

Intellectual Property and Technology

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Cohen & Gresser handles a wide range of intellectual property and technology matters. Our litigators have experience in patent, trademark, copyright, trade secret, and unfair competition litigation and advise clients on internet privacy issues, data security, and technology law. Our transactional lawyers protect our clients' patents, trademarks, service marks, copyrights, and trade secrets; manage trademark portfolios; and negotiate and draft a broad range of licensing and technology-related agreements.

Copyright Law

Our copyright attorneys protect the intellectual property rights of companies in a range of industries, including manufacturing, entertainment, and electronics. We also represent artists, designers, inventors, and technology developers. We are skilled in copyright portfolio management (ownership rights, registration, and renewal) in addition to litigation and transactions involving copyrights.

Our litigators are experienced in resolving copyright infringement actions for both registered and unregistered copyrights and in navigating issues of joint ownership, fair use, public domain, and independent creation. We regularly provide counsel in matters involving safe harbor protections, misappropriation of trade secrets, non-competition agreements, and DMCA enforcement.

On the transactional side, our copyright attorneys conduct due diligence reviews and evaluate target companies' copyright and other IP assets in connection with joint ventures, mergers and acquisitions, asset sales, and co-branding and distribution agreements.

Due Diligence and Corporate Support

Our Intellectual Property and Technology lawyers provide a full range of services and counseling in connection with corporate transactions. We evaluate third-party patent and trademark holdings for possible acquisition, conduct due diligence assessments on intellectual property aspects of mergers and acquisitions, and negotiate agreements transferring title and rights to intellectual property. We also advise clients on technology-related risk analysis within the context of corporate transactions.

In collaboration with the firm's other practice groups, we also advise technology companies on a broad range of "life cycle" issues, including formation, seed and venture capital, financing, private and public equity, mergers and acquisitions, real property acquisition and lease negotiation, litigation, and compensation and employment matters.

Licensing and Technology Transactions

Today more than ever, technology and technological advancements drive global economies. Our cross-border licensing & technology transactions team spans our New York, Paris, and Seoul offices, and regularly assists clients in connection with a wide range of intellectual property and technology-related projects and contracts.

Our team has more than a decade of experience advising companies at all stages of growth, including software developers and vendors, service providers, OEM, internet and e-commerce operators, corporate accounts, financial institutions, and members of other industries through the full cycle of technology projects implementation in both domestic and international contexts. We represent clients in developing, commercializing, and transferring intellectual property rights, including patents, copyrights, trademarks, and other intellectual property assets. Our Paris-based team has been recognized in *Legal 500* for IT, Telecoms, and the Internet in France.

We have extensive experience in the following fields:

IT & Technology Services, including:

- Software licensing and integration agreements (including implementation agreement negotiation and project management), computing development, maintenance, and services agreements
- Cloud computing, SaaS, PaaS, IaaS, and other as-a-service solutions and platforms
- Sourcing and outsourcing agreements negotiation and implementation

Internet & e-Commerce, including:

- Digital media, digital content and rights management, online distribution, digital advertising, social media, content aggregation, traffic management, and ad-tech
- Big data analytics, platforms, and services, algorithm development and protection, and strategic data management and regulatory constraints advice
- e-Commerce, marketplaces, e-Payment, and fintech licensing and services agreements
- Cybersecurity processes definition and implementation, cybercrime investigation management and defense

Telecoms, Infrastructure, and Industrial Projects, including:

- Telecom operator and network interconnection agreements, MVNO agreements, and satellite telecommunications agreements
- Turn-key project agreements to establish mobile telecommunication systems with numerous foreign governments and various service providers
- Technology transfer agreements in the areas of telecommunication transmitting equipment, mobile communication devices, smartphone technology, and biotechnology equipment and products
- Joint ventures, distribution agreements, and other international or multi-state distribution arrangements

Intellectual Property Rights, including:

- Patent and technology license agreements
- Intellectual property acquisitions and asset sales
- OEM and reseller agreements
- Licensing and distribution agreements for digital media content and data and a wide range of consumer products

Patent Litigation

Our litigators have successfully asserted and defended patent cases in federal courts throughout the country, including jurisdictions with heavy patent dockets (e.g., California, Delaware, Massachusetts, New Jersey, Pennsylvania, Texas, and Virginia), the Court of Appeals for the Federal Circuit, and before the International Trade Commission. Foremost, we are trial lawyers, and our diverse IP litigation practice enables us to excel across a wide range of technologies. Our approach is to pair lawyers who have strong technical backgrounds in the relevant technology with experienced trial lawyers, thereby giving our clients the best of both worlds: a litigation and trial team which can construct the strongest possible technical arguments in support of our position and can also explain our case to a judge and jury in language which is simple and persuasive.

From individual inventors to Fortune 500 companies, our lawyers have represented a wide range of clients in patent matters and have successfully litigated against some of the largest law firms in the U.S. The firm's patent practice has been recognized in the *Chambers USA* guide, and the firm has been ranked as a recommended firm for patent litigation by *Managing Intellectual Property* magazine's IP Stars guide. Patent Litigation group members have also been recognized individually by *Chambers*, as IP stars by *Managing Intellectual Property*, and as part of *IAM's* Patent 1000 list.

Our patent attorneys are also skillful and experienced negotiators, able to assist our clients in maximizing the value of an IP asset sale. We draft infringement and validity opinions, conduct detailed intellectual property due diligence and freedom-to-operate analyses, and counsel clients on monetizing strategies for patent portfolios.

Patent – Post-Grant Proceedings

The U.S. Patent & Trademark Office (“USPTO”) has emerged as both an offensive and defensive tool in mitigating expensive and protracted district court litigation. A number of procedures exist at the USPTO and its adjudicative body, the Patent Trial and Appeal Board (“PTAB”), to challenge or refine issued patents, including *inter partes* review (“IPR”), covered business method review (“CBM”), post-grant review (“PGR”), *ex parte* reexamination, supplemental examination, and patent reissue.

Taking full advantage of these options can bolster any offensive or defensive patent strategy. Our IP practice group’s seasoned patent litigators and practitioners work with clients to develop innovative patent strategies that are business-focused and cost effective. Post-grant proceedings can be a tool for patent holders to improve the quality and strength of patent portfolios in advance of business transactions or litigation campaigns. For defendants, these proceedings have emerged as an effective alternative to costly and uncertain patent litigation.

Our team is well versed in patent examination and litigation before the USPTO, federal courts, and the International Trade Commission, providing the foundation and tools to foresee problems and formulate solutions. Team members hold undergraduate and graduate degrees in engineering, computer science, medicine, physical sciences, and life sciences. Moreover, our lawyers have patent experience in a broad range of technologies, from aerospace, telecom, and gaming to pharmaceuticals. This comprehensive technical expertise and strategic foresight enable our attorneys to be effective client advocates in all of the USPTO post-grant proceedings described below.

Patent owners and prospective challengers have a number of post-grant options, including the following:

***Inter Partes* Review (“IPR”)**

IPR is a proceeding conducted before the PTAB to review the patentability of patent claims based only on anticipation and obviousness grounds, and then only on the basis of prior art consisting of patents or printed publications.

Post-Grant Review (“PGR”)

PGR is a proceeding conducted at the PTAB to review the patentability of claims in a patent on broader grounds than an *inter partes* review, including failure to comply with written description, enablement, or patent eligibility requirements, and can also rely on evidence of public use, on-sale activity, or other public disclosures; however, PGR rules impose a limited filing window (must be filed within nine months of the issuance or reissuance of the patent).

Covered Business Method (“CBM”) Review

CBM review is a proceeding conducted at the PTAB to review the patentability of claims in a covered business method patent, which employs the standards and procedures of a post-grant review, but has notable differences (e.g., there has to be a formal allegation of infringement, and PGR cannot be available).

***Ex Parte* Reexamination**

Ex parte reexamination is a proceeding in which the requester (most often a third party) may re-examine an issued patent based on prior patents and printed publications, at any time during the enforceability of a patent. The requester initially bears the burden of showing that the submitted prior art establishes a substantial new question of patentability, after which the USPTO will commence the reexamination process. From that point on, the *ex parte* reexamination proceeding will, for the most part, involve only the patent owner and the USPTO.

Supplemental Examination

Supplemental examination is filed by a patent holder and asks the USPTO to “consider, reconsider, or correct information believed to be relevant to the patent,” which is not limited to patents or printed publications. The standard and procedure otherwise substantially mimics that of *ex parte* reexamination.

Patent Reissue

Reissue is available as a procedure to correct errors in an issued patent where the error renders the patent wholly or partially inoperable or invalid. Patent reissue can address errors and issues relating to utility, written description, or enablement, whereas patent reexamination only reaches issues of novelty and obviousness. Further, patent reissue may allow for broadening of claim scope for a limited time after issuance.

Technology Litigation

In addition to patent litigation and advice, we advise technology companies in many other types of dispute resolution and litigation matters, including those related to IT and software implementation projects and project management issues, but also e-Commerce, e-Payments, fin-tech, ad-tech, and industrial projects disputes.

Our IP & Technology team has a track record of representing clients in complex civil litigation and commercial disputes in the technology field, including across various jurisdictions. Clients include multinational corporations, foreign and local listed companies, small and medium enterprises, and foreign and local financial institutions. *The Legal 500* recently recognized our work in the IT, Telecoms, and the Internet category for France.

Trade Secret and Unfair Competition

We represent clients in actions involving unfair trade practices, unfair competition, and violations of non-competition and nondisclosure agreements. We also advise clients on the preparation and negotiation of nondisclosure and confidentiality agreements, and we represent clients in trade secret misappropriation disputes and litigation.

Trademark Law

Our trademark attorneys evaluate prospective trademarks for both clearance and availability for use; file and prosecute trademark applications in the United States Patent and Trademark Office; handle opposition and cancellation proceedings before the Trademark Trial and Appeal Board; and use state of the art technology to manage trademark portfolios efficiently and cost-effectively. We also represent clients in trademark infringement litigation, including *ex parte* seizure orders, temporary restraining orders, and preliminary injunctions in federal and state courts, and we regularly counsel our corporate clients on the protection and enforcement of their trademarks.