

## Intellectual Property

Working at the crossroad of emerging patent and IP laws and competitive business practices, McGlinchey Stafford's intellectual property attorneys counsel national and global commercial leaders, research and development teams, educational institutions, and innovators.

In 2008, the renowned intellectual property law boutique of Sieberth & Patty, LLC merged with McGlinchey Stafford, deepening our five decades of IP practice experience and service to clients. We have significant strength in IP issues facing the chemical, oil and gas, pharmaceutical, and mechanical equipment industries.

From defending patent interference claims made by a Nobel Laureate chemist, to enforcing injunctions that protected a retailer's trade secrets, our IP attorneys help clients establish, extend, monetize, and defend IP assets and portfolios.

Our team of IP attorneys secures and defends vital patent, copyright, trademark, and trade secret rights. Hundreds of successful patent applications, as well as the resolution of complex IP issues and litigation, form the foundation of representative matters for our IP practice.

The extensive technical background of our attorneys influences a practice approach that is proactive, cost-efficient and forward-thinking. And highly effective.

### Practice Scope - Filing, Prosecution, Litigation, and Counsel

Our range of IP services anticipates the burgeoning need of today's companies and research leaders. When appropriate, we collaborate with firm colleagues in other practice areas to provide comprehensive IP counsel and services, which include:

- **Patents** - U.S. and foreign patent application preparation, prosecution, appeals and interferences. We guide clients through the process and routinely obtain broad and valid patents for research centers, educational institutions, and commercial research and development teams.
- **Trademarks** - Every business needs trademark protection and our attorneys are highly experienced in evaluating and strategically managing trademark assets. We provide comprehensive counsel on U.S. and foreign trademark/service mark applications, prosecution and appeals, and trademark and trade name availability searches.
- **IP Litigation and Enforcement** - Experienced and effective at both defending and enforcing protections, our IP attorneys act aggressively against threats to our clients' assets. For example, for such diverse clients as an oil and gas exploration company and a publicly-traded insurance brokerage, we protected competitive, multimillion dollar agreements and assets by prevailing during injunction proceedings. Trademark, trade secret, and unfair competition litigation matters are also areas of achievement. Our experience includes favorable litigation outcomes in all resolution forums, including mediation and arbitration.
- **Copyrights** - U.S. and foreign copyright applications, publishing, and related contracts.
- **Licensing and Transfers and IP Portfolio Management** - Technology transfers, novelty and validity searches, legal opinions, and counseling are part of our practice background. Our experience includes negotiating pharmaceutical licenses and highly complex, international licensing agreements for wireless technology used by the blind.
- **Acquisitions and Sales of IP Assets** - We offer opinions and provide due diligence during commercial transactions and have extensive experience working with venture capital investors in IP asset evaluations.
- **IP Advice and Counsel** - Our opinions and advisory experience includes matters involving antitrust and IP issues, noncompete agreements, and insurance coverage for IP matters. Additionally, we advise on structuring businesses, IP holdings, and agreements within an IP-focused, protective, and practical framework.
- **Trade Secret Protection Counseling** - When seeking a patent, our clients may have to reveal valuable trade secrets and other proprietary intelligence. Also, some business models require consideration of trade secret protection strategies as a viable alternative to patent protection. Our attorneys provide strategic counsel on achieving critical protections while commercializing IP assets with trade secret implications.
- **Expert Witness Consulting** - Because of our consistent record of achievement in the IP arena, especially within the chemical and manufacturing sectors, we are asked to appear as expert witnesses and/or consultants from time to time. Several of our attorneys provide expert testimony during litigation matters and are available for pre-trial consultation and in the courtroom.

### Client Industries

We are trusted counselors to clients based regionally, across North America and around the globe, including in Asia, Europe and the Middle East. Our clients are industry leaders, researchers and innovators in:

- Art, design and fine arts
- Chemical manufacturing
- Education and academic institutions
- Entertainment
- Food processing
- Franchise organizations
- Governmental entities and contracting
- Health care
- Hospitality
- Insurance and brokerage industries
- Internet commerce
- Financial services
- Oil, gas, and energy
- Pharmaceuticals
- Publishing
- Real estate development
- Research and development centers
- Technology companies

### Technical Backgrounds of Attorneys

Our attorneys' technical and scientific backgrounds are key practice strengths. A sizable number of attorneys in our IP practice have at least undergraduate degrees in a field of chemistry, biochemistry, or an engineering discipline.

The firm's patent attorneys are also experienced in a variety of other fields of basic applied science, including mechanical and electro-mechanical arts, medical and pharmaceutical arts, software-based systems, financial and business systems, and industrial fabrication, including microfabrication.

Several attorneys in the firm have worked in the chemical industry or in an engineering capacity for related industrial service companies. All patent attorneys are licensed to practice before the United States Patent and Trademark Office.

Our attorneys' technical skills and training provide a distinct advantage during the process of obtaining broad and valid patents and other IP protections for our clients.

### Representative Matters

- **Patent Interference** - Our client, a research university foundation, faced a patent interference challenge from another institution based upon work done by a Nobel-winning scientist. The matter, which involved opposing counsel from multiple global and national law firms, was resolved favorably.
- **Trade Secret and Agreement Protection** - We successfully represented one of the largest national retailers in several of their IP matters, obtaining injunctions to prevent breach of covenants not to compete and reveal trade secrets.
- **Copyright Infringement** - For a telecommunication systems company in a dispute with a national software trade association, we represented them against software copyright infringement allegations involving several hundred thousand dollars in alleged damages. Our favorable resolution of the matter resulted in a complete withdrawal of the asserted claims.
- **Trademark Ownership Dispute** - During our representation of a restaurant chain in U.S. trademark opposition proceedings against a national restaurant conglomerate, our client obtained and retained ownership rights of the trademark in question.
- **Portfolio Procurement and Management** - Our attorneys have procured and managed an international patent portfolio for an intellectual property holding company engaged in the development of industrial pump technology for use in the aggregate products industry.

### Professionals



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## Experience

### Handled Brand Management for Restaurant/Hospitality Industry Clients

Represent several restaurant/hospitality industry clients in brand management and trademark procurement/enforcement matters.

#### IP Counsel for Software Developer for Healthcare Products

Serve as IP counsel for an established software developer of electronic health records and medical practice management software products.

#### IP Due Diligence Counsel for Lender in Multi-Million Dollar Financing for Biofuels Industrial Plant

Served as IP due diligence counsel for the lead lender in successfully closing a \$25 million round of financing for a biofuels industrial plant employing patented technology.

#### Representation of Casino Developer in Multi-Million Dollar Brand and Celebrity Rights License Transaction

Represented the casino developer in a multi-million dollar brand and celebrity rights license transaction, in connection with the development of a \$200 million themed casino project.

#### Representation of Major Oil Field Services Company in U.S. Chemical Patent Matters

Represented one of the world's largest oil field services companies in U.S. chemical patent matters.

#### Representation of Major U.S. Financial Institutions in IP Due Diligence for Loan Transactions

Represent one of the largest US financial institutions in loan transaction IP due diligence matters.

#### Representation of National Financial Institution in IP Litigation

Represented a national financial institution in federal litigation involving a software licensing dispute with one of the client's online banking system vendors. The matter was favorably settled.

#### Representation of Public University Foundation in Chemical Patent Matters

Represent a public university foundation in chemical patent matters, including a patent interference adverse to a Nobel Prize winner in Chemistry.

#### Representation of Specialty Chemical Company in Hundreds of Patent Applications Worldwide

Represent a major publicly traded specialty chemical company in patent matters involving approximately 700 patent applications worldwide.

#### Represented Major Industrial Services Company in Patent and IP Matters

Represent a major industrial services company in patent and intellectual property matters.

#### Albemarle Chemical

Obtained a trial verdict of \$6.8 million for Albemarle in a case involving enforcement of a royalty agreement linked to a sale of assets and intellectual property.

#### Patent Defense

Obtained dismissal on initial motions of three separate patent infringement cases within the last few years at minimal cost and with almost no discovery conducted. Obtained dismissal of litigation in Eastern District with no payment. Obtained dismissal in Eastern District with settlement far below other defendants' and at a fraction of original demand.

#### Patent Plaintiff

Represented patent holder in litigation spanning four cases, two states, USPTO reexaminations and appeal to the Federal Circuit.

#### Schlumberger and its affiliate WesternGeco

In cases ranging up to eight figure amounts, Joel Mohrman handled numerous trade secret and covenant not to compete cases successfully for these organizations, both at final trial and in injunction proceedings.

#### The May Department Stores Company

Handled numerous matters including several very large trade secret intellectual property matters for one of the largest retailers in the United States.

**USI Insurance Services, Inc.**

Represented this publicly traded insurance brokerage in numerous matters relating to trade secrets, covenants not to compete, and contract litigation in several different states.

**Veolia Water N.A.**

Handled covenant not to compete and trade secret litigation for the largest water services provider to municipalities in the world in Alabama and other states.

**Recent Publications**

December 21, 2018	<p><b>Copyrighting Architectural Drawings: An Issue for Builders, Developers, and Lenders</b></p> <p>The U.S. Copyright Office has proposed new rules requiring electronic registration of copyrights in architectural works.</p> <p>McGlinchey Real Estate and Intellectual Property Alert</p>
Winter 2018	<p><b>Recent Developments in Intellectual Property Law</b></p> <p>Co-authors: Mary H. Drabnis, Ph.D., Chris Nichols, and David L. Pardue</p> <p>Tort Trial &amp; Insurance Practice Law Journal (53:2)</p>
Winter 2017	<p><b>Recent Developments in Intellectual Property Law</b></p> <p>Co-authors: Eric P. Raciti, Yolanda Álvarez, and Christopher S. Nichols</p> <p>Tort Trial &amp; Insurance Practice Law Journal (52:2)</p>
February 2, 2017	<p><b>Trademark Owners Take Note! USPTO Implements New Evidence Requirements for Proving Use or Continued Use of Federally Registered Trademarks</b></p> <p>Effective February 17, 2017, the U.S. Patent and Trademark Office (USPTO) will change its rules for proving use or continued use of federally registered trademarks.</p> <p>McGlinchey Intellectual Property Alert</p>
May 24, 2016	<p><b>Defense of Trade Secrets Act Prompts New Notice in Employment and Contractor Agreements</b></p> <p>Now that the Defense of Trade Secrets Act ("DTSA," Public Law 114-153) is federal law, employers and contractors should include a notice of immunity in all confidentiality or trade secret provisions in any employment agreement or contractor agreement.</p> <p>McGlinchey Intellectual Property Alert</p>
Winter 2016	<p><b>Recent Developments in Intellectual Property Law</b></p> <p>Co-authors: R. Andrew Patty II, Yolanda Álvarez, and Eric P. Raciti</p> <p>Tort Trial &amp; Insurance Practice Law Journal (51:2)</p>
February 5, 2016	<p><b>Practice Points: Lessons Learned After Dow Slammed By Section 112 Law Change Under Nautilus</b></p> <p>This article was first published in <i>IPFrontline</i> on November 16, 2015.</p> <p>State Bar of Texas Intellectual Property Section Newsletter</p>
November 16, 2015	<p><b>Lessons learned after Dow slammed by Section 112 law change under Nautilus</b></p> <p>IPFrontline</p>
September 4, 2015	<p><b>Key Considerations Before Litigating IP</b></p> <p>American Bar Association Intellectual Property Law Committee Newsletter</p>
Winter 2015	<p><b>Recent Developments in Intellectual Property Law</b></p> <p>Co-authors: R. Andrew Patty II, Yolanda Álvarez, and Eric P. Raciti</p> <p>Tort Trial &amp; Insurance Practice Law Journal (50:2)</p>

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**Recent News**

- December 14, 2018 [McGlinchey Stafford Attorneys Named to National Intellectual Property Association Leadership](#)  
McGlinchey News Release
- November 1, 2018 [McGlinchey Stafford's Practices Ranked Among Top in Nation in U.S. News/Best Lawyers' "Best Law Firms" 2019](#)  
McGlinchey News Release
- May 30, 2018 [McGlinchey Stafford's Intellectual Property Team Receives Recognition in IP Stars](#)  
McGlinchey News Release
- November 1, 2017 [McGlinchey Stafford's Practices Ranked Among Top in Nation in U.S. News/Best Lawyers' "Best Law Firms" 2018](#)  
McGlinchey News Release
- September 18, 2017 [McGlinchey Stafford's Intellectual Property Team Receives Recognition in IP Stars](#)  
McGlinchey News Release
- November 13, 2015 [McGlinchey Stafford Ranks Second Nationwide in Obtaining Patents in TC 1600](#)  
Juristat
- September 23, 2015 [Brian S. McGrath and Ashley R. Newman Expand McGlinchey Stafford's Litigation Practice in New York City](#)  
McGlinchey News Release
- July 31, 2015 [Patty and Cao Serve as Panelists at ABA Annual Meeting](#)  
McGlinchey News Release
- July 28, 2015 [McGlinchey Stafford Receives Tier 1 Ranking From Managing Intellectual Property](#)  
McGlinchey News Release
- February 2, 2015 [McGlinchey Stafford Expands Intellectual Property Team](#)  
McGlinchey News Release