

## Intellectual Property

Greenspoon Marder's IP Practice Group provides a full-service practice focused on helping clients protect, enforce and exploit their intellectual property rights. Our lawyers represent clients of all sizes: individual inventors; entrepreneurs; small and mid-size businesses; and large multinational corporations. We leverage our diverse backgrounds in business, science, technology and law with an in-depth understanding of intellectual property rights to help our clients succeed in today's increasingly competitive global marketplace.

With decades of experience, we focus on the development, protection and exploitation of intellectual property. Our team has earned a reputation for aggressively litigating business-critical intellectual property assets and managing high-value IP portfolios for our clients.

Greenspoon Marder's attorneys, patent prosecutors and technical specialists have advanced scientific training and are admitted to practice before the U.S. Patent and Trademark Office (USPTO). We have the technical expertise to understand the hard science behind our clients' technical innovations. We also have an extensive network of foreign patent agents with whom we work on international patent matters. Our skilled professionals monitor and manage patent and trademark portfolios to efficiently maintain and enhance matters entrusted to us.

### Representative Matters

We have represented, among others, entities and individuals in the following industries: aerospace, insurance, timeshare, finance, apparel, real estate development and brokerage, software development, action sports, manufacturing, international mobile telecom, solar power, music publishing and entertainment, oil, rental car, and medical device. See our list of representative matters.

### Our IP services include

- Management of IP Portfolios, including [Patents](#), [Trademarks](#), [Domain Names](#) and other IP assets
- Intellectual Property Litigation, including [Patent](#), [Trademark](#), [Trade Secret](#), [Copyright](#) and [Domain Name Disputes](#)
- [IP Licensing](#), including licensing disputes
- Preparing and Prosecuting U.S. Patent Applications
- Preparing and Prosecuting U.S. Trademark Applications
- Post-Grant Patent Proceedings before the Patent Trial and Appeal Board (PTAB), including Inter Partes Reviews (IPRs), Covered Business Method (CBM) Reviews and Post-Grant Reviews (PGRs)
- Trademark Proceedings before the Trademark Trial and Appeal Board (TTAB)
- Uniform Domain Name Dispute Resolution Policy (UDRP) Proceedings
- Trade Secret Counseling
- International Trade Commissions (ITC) Section 337 Investigations
- Rendering Validity and Non-Infringement Opinions as well as Auditing Intellectual Property Portfolios
- In-House Educational Training and Seminars on Intellectual Property Law and Related Matters

Greenspoon Marder's IP practice group is a proud member of the International Trademark Association.

### Related Areas

- Intellectual Property Litigation
- Internet and E-Commerce Law

## News

- Greenspoon Marder Partner Robert Rando Elected To Serve As President Elect of the New York Intellectual Property Law Association
- Greenspoon Marder Represents Client Doré in Launch of Made In France Skincare Line
- Greenspoon Marder Partner Robert Rando Featured Speaker At New York Intellectual Property Law Association Patent Trial And Appeals Board Committee CLE Program
- Greenspoon Marder Represents Samson & Surrey in Significant Transaction
- Greenspoon Marder Launches Innovation & Technology Practice Group Led by New Partner Eric Galen in Miami
- Greenspoon Marder Attorney Bruce Siegal Featured Speaker at 10th Annual Mississippi Sports Law Review | NIL & IP Summit
- Greenspoon Marder Attorneys Alan Clarke and Peter Stathopoulos Participate In Georgia Intellectual Property Alliance's 15th Annual 2021 Corporate Intellectual Property Institute®
- Greenspoon Marder Names Sharon Urias as IP Practice Group Leader
- Super Lawyers Recognizes 11 Greenspoon Marder Attorneys In New York Metro 2021 Edition
- Greenspoon Marder Attorney Bruce Siegal Featured Speaker at the Georgia Intellectual Property Alliance Creators Community Virtual Gathering
- Greenspoon Marder Partner Robert Rando Featured Speaker at Federal Bar Association Webinar "A SCOTUS Review of IP Cases in the Recent 2020 Term and its Implications for Constitutional Jurisprudence in Other Areas of Law"
- Greenspoon Marder Welcomes Five New Partners In New York Including New Managing Partner
- You, Me & IP Webinar Series: It's Time to Confirm You're Properly Using Trademarks in Commerce
- You, Me & IP Webinar Series: Getting Back to Basics
- Greenspoon Marder Promotes Six Attorneys To Partner in 2021
- You, Me & IP Webinar Series: The Grinch Who Stole Holiday Trademarks
- You, Me & IP Webinar Series: A Cannabis Haiku
- Greenspoon Marder Hosts The You, Me & IP Webinar Series: "The Washington Football Team Is A \$3.4B Identity Crisis"
- You, Me & IP Webinar Series: The Washington Football Team A \$3.4B Identity Crisis
- You, Me & IP Webinar Series: COVID, Boomers and Karens: Oh My!
- Greenspoon Marder Secures Trademark for Pitbull's Signature Grito
- Greenspoon Marder Cannabis Client Awarded \$8,800,000 Final Judgment
- Greenspoon Marder Files Patent On Behalf of Wisconsin Student For Device That Could Help Save Lives During A School Shooting
- Greenspoon Marder Successfully Represents Client Before the Patent Trademark Appeal Board in Two Inter Partes Review Proceedings
- Greenspoon Marder Supports IP Counsel Exchange
- Greenspoon Marder Supports 8th Annual New York Health Forum
- Greenspoon Marder Partner Anton N. Handal Files Amicus Brief With The Supreme Court in Oil States Energy Services, LLC. V. Green Energy group LLC.
- Greenspoon Marder Announces Further Expansion with Addition of Intellectual Property Practice, Opening of Office in Nashville

## Videos

- You, Me & IP - Space Marks: To Infinity & Beyond!
- You, Me & IP: Cybersquatting is Back!
- You, Me & IP: Fashioning Intellectual Property to Suit
- You Me & IP - A Trademark Analysis of Santa's Workshop
- You, Me & IP - Intellectual Property Questions from MJBizCon Conversations
- Webinar: You, Me & IP - Sensory Trademarks

- Cannabis Quick Hits: Intellectual Property in the Cannabis Industry
- Registering Trademarks With U.S. Customs and Border Protection to Stop Infringing Imports
- Top Tips on Navigating Legal and Operational Startup Challenges
- Webinar: It's Time to Confirm You're Properly Using Trademarks in Commerce
- Webinar: You, Me & IP Series - The Grinch Who Stole Holiday Trademarks
- Webinar: You, Me & IP Series - A Cannabis Haiku
- Webinar: The Washington Football Team A \$3.4B Identity Crisis
- Webinar: COVID, Boomers and Karens: Oh my!
- Meet the Lawyers - Justin McNaughton (Intellectual Property)

## **Publications**

- Meta Shifts Trademark Reality
- Kat Von D Tattoo Copyright Infringement Suit – A Permanent Mistake?
- Big Candy and Big Food Companies Ask Congress To Intervene on Illicit Cannabis Packaging
- Sports IP: College Athletes and Name, Image and Likeness
- You, Me & IP Webinar Series: Sensory Trademarks: Selling to the Subtle Perceptions of Sophisticates
- GM Innovation Week: Catch You at the Border: Registering Trademarks With U.S. Customs and Border Protection to Stop Infringing Imports
- You, Me & IP Webinar Series: It's Time to Confirm You're Properly Using Trademarks in Commerce
- Greenspoon Marder Intellectual Property Blog: Profit Awards in Trademark Cases: Supreme Court to Decide Whether Willfulness Is Required
- Greenspoon Marder Intellectual Property Blog: GOTrademarks?
- Greenspoon Marder Intellectual Property Blog: Update to UGG! Generic or Not?
- USDA Accepting Applications of Seed-Propagated Hemp for Plant Variety Protection
- Greenspoon Marder Intellectual Property Blog: Dusting Off the UDRP (Uniform Domain-Name Dispute-Resolution Policy)
- Trademark Protection in China
- How to Protect Your Registered Trademark
- Can Blockchain Technology Protect Your IP Assets?
- USPTO Releases Revised Guidance for Patent Subject Matter Eligibility
- 3D Printing and IP Protection
- Do "Old Barbie" Alcoholic Beverages Really "Dilute" Barbie?
- Trademark Licenses in Bankruptcy Cases
- USPTO Harmonizes Claim Construction Standard with the Federal Courts for Inter Partes Review Proceedings
- Trademark Trolling
- Ugg! Generic or Not?
- Patent Lawsuit Fee Awards: How Much Is Enough to Be "Exceptional"?
- Is Kim Kardashian Feeling The "Vibes"?
- Coca-Cola or Dr Pepper?
- Attempting To Patent Cannabis-Related Inventions May Be Challenging
- Using Trade Secret Protection To Shield Your Marijuana-Related Intellectual Property
- Graffiti and Street Artists Sue for Copyright Infringement
- Parodies Can Be Protected from Intellectual Property Claims
- Another Trademark Battle Over Color
- Update: No Infringement in Allstate v. Kia Case

- Update: PayPal and Pandora Settle
- A Trademark Fight Over Nearly Identical Names: Is There Confusion?

## **Meet the Team**

- Eric Breitman
- Sandra Brown
- Alan S. Clarke
- Mark T. Doerr
- Ahmand R. Johnson
- Jerry Juste
- Jean M. Kim
- Justin McNaughton
- Kendall Minter
- Daniel Nageotte
- Aliya J. Nelson
- Michael Patrick
- Robert J. Rando
- Bruce B. Siegal
- Sharon Urias

## **Sub-Practices**

### **Trademark Law and Registration**

#### **Trademark Law and Registration**

There are many different ways in which a business can create branding. By using a trademark, you can build brand recognition and protect your business's identity. At Greenspoon Marder, we provide clients with tailored intellectual property services, including the handling of all trademark issues. We explain the differences between a registered trademark (®) and an unregistered trademark (™), and help you decide upon the best possible strategy to protect your brand.

#### **What Is a Trademark?**

A trademark is the hallmark that a company uses to identify itself or the goods and services that it provides. It can be a slogan, word, phrase, symbol, logo, image, or any combination of these elements. Though trademark registration is not required, it may be beneficial to protect your rights and to ensure that your business is the one being identified by the trademark.

#### **Trademark Creation and Licensing**

Our law firm's trademark practice includes counseling clients on choosing an identity that is strong, unique and protected by law. We have extensive experience dealing with the creation of trademarks and filing of applications in the United States Patent and Trademark Office (USPTO) and abroad. We can help you understand how a trademark will represent your business in the public's eye. We also prepare license agreements in order for other individuals and businesses to compensate you for the legal use of your trademark.

#### **Trademark Litigation**

When a trademark is used unlawfully, it is possible to get damages from and even stop the individual or entity who is

infringing the trademark. You may be entitled to monetary compensation if the trademark usage benefitted the persons using it without your permission. Learn more about our trademark litigation practice.

### **Contact an experienced trademark attorney at Greenspoon Marder.**

Contact Greenspoon Marder to schedule a consultation with an experienced trademark attorney.

### **Patent Counseling and Prosecution**

#### **Patent Counseling and Prosecution**

Greenspoon Marder's Intellectual Property Practice Group provides comprehensive patent counseling and prosecution services. In an ever-changing legal landscape, we do more than just prepare and file patent applications; we provide our clients with strategic counseling to efficiently obtain and maintain their patent rights.

At Greenspoon Marder, we learn your technology and business to customize services best suited to your needs, whether you are a first-time inventor or have an expansive patent portfolio.

From domestic provisional patent applications to coordinated international filings, our patent attorneys have decades of combined experience counseling clients on patent and design registration rights in a wide range of jurisdictions including the United States, European Union, China, Japan, South Korea, India, Canada, Australia and more.

Greenspoon Marder's patent counseling and prosecution services include:

- Rendering patentability, validity, and non-infringement opinions
- Preparing and prosecuting utility and design patent applications, including reissuing applications and reexaminations
- Obtaining and maintaining foreign patents and registered designs
- Counseling regarding direct and virtual patent marking
- Analyzing inventorship issues, making inventorship determinations, and reviewing invention disclosures
- Advising clients on patent lifecycle management
- Auditing and managing domestic and international patent portfolios
- Negotiating and preparing inbound and outbound patent licenses
- Providing in-house educational training and seminars on patent law and related matters

### **PTAB Proceedings: *Inter Partes* Review, Covered Business Method Review, and Post-Grant Review**

*Inter Partes* Review (IPR), Covered Business Method Review (CBM) and Post-Grant Review (PGR) are administrative trial proceedings conducted before the Patent Trial and Appeal Board (PTAB).

The America Invents Act authorized the filing of petitions for IPR, CBM, and PGR as of September 2012. An IPR allows reconsideration of a patent's validity before a panel of administrative judges, but only based on patents or other published prior art. At the same time, the procedure allows a patent owner to amend challenged claims to avoid cancellation. While a CBM proceeding allows reconsideration of a patent's validity on almost any ground, including patent ineligibility under 35 U.S.C. §101, it only applies to patents that claim "a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service." A PGR proceeding may also test the validity of a patent on almost any ground, but is only available for up to nine (9) months after a patent issues.

IPRs, CBMs, and PGRs require both technical and litigation skills, as it involves aspects of both patent prosecution and litigation. The PTAB clearly expects the attorneys practicing before it to have an extremely high level of skill and expertise. Greenspoon Marder is recognized nationally as a go-to intellectual property firm that possesses the essential combination of litigation and prosecution expertise necessary to succeed in these administrative proceedings before the PTAB.

### **International Trade Commission (ITC) §337 Investigations**

Section 337 investigations are conducted by the United States International Trade Commission (ITC) and most often

involve allegations of patent and trademark infringement by importers of goods. The primary remedy is an exclusion order that directs United States Customs to stop infringing imports from crossing the border. In other words, goods may be prevented from entering the United States.

These ITC Section 337 investigations have become powerful weapons to keep potentially infringing products out of the United States. Used effectively, the holder of United States patents and trademarks can wage war on foreign competition in ways that is not available in traditional litigation.

Whether you are a company seeking to stop the importation of competing products, or a company that is threatened with an ITC Section 337 action aimed at keeping your products out of the United States, you need a skilled and experienced team of attorneys that understand and have experience with the rules. ITC § 337 proceedings are different, rigid and extremely complicated, and are highly technical and expensive. Greenspoon Marder's attorneys have handled several ITC matters and are readily available to assist you in navigating this highly specialized area of the law.

## **IP Licensing**

### **Licensing of Intellectual Property Rights**

Whether you are the IP owner or the licensee, both parties have rights and obligations as stated in their license agreement. Before a dispute even arises, you will need a lawyer who understands IP licensing issues to avoid any hidden traps or loopholes and strategically capitalize on the transaction. Should a dispute develop, delaying action may result in increased damages. Discuss your situation with an experienced attorney.

Greenspoon Marder's IP Practice Group has substantial experience negotiating, drafting and litigating licensing agreements. Every case we handle receives our personal attention from start to finish.

Our law firm handles licensing disputes throughout the United States involving:

- Use of a trademark without meeting the quality and auditing requirements of the original licensing agreement.
- Failure to keep accurate accountings and/or to pay royalties.
- Misuse of the trademarks or other IP interests.
- Failure to abide by confidentiality obligations.
- Other breaches of licensing agreements.

### **Make sure the requirements of the license agreement are met.**

When one party fails to meet its obligations under a license agreement, an experienced attorney will be able to sort through the facts and determine the appropriate action to take in order to protect the business. Contact Greenspoon Marder today to discuss how we may fulfill your Intellectual Property needs.