

## Intellectual Property Litigation

### Skilled in complex IP disputes

A business builds its reputation and identity by developing strong brands. Its inventions, innovations and designs are essential to its success and growth. Intellectual property is not tangible like real property, but it is every bit as important and protecting it is vital to your business interests. At Greenspoon Marder, we understand the importance of your IP, and we have the experience and knowledge to help protect and defend your trademarks, patents, trade secrets, trade names and copyrights. Our firm handles disputes and litigation involving a wide range of intellectual property law matters including:

- Patent litigation: If someone has violated your patent rights or if you are accused of infringing the patent rights of another, we have the expertise and experience to protect your rights.
- Trademark litigation: If others infringe on your trademark, you need to take steps to protect your interests. If you are accused of infringing on another's mark, our law firm will fight to protect you.
- Trade Secret litigation: We know what it takes to protect your confidential; trade secrets through all stages of litigation, as well as to assist you defend against allegations of trade secret misappropriation.
- Copyright litigation: If someone has used your copyrighted works without your authorization or permission, it is essential to take immediate action to protect your intellectual property. Or, if you are accused of using someone else's copyright, we will defend your rights and your interests.
- Domain Name Disputes: It is essential to protect your domain name from cybersquatters, competitors or others that seek to exploit your valuable IP interests. We will help you protect your domain name through informal resolution, WIPO/NAF arbitration, Uniform Domain Name Dispute Policy (UDRP) or in federal court under the Anti-Cybersquatting Consumer Protection Act.
- Licensing disputes: Has another party breached a license agreement or failed to meet its obligations under a license agreement? Has someone else accused you of breaching a license agreement? We can help you determine what action to take. No matter which side of a dispute you are on, it is essential that you retain an attorney experienced in intellectual property litigation.
- Reverse Domain Name Hijacking: occurs when trademark owners abusively assert their trademark rights to strip domain names from rightful owners.

### Your rights and interests deserve the attention of an experienced IP attorney.

At Greenspoon Marder, you can count on experienced, knowledgeable representation and a high level of service. Contact Greenspoon Marder today to discuss how we may fulfill your Intellectual Property needs.

### Related Areas

- Intellectual Property
- Internet and E-Commerce Law

### News

- Greenspoon Marder Partner Sharon Urias Speaker At The Arizona State Bar Convention
- Greenspoon Marder Partner Sharon Urias Featured Speaker At Arizona Apparel Foundation's 3D Printed Fashion Workshop "Dress To Impress: How To Protect Your Trademark"

## Meet the Team

- Michael Patrick
- Robert J. Rando
- Sharon Urias

## Sub-Practices

### 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.

### **Licensing Disputes**

#### **Trademark Licensing Disputes**

When it comes to trademarks, whether you are the IP owner or the licensee, both parties have rights and obligations as stated in their licensing agreement. If there is a dispute, you will need a lawyer who understands trademark licensing issues, and can help you determine the best action to take. Delaying action can result in increased damages. Discuss your situation with an experienced attorney.

Our firm handles trademark 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 subject marks or other IP interests.
- Failure to abide by confidentiality requirements.
- Other breaches of licensing agreements.

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

When one party fails to meet its obligations under a licensing 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 for an appointment.

### **Reverse Domain Name Hijacking**

In the competitive world of business, attempts by people to bring their businesses to the forefront often raise legal issues. One of these issues is called "reverse domain name hijacking." Reverse domain name hijacking occurs when trademark owners abusively assert their trademark rights to strip domain names from rightful owners.

You may be the victim of reverse domain name hijacking if someone tries to intimidate you to give up your domain name under the guise of trademark ownership. This may occur even if use of your domain name does not violate any trademark

laws. Reverse domain name hijacking is a serious problem and can cause you to lose your domain name and/or seriously damage your business. If you are the victim of reverse domain name hijacking, you may have a claim against the “trademark owner” under federal law.

Often what may occur is the “trademark owner” files a UDRP complaint against you and successfully obtains transfer of your domain name away from you.

### **Someone took my domain away!**

How do you address this problem? At Greenspoon Marder, we believe it is always prudent to see whether amicable resolution is possible so as to avoid the expense and time involved in litigation. That is not always possible. Sometimes, you may need to file a lawsuit in order to recover your domain name. While situations vary, under the federal Lanham Act, generally you need to show that:

1. You are the registrant of the domain name;
2. The registration was suspended, disabled or transferred under a registrar's policy;
3. The owner of the trademark that caused the domain name to be suspended, disabled or transferred has notice of the lawsuit; and
4. Your registration or use of the domain is not unlawful.

If the above conditions are met, you may win a lawsuit to recover your domain name. A court may issue an order requiring the registrar to permit you to register the domain name or to transfer the domain name back to you.

An exceptional case may entitle you to an award of attorney's fees. Although in most cases attorneys' fees are not awarded in trademark disputes, a court may award you attorneys' fees if you win your lawsuit and you can prove the other side's position was groundless, unreasonable, vexatious, or pursued in bad faith.

### **Our attorneys strive to resolve Internet domain name disputes efficiently and successfully.**

Greenspoon Marder offers effective, knowledgeable representation in litigation and other disputes arising out of Internet-based commerce. We serve individuals and companies in throughout the United States. If you have concerns about E-commerce law, Internet law or how to protect and promote your business, contact us for an appointment.

## **Domain Name Disputes**

### **Trust us to protect your rights.**

Domain names can present numerous issues requiring the services of an experienced attorney. We have a particular emphasis on matters involving cybersquatting and trademarks, and we will help you protect your domain name through informal resolution, WIPO/NAF arbitration, Uniform Domain Name Dispute Policy (UDRP) enforcement or in federal court under the Anti-Cybersquatting Consumer Protection Act.

If your dispute involves a domain name registered with GoDaddy.com, which is based in Scottsdale, Arizona, we welcome you to contact Greenspoon Marder at our Scottsdale, Arizona office. We have extensive experience dealing with domain name disputes, trademarks and brand identity protection. And, we work hard to preserve the favorable reputation we have earned throughout the local and national legal communities.

Disputes over domain names can arise in many circumstances. Someone may own a domain name that infringes your trademark or use a domain name that is confusingly similar to your trademark. A competitor may register a domain name that incorporates your trademark and points it to a competing website. A former partner or employee may leave your company and attempt to take your domain name with him or her.

At Greenspoon Marder, our primary objective is to achieve our clients' goals in the most efficient and cost-effective manner possible. We will discuss your options and come up with a strategy to protect your domain name as effectively as

possible. If it suits your best interests, we will pursue alternative dispute resolution, such as mediation or arbitration. But our experienced litigators always remain ready to vigorously fight for you in court when necessary.

Technology is constantly changing and the laws are trying to keep up. Our trademark attorneys work hard to stay current on all of the laws that apply to domain name disputes and other electronic intellectual property matters. We can advise you on your rights and help you understand the obstacles you may be facing. Contact Greenspoon Marder to further discuss your specific domain name dispute questions and concerns.

## **Trade Secret Litigation**

### **Trade Secret Litigation**

#### **Protection against theft and infringement.**

Protecting your company's trade secrets is crucial to ensuring that your business plans, customer lists, pricing, processes, codes, designs and other proprietary information do not fall into the hands of any of your competitors. When a trade secret is stolen or revealed by a former employee, your business can suffer significant damage, both financially, and in terms of your market share.

At Greenspoon Marder, we offer extensive advice on a very wide range of issues relating to the protection of your company's trade secrets, including:

- **Pre-employment contracts:** Maintaining the competitive edge of your business by creating legally binding agreements that prevent employees from sharing sensitive information they learn on the job. We will advise you regarding the enforceability of your contracts with employees, independent contractors, partners, manufacturers, and all other involved parties.
- **End trade secret infringement:** Discovering that someone has stolen or shared your company's confidential information can be frustrating. Fortunately, you have legal recourse not only to stop the other party's use of your information, but also to seek damages for losses you may have incurred. Our attorneys will discuss all of your options with you, including how to stop the use of your proprietary information in the quickest and most cost-effective manner. We also will offer advice regarding your options to pursue compensation in order to make your business whole once again.
- **Litigation defense:** If your business has been accused of utilizing misappropriated information, it is important to address the issue swiftly and forcefully. Our attorneys also offer aggressive defense against trade secret litigation in an effort to help your business avoid an adverse judgment.
- **Inventorying key information:** Understanding which information is key to your business can be extremely difficult. Our attorneys offer advice on information that should be clearly protected, and the steps necessary to do so.

#### **Contact a skilled IP lawyer with your trade secret concerns.**

Protecting your private information from competitors is vital to the success of your business; our attorneys will offer the advice you need to understand your options for securing all of your trade secrets.

Contact us to schedule an appointment to discuss your specific trade secret concerns with one of our attorneys.

## **Trademark Litigation**

### **IP Attorneys protecting your valuable assets.**

If you fail to protect your trademark, or if you allow it to be used by someone else without permission, it will lose its value to your business. If you believe that your mark is being used – either without permission or without payment of agreed-upon fees – talk to an attorney experienced in trademark litigation as soon as possible. Your lawyer can send a cease-and-desist letter. If the unlawful use does not stop, you may need to consider taking additional action.

Trademark lawsuits generally are tried in federal courts, but trademark disputes also may be conducted by the Trademark Trials and Appeals Board (TTAB). Greenspoon Marder's IP Practice Group has a wealth of experience protecting and defending trademarks for our clients.

- If necessary, we will take immediate action to protect your rights by sending a cease-and-desist letter, filing a lawsuit, or taking action in the TTAB.
- If someone uses your trademark unlawfully, you should be paid out of that entity's profits.
- If you are accused of trademark infringement, prompt action may be required to reduce or avoid potential exposure and continue business operations.
- Use of a similar name is not always infringement of a trademark.

Greenspoon Marder will aggressively litigate your case in court or the TTAB, whenever necessary. Our firm philosophy, however, is that we try to resolve every matter in the most expeditious and cost-effective manner for every one of our clients. We believe that it often is better for our clients to pursue resolution through mediation or arbitration, if possible, in order to avoid the time and expense of court, but are also willing and able to take the matter trial when necessary.

### **Talk to an experienced attorney if you suspect a trademark violation.**

The first step in protecting a trademark is to consult a lawyer who can advise you about your rights, and who will fight to protect your trademark. An experienced attorney can explain the law and whether your trademark has been violated under the law. Contact Greenspoon Marder to discuss any suspected trademark violations.

## **Copyright Litigation**

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#### **Protect your creative works.**

Counterfeit CDs, songs that copy your original work and unauthorized use of photography or other creative works may all constitute infringements of your intellectual property rights. If a business or individual is unlawfully using your copyright, you need to take steps to protect your valuable assets. Step one is to consult a lawyer with experience in copyright litigation.

Your attorney can analyze your case and help you assert your rights by sending a cease-and-desist letter or even filing a lawsuit.

At Greenspoon Marder, our IP Practice Group is thoroughly knowledgeable about copyright law. We have represented clients in issues including:

- The sale and distribution of counterfeit CDs
- The use of copyrighted material without the payment of royalties
- The sale of "bootlegged" music
- Using photography without permission or payment
- Violation of a license agreement

E-commerce has added a new dimension to copyright infringement, including the theft of music and art from Internet sites. We have experience making and enforcing demands under the Digital Millennium Copyright Act (DMCA).

### **Contact our experienced copyright litigation lawyers.**

If your copyrighted material has been used without permission, talk to a lawyer who regularly practices intellectual property law and is experienced in copyright litigation. Contact us for an appointment.

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