

Intellectual Property

Our legal knowledge, engineering and science backgrounds, business acumen, and fluency in various industries and technologies enables us to provide a full range of intellectual property services to clients located around the globe. Our attorneys provide patent, trademark, copyright, and related licensing, outsourcing and technology agreement services to large multinational corporations, middle market participants, emerging companies, higher education institutions, nonprofit organizations, individuals, and entrepreneurs.

Patents

We strategically work with our global affiliates to procure and protect patents in countries around the world. Our attorneys are experienced in evaluating technologies for patentability and drafting and prosecuting patent applications. The Firm represents clients before the U.S. Patent and Trademark Office in obtaining patents and in post-grant review of patents, including appeals to the Patent Trial and Appeal Board of the U.S. Patent and Trademark Office. Our experience in patent procurement spans a broad range of industries and technologies, including:

- Medical devices
- Energy production systems
- Computer software, including software for the financial and medical industries
- Integrated circuit manufacturing and design
- Exercise and sports equipment
- Document, mail and package processing and handling technologies
- Automotive-related inventions, including manufacturing equipment, and chemicals and tools for automobile repair and maintenance
- Semiconductor device packaging
- Camera technology
- Optoelectronic devices
- Chemical processes
- Industrial manufacturing equipment
- Stored data protection
- Environmental remediation and sampling technology
- Manufacturing methods
- Mechanical devices, including fasteners, support structures for tools and pet supplies
- Surgical training and instruction aids
- Furniture and decorative items

Representative matters include:

- Procured domestic and foreign patents for inventions directed to energy production systems with reduced carbon output.
- Obtained patent protection in the U.S. and abroad for camera-related technology developed by an inventor who is an inductee into the National Inventors Hall of Fame.
- Conducted due diligence related to a client's potential investment in a company facing a patent infringement claim. This included assessing the scope of the subject patent directed to the configuration of a computer network running a gaming program and evaluating the infringement claim.
- Prepared and prosecuted patent applications directed to commercial, high-speed document processing machines.
- Counseled clients against whom assertions of infringement were made based on the use of computer-implemented methods as part of clients' website.
- Prepared and prosecuted patent applications for computer implemented inventions developed for use by the U.S. military.
- Obtained patent protection for clients in the telecommunications and semiconductor industries directed to computer chip manufacturing processes, such as photolithography and chemical-mechanical planarization and polishing.

Trademarks

Schnader's Intellectual Property Practice Group registers, maintains and protects trademarks for domestic and foreign clients. Our docket of over 2,600 U.S. and foreign applications and registrations includes marks used in a broad range of industries, such as pharmaceutical, automotive, clothing, food and consumer products. We also oversee the trademark portfolios of higher education entities, comprising marks

associated with academic and athletic programs.

We advise our clients on selection and protection of brand names, slogans and source identifiers to distinguish their goods and services from those of competitors. We evaluate the benefits of securing trademark registrations throughout the world and handle the registration process. We represent clients in contested proceedings before the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office.

Representative matters include:

- Develop and protect university trademark portfolios, including coordinating efforts of athletic personnel and in-house counsel, to maximize licensing fees.
- Registered trademarks in China that were previously blocked by a trademark "pirate."
- Represented a large research and clinical care organization in Pennsylvania with the protection and defense of their trademarks.
- Negotiated the settlement of a claim that a U.K. client's use in the U.S. of its internationally protected trademark infringed the rights of a U.S. trademark owner.
- Protected marks on behalf of a university against unauthorized use by various business consulting services companies.
- Counseled client on the selection and adoption of new names and logos for its various gaming activities and registered the selected marks in the U.S. Trademark Office.
- Protected the house mark for a pharmaceutical client and prevented registration of similar marks for competing pharmaceuticals.
- Guarded a well-known food franchisor's mark against infringing use from one of its competitors.

Copyrights

Schnader assists clients in protecting original works of authorship by obtaining registration in the U.S. Copyright Office. We also counsel clients on copyright fair-use issues. Our firm provides copyright services related to websites, audiovisual works, computer software, paintings, jewelry, furniture, music and literature. We also advise clients on issues involving ownership and adaptation of works that may be subject to copyright. We enforce clients' rights and secure compliance with settlements arising from copyright proceedings.

Representative matters include:

- Represented clients in the publishing industry in licensing copyrights for translated works and the original works in English.
- Prepared agreements to license original compositions and recorded performances by composer/musician to publisher.

- Counseled a copyright owner on terms of agreement transferring rights to produce movies and television series based on a book series.
- Registered copyrights in clients' computer software and website content.
- Negotiated a comprehensive license agreement for technology, know-how, and copyrights in related documents.
- Counseled a business on the merits of a publisher's assertion that the business violated a license agreement by internally distributing copies of newsletters.
- Advised a client on copyright protection of product manuals and parts lists in the automotive industry.
- Counseled a jeweler on the ownership of copyrights in jewelry designs created by a freelance designer.

Technology Transactions and Outsourcing

Our attorneys are experienced in areas of the law relating to the commercialization of technology, including intellectual property licensing, restrictive covenants, privacy issues, free-speech issues and antitrust issues. We have handled numerous high-profile matters involving online commerce and complex technology, and business process outsourcing transactions. Representing clients who operate social media websites, search engines, and portals, we create and review terms of use and privacy policies governing such issues as the distribution of customer content, privacy and payment and potential advertising opportunities.

We negotiate and draft intellectual property ownership agreements, both as stand-alone contracts and as adjunct documents to employment or independent contractor agreements, and licensing, leasing, and acquisition transaction agreements. We facilitate the ownership transfer of intellectual property associated with acquisitions and within business entities, by assigning and recording rights in the U.S. and foreign countries. We represent both banks and borrowers where the proceeds of the loan will be used for the purpose of acquiring technology or where intellectual property is provided as security for the loan. We also assist clients in protecting and maintaining intellectual property during bankruptcy proceeding.

Representative matters include:

- Represented a major equipment leasing firm in the negotiation and preparation of licensing agreements and service level agreements to establish an Internet portal automating decision-making on credit requests by the firm's customers.
- Reviewed and drafted advertising terms and conditions for product placement (media buys) on retail websites.
- Represented major financial institutions in the negotiation of data licenses, check-clearing, and electronic-trading agreements.
- Represented a large credit card processor in outsourcing the printing and mailing of invoices and statements.
- Conducted IP audits/assessments in connection with technology and licensing transfers for mergers

and acquisitions.

- Drafted UDRPs, DMCA takedown notices and demand letters in order to maintain the commercial impression and integrity of registered trademarks and copyrights on the Internet.
- Represented a large multinational corporation in the global outsourcing of integrated facilities management.
- Acted as principal outside counsel on technology matters for one of the country's leading online retailers of goods and services.
- Reviewed mobile phone provider developer terms and conditions to advise client on concerns and business issues related to the development of smartphone mobile applications.
- Represented a large hospital group in the outsourcing of its IT department, including licensing third-party technology used in the service and negotiation of hosting agreements.

Contacts

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