

## 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.

## **Related Areas**

- Intellectual Property
- Intellectual Property Litigation
- IP Licensing
- Trademark Law and Registration
- Trademark Litigation
- Patent Litigation
- Copyright Litigation
- Trade Secret Litigation
- Domain Name Disputes
- Reverse Domain Name Hijacking
- Internet and E-Commerce Law
- Licensing Disputes
- List of Representative Matters

## **News**

- Greenspoon Marder Ranked Among the Best Law Firms by Best Lawyers® for 2024