled and effective manner. Many situations may be resolved through notice to an infringer of a well-supported objection, but in some cases, either filing a lawsuit in federal court or lodging a formal challenge before the Trademark Trial and Appeal Board is the best option for protecting your intellectual property.

**Trademark and Copyright Registration** – We have assisted clients across multiple industries in obtaining federal certificates of trademark registration by the U.S. Patent and Trademark Office (USPTO) to ensure establishment of ownership of trademarks and protection of our clients' IP assets. In addition, we assist creators of original works of authorship (literary works, music, sound recordings, stage plays, lyrics, visual arts, photographs, and motion pictures) in registering works with the U.S. Copyright Office to preserve the ability to recover statutory damages and attorney's fees in the event of infringement.

**Trademark Availability Opinions** – Before a company invests in a new trademark, our IP attorneys can develop an availability opinion to help determine whether the mark is available, not available, or can be adopted and used with certain modifications to reduce the risk of a third-party objection.

**Trademark Licensing** – Trademark licensing can be helpful in broadening the reach and value of your brand. When licensing a trademark, the brand's reputation and commercial value are at stake. Our IP attorneys leverage a sophisticated process to prepare trademark licensing agreements to ensure your trademark is protected and the license is legally sound.

**Patent Infringement Litigation** – Patent owners have the right to exclude third parties from making, using, offering to sell, or selling something that contains every element of a patented claim or its equivalent while the patent is in effect. Our IP team helps navigate patent claim disputes through settlement, before federal courts, and in formal challenges before the Patent Trial and Appeal Board.

**Patentability Searching and Opinions** – To be patentable, inventions must be novel, useful, and nonobvious. Certain requirements, such as novelty and non-obviousness, may involve conducting a preliminary patent search. Our IP attorneys can conduct and analyze patent searches to provide an opinion on whether meaningful patent protection is available.

**Patent Prosecution** – Our patent attorney has advised applicants, from Fortune 100 to startup companies, on all stages of patent prosecution. We have prosecuted patent applications in a broad range of technical fields, including the mechanical, industrial, chemical manufacturing, materials, software, microelectronics, polymer formulation, adhesives, medical device, transportation, and consumer products areas. We leverage an extensive network of foreign patent attorneys to secure patent protection for our clients across the globe.

**Patent Licensing** – Patent and product licensing is frequently a part of commercializing any patented product or method. Whether to provide a manufacturing partner the proper rights and protections to produce a component to be incorporated into a final product for sale, or as a key part of the revenue generation stream of a patented invention.

**Software Audit Defense** – Software audits can have serious implications if handled improperly. We help clients navigate such audits to document and implement licensing compliance for software users and to negotiate comprehensive licensing packages that reduce the risk of future noncompliance.

**Software License Review** – Our IP attorneys cover the full scope of substantive issues that clients must consider in any licensing relationship, including data security and back-up protocols, indemnification obligations triggered by third-party infringement claims, and termination provisions — including protecting the ability of a licensee to transition to a new vendor with its data intact.

**Advertising Review and Counseling** – The time constraints of advertising cycles require timely but cost-effective legal review procedures. Our IP team is involved in every stage of advertising development, including in the digital space, to help our clients reduce legal risk without undermining the effectiveness of valuable marketing efforts.

## **Representative Experience**

- Developed strategy for prosecution and maintenance of domestic and international patent and trademark portfolios for U.S. based companies with foreign product markets
- Represented various privately held companies and individuals in connection with intellectual property matters, including the submission of trademark and patent applications with the USPTO
- Assisted clients with software license drafting and review
- Drafted and negotiated design, research & development (R&D), and software as a service (SaaS) agreements for clients in various technical fields
- Represented The Acushnet Company against retailers and wholesalers counterfeiting Titleist Pro V1 golf balls in multi-million dollar trademark infringement lawsuits across the country
- Represented Cartier International B.V. and Montblanc-Simplo GmbH in trademark infringement action related to counterfeit Montblanc and Cartier watches
- Represented PRL USA Holdings, Inc. in a multimillion-dollar trademark infringement lawsuit against numerous defendants for selling counterfeit Polo and Chaps shirts
- Represented Liz Claiborne, Inc. against a Dallas-based public company in multimillion-dollar trademark infringement litigation involving alleged counterfeit Monet jewelry – obtained temporary restraining order against all defendants in lawsuit

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