

INTELLECTUAL PROPERTY

Patent | Trademark | Copyright | Portfolio Asset Management
Licensing and Technology Transfer | Patent and Intellectual Property Litigation

Intellectual Property

The Intellectual Property Group focuses on the protection, commercialization and enforcement of critical intellectual property assets. The group works closely with business owners, executives, entrepreneurs, inventors, scientists and investors to help ensure that business goals are met while intellectual property assets are appropriately and efficiently protected and exploited.

Patent

Mirick O'Connell attorneys prepare and prosecute patent applications in the United States and worldwide. Our patent attorneys have diverse technical degrees and years of experience working in their technical fields. These factors allow us to understand and protect our clients' inventions. We also investigate and strategize patentability and freedom-to-operate issues.

Representative Matters:

- Developed a portfolio of U.S. and foreign patents and patent applications for an innovative nanotechnology company with a global presence.
- Built a portfolio of utility and design patents and patent applications for an air treatment equipment maker, paving the road for a global product launch.
- Provided patent strategy and developed a patent portfolio for a technology startup focusing on software and hardware Internet of Things (IoT) solutions.
- Developed both U.S. and international patent portfolio for a mid-size technology company developing software and service solutions for clinical trials.
- Built a portfolio of U.S. and foreign patents for a publicly-traded innovative drug developer that was licensed by a large pharmaceutical company
- Developed a patent portfolio with founding inventors for an orthodontic consumer baby product, and successfully out-licensed the portfolio to an international manufacturer
- Assisted a non-profit licensing office with the strategic development and positioning of an international patent portfolio, based on a university's small-molecule research program, for pharmaceutical partnership

Trademark

We handle the clearance and worldwide registration of trademarks. The depth of our experience in this area allows for efficient and timely protection of our clients' trademarks in appropriate geographic regions. We also handle contested matters in the U.S. Patent and Trademark Office.

Representative Matters:

- Obtained clearance and registration of a house mark and separate trademarks for a new line of products
- Resolved potential trademark oppositions through an agreement as to the scope of goods and services offered under the mark, and the classes of customers to whom the mark would be targeted
 - Obtained international registration of a trademark for a new line of goods based on a patent license



Attorneys

Thomas J. (TJ) Conte
Patricia L. Davidson
James C. Donnelly, Jr.
Alexandra N. Mansfield
Michael A. Refolo
Jeffrey E. Swaim

Paralegals

Cynthia M. John

**Excellence in our work.
Excellence in client service.
Excellence in value.**

Copyright

We protect software, websites, publications, images and other copyrighted works. We counsel clients regarding proactive strategies that will protect their substantial investments in these works, including ownership and licensing.

Representative Matters:

- Counseled a client as to ownership, registrability and enforcement of copyrights in materials delivered to its customers as part of the delivery of services
- Registered the copyright in a website resulting in rights that were enforceable against third parties
- Defended a client against an allegation of improper use of copyrighted materials

Portfolio Asset Management

Intellectual property rights are critical assets of today's businesses. We assist clients in developing strategies to identify, protect and exploit intellectual property. We also audit existing portfolios to identify critical intellectual property assets, and we advise clients on effective plans to maintain them. We advise clients regarding patentability and patent validity, infringement and enforcement issues. We counsel in the selection and protection of trademarks.

Representative Matters:

- Provided strategic advice to a university regarding the costs and advantages of foreign patent prosecution
- Developed and executed a complex litigation-based strategy to secure sole ownership of an intellectual property portfolio relating to the client's core business technology
- Advised a start-up company on the efficient use of funds to identify and protect critical patent and trademark properties

Licensing and Technology Transfer

Substantial value can be realized from and by intellectual property assets. We have depth of experience in all aspects of technology transfer, such as the in-licensing, out-licensing and sale of patents, software, trademarks, copyrights and trade secrets. Our attorneys advise on, negotiate and draft agreements relating to intellectual property, including licensing, joint venture, R&D, secrecy, supply and distributorship agreements.

Representative Matters:

- Developed and implemented licensing and product development programs for a start-up biotechnology company
- Assisted a medical device manufacturer with in-licensing intellectual property from a university
- Successfully negotiated business agreements for further development and distribution of custom medical devices, laboratory instruments and dental products, based on the client's core technology
- Analyzed and resolved a license dispute between a technology company and the licensing office of a university.

800.922.8337

www.mirickoconnell.com

WORCESTER | WESTBOROUGH | BOSTON

MIRICK, O'CONNELL, DEMALLIE & LOUGEE, LLP

Patent and Intellectual Property Litigation

Litigation is one of the options available to businesses as part of their offensive and defensive strategies to protect their valuable intellectual property rights. At Mirick O'Connell, our interdisciplinary practice blends the skills and experience of business attorneys and litigators to achieve our clients' objectives with regard to protection, exploitation and dispute resolution. Our litigators focus on enforcing and defending our clients' intellectual property rights in court and before arbitration panels and administrative agencies. Our intellectual property litigation experience includes cases involving patents, trademark/trade dress, copyright, trade secrets and related commercial disputes in the areas of anti-trust and unfair competition. Our litigation clients include individual entrepreneurs, small businesses, established and emerging companies and private and public companies.

Representative Matters:

- Defended a software company in a patent infringement suit brought by its major competitor.
- Represented a patent owner in patent litigation against a global technology company in federal district court and ITC.
- Defended a large retail chain against a patent assertion entity.
- Represented an inventor in patent litigation against a large software company in federal district court.
- Investigated pre-suit infringement theory for a major semiconductor company against its main competitor.
- Enforced patent licenses against licensees in arbitration.

800.922.8337

www.mirickoconnell.com

WORCESTER | WESTBOROUGH | BOSTON

MIRICK, O'CONNELL, DEMALLIE & LOUGEE, LLP