



Intellectual Property Practice

Hinshaw & Culbertson LLP understands the importance of your intellectual property (IP) to the success of your business. IP often is developed not by a “flash of genius,” but by hard work, long hours and dogged determination. Our IP team has that same work ethic and dedication to help you with a full range of services, no matter your size or industry. Our clients range from sole proprietorships to Fortune 100 companies, in industries and technologies as varied as compact fluorescent lamps (CFLs), food and beverage products and equipment, healthcare devices and drugs, software, business methods, to mechanical and electronic devices. Our diverse technical backgrounds in science and engineering and years of hands-on experience provide clients with a diverse and comprehensive understanding of technology and law to produce results for you.

Intellectual Property Protection, Counseling and Litigation

Increasingly, intellectual property (IP) impacts many issues that most businesses face. When confronted with an IP issue, it is imperative to seek advice from a firm having lawyers dedicated to IP with comprehensive experience. Hinshaw is that firm. We protect all types of intellectual property, counsel clients on IP issues ranging from simple to complex, assert IP on behalf of IP owners and defend clients charged with IP infringement. We are especially adept and well-seasoned in our patent prosecution practice. We help you fend off threats from patent trolls and efficiently handle lawsuits filed by them. We negotiate licenses, counsel clients on patent issues and provide advice and formal, written patent opinions on validity, infringement, enforceability and design-around. Our lawyers handle merger and acquisition matters relating to patents, trademarks, copyrights, unfair competition, trade secrets, privacy and antitrust.

Attorney Advertising: Prior results do not guarantee future performance.





Patents

Transactions

Hinshaw is active in providing a full range of intellectual property advice to clients. Our intellectual property practice includes preparing and negotiating contracts, including license and asset purchase, contract manufacturing, distributing, product development and joint venture agreements.

Hinshaw's intellectual property attorneys have substantial experience in all aspects of intellectual property in mergers and acquisitions, including due diligence and risk evaluation and validity, infringement and enforceability issues.

Patent Procurement and Management

Hinshaw has highly experienced and skilled attorneys with varied technical backgrounds including chemistry, chemical engineering, computer science, electrical engineering and mechanical engineering. Our patent procurement and portfolio management practice helps you identify, establish, enforce and obtain value from your United States and foreign patents. Unlike some large-firm "prosecution mills," our group is small enough to provide dedicated personalized representation. Consequently, our lawyers become familiar with your business and its existing and future product fields. This understanding helps you expend resources on patent portfolio development in a cost-effective manner. The result is increased long-term value for you, your shareholders and your customers.

Hinshaw lawyers have substantial expertise in numerous technical areas. Some specific areas include: batteries; blasting formulations; electronic devices, including compact fluorescent lamps; microprocessors; semiconductors; solar cells; coatings (including CVD, sputtered, and electromagnetic); contact lens solutions; food and beverage technologies; medical devices and methods, including contact lenses, blood storage, orthotic and prosthetic devices, drugs, wound dressings, synthetic blood, surgical equipment; organic chemistry; software and hardware for many types of industries; wireless mobile sensing systems; cellular routers and gateways; cargo tracking; and network edge platforms.

Freedom to Practice, Design Around

When your company expects to introduce a new product or service, it is valuable to identify and address any patent problems before launch, especially for key products. Our lawyers are available to evaluate that product or service against the existing patent landscape and render advice, and if desired, a formal freedom to practice. Our specialized knowledge and experience enables us to efficiently evaluate the matter, and if needed, develop design alternatives or find any invalidating prior art.

America Invents Act

Our in-depth understanding of the first-to-file America Invents Act of 2011 allows us to better position our clients now and in the future. The advent of increased Patent Office-based hybrid prosecution/litigation procedures to either potentially strengthen or attack a third party's patents plays into our deep understanding of both patent prosecution and litigation. These AIA-based proceedings include *ex parte* and *inter partes* proceedings. Patent owners have three potential options of strengthening an existing patent: *ex parte* reexamination, patent reissue and supplemental examination. Patent challengers have a total of four options: *ex parte* reexamination, post-grant review, *inter partes* review, and derivation (or interference for some patents) proceedings. Our attorneys advise you on the advantages and availability of each type of proceeding, and then we implement the desired strategy.

IP Litigation

Infringement, Validity and Other Evaluations

Before filing suit or before determining a proper litigation strategy, it is important to identify and evaluate infringement and other issues relating to patent invalidity and enforceability. Our IP lawyers are highly skilled in all of these areas. An objective and properly conducted evaluation provides a solid basis and foundation for future action, which is always the best strategy for a successful business.

Trolls

We handle these types of cases efficiently for our clients using techniques we have developed through our past successful representations. Our attorneys also have had great success in representing our clients against litigious non-practicing patent entities or trolls. For example, we represented an online retailer in responding to threats made by a variety of trolls. Often, we have persuaded the troll to not file suit against our client, with no payment to the troll. In a case where our client was sued, we successfully sought indemnification from its software vendor, allowing our client to avoid a costly waste of time and resources. We also recently settled another litigious patent holder case on very favorable terms early in the case after reviewing its other license agreements and raising new and unique defenses for our client.

Our Approach

Where litigation becomes necessary, as sometimes happens, our team of litigators — which has handled litigation matters in numerous technologies in district courts around the country — provides skilled counsel. This trial experience bolsters our clients' negotiating positions.

Hinshaw has extensive patent infringement litigation experience, including jury trials and appeals. We have successfully represented both patent holders and accused infringers, ranging in size from individuals to Fortune 100 companies. Our depth of experience in these areas provides a comprehensive understanding of the patent litigation process and how to attack (or defend) patents in litigation. Having seen patent infringement issues from every conceivable angle, we are able to objectively view and evaluate patent disputes. We are able to understand our opponent's likely goals and strategies as well as reasonable outcomes under the particular circumstances of a case.

More specifically, our attorneys defended the accused infringers in a successful two-week jury trial and appeal that resulted in the invalidity or unenforceability of all four asserted patents. Our attorneys defended another client in a successful two-week jury trial resulting in an award of damages that was five percent of what the plaintiff sought at trial. We represented a plaintiff asserting breach of a license agreement and patent infringement claims in a three-week arbitration hearing resulting in a favorable settlement when defendants called asking to settle the night before the arbitrators were to rule. We represented a patent holder in a declaratory judgment action brought by Oracle, which settled for eight figures on the eve of trial.

Although we can handle a patent infringement case all the way through to a successful trial and appeal, we recognize that this is not usually your most desired strategy. We therefore work with you to ensure you accomplish your business goals, whether the matter at hand is litigation, licensing or other counseling.

An adverse result in an intellectual property litigation case can mean the difference between remaining a going concern and going out of business. We understand litigation is nothing to leave to chance. We provide you with the client service and practical, bottom-line focus customary of an intellectual property boutique law firm, and the experience that comes from a multidisciplinary national law firm that has handled large-scale patent litigation cases for some of the world's leading companies.

Our experience and approach — unlike that of many other law firms with a patent litigation practice — does not entail turning over every rock and digging into side issues that unnecessarily drive up the cost of litigation. Rather, we focus on the issues that matter and strive to keep both the court and the opposing party on track to an expeditious and efficient resolution.

Comprehensive Representation — From Start to Finish

We handle all aspects of patent litigation, from the inception of the claim to its ultimate conclusion, whether by means of a settlement, mediation, verdict, or appeal to the Federal Circuit or U.S. Supreme Court. As members of a national law firm, our patent litigators can tap into the firm's multidisciplinary resources when our clients are confronted with unique issues that fall outside the traditional patent law setting. As necessary, our Appellate Practice attorneys can provide trial-level legal assistance

to prepare dispositive and other pretrial motions, craft jury instructions, and develop post-trial motions to strengthen our clients' position in the event of an appeal. Where defending or prosecuting an appeal becomes necessary, our patent litigators and appellate lawyers collaborate to provide legal representation tailored to your business goals, the patent at issue and the unique appellate process.

Hinshaw's Experience

Hinshaw's patent litigation attorneys have litigated patents involving numerous technologies, including: computer software, consumer products, electronics, hardware, industrial products, and medical devices.

We have handled patent litigation across the United States. Given our strategic office locations throughout 11 states, we frequently are able to provide local counsel, no matter where the court is located. We are extensively experienced and have handled trial litigation in jurisdictions that see some of the highest volumes of patent cases, including California, Delaware, Illinois, Texas (including the Eastern District of Texas), and Wisconsin (including the Western District of Wisconsin).

In addition to representing clients in U.S. district courts across the country, we have appeared before the U.S. Court of Appeals for the Federal Circuit numerous times and have patent litigation experience before the U.S. Supreme Court.

Copyright

Hinshaw's Intellectual Property Practice attorneys provide effective legal representation to businesses and individuals in copyright litigation and copyright-related transactional and risk-management activities. We are experienced in handling copyrights involving both traditional and electronic platforms. Among many other activities, we handle legal matters involving:

- ◆ Acquisition and protection of copyrighted works
- ◆ Questions of fair use and permissions
- ◆ Clearance evaluations
- ◆ Copyright audits
- ◆ Copyright registrations
- ◆ Drafting of and responses to cease and desist letters
- ◆ Drafting of ownership and history reports
- ◆ The Digital Millennium Copyright Act
- ◆ Enforcement of copyrights
- ◆ Evaluation of clickwrap and shrinkwrap agreements
- ◆ Investigations and obtainment of clearances where appropriate
- ◆ Negotiating of licensing and ownership agreements, including issues of "work made for hire" and assignments and as to multimedia licensing
- ◆ Due diligence in corporate acquisitions involving copyrights
- ◆ Copyright training programs

Trade Secrets

Trade secrets can be a key aspect of your operations and success – potentially providing a long-lasting competitive advantage in the market for your company under proper circumstances. Our lawyers help you identify, compile and safeguard your trade secrets and other confidential information against theft and destruction. We can prepare and implement enforceable nondisclosure and other confidentiality agreements, provide advice on other sound policies and procedures, and advise on proper disclosure protocols. We also advise on the proper protections to implement to protect against employee theft, including the drafting and use of confidentiality agreements and employee handbook provisions and the implementation of security and access policies.

When a theft or unauthorized use is suspected, quick, decisive and often aggressive action must be taken to stop further use and dissemination and to secure the return of the trade secrets and other confidential information. We handle misappropriation cases in state and federal courts throughout the United States. We also advise and take appropriate legal action to stop further use and dissemination of trade secrets and other confidential information and secure their return.

Our attorneys draft legally compliant confidentiality agreements and restrictive covenant agreements tailored to your business's operations. We also draft and help implement policies and procedures designed to reduce the possibility of theft and to enhance a business's ability to pursue legal action if necessary.

Technology

The information revolution of the late-20th and early-21st centuries has resulted in full-scale changes to the way businesses and societies operate and evolve. It goes without saying that today, to fully maximize their potential, businesses must integrate computers, the internet and other technological tools into all aspects of their operations. But equally important, in light of the many opportunities and risks that come with doing so, is incorporating these tools wisely. Access to sophisticated advice on how to address the legal aspects of smartly harnessing existing and new technologies is now vital.

- ◆ Web Development Activities
- ◆ Web Development Agreements
- ◆ Domain Name Issues
- ◆ Hosting Agreements
- ◆ Privacy Policies
- ◆ Communications Decency Act Section 230 Compliance
- ◆ Digital Millennium Copyright Act Safe Harbor Issues
- ◆ Electronic Privacy
- ◆ Software Licensing

Trademarks

Hinshaw's trademark practice focuses on the areas of brand selection, domain name dispute resolution, domestic and foreign trademark clearance and prosecution, right of publicity, trademark litigation, and unfair competition. We also assist businesses and individuals on matters such as: counseling and monitoring to confirm that intellectual property rights are used properly and effectively; creating enforcement programs and procedures that promote effective use of the intellectual property; identifying, defining and maximizing the intellectual property that has or needs protection; negotiation and drafting of licenses, assignments, and other agreements related to the intellectual property rights obtained; policing against improper use of the intellectual property rights of others; and trademark clearance opinions and searches.

- ◆ Trademark Portfolio Management
- ◆ Trademark Monitoring, Protection and Enforcement
- ◆ Domain Name Review
- ◆ Internet Searches
- ◆ Watch Service
- ◆ Licenses
- ◆ New Trademark Applications
- ◆ U.S. Customs and Border Protection

About Hinshaw & Culbertson LLP

Hinshaw & Culbertson LLP is a U.S.-based law firm with offices nationwide. The firm's national reputation spans the insurance industry, the financial services sector and other highly regulated industries. Hinshaw also serves as counsel to the professional services sector, and provides business advisory and transactional services to clients of all sizes. Visit www.hinshawlaw.com for more information and follow @Hinshaw on LinkedIn and Twitter.

Contact Us

For more information on our Intellectual Property Practice, please contact:

David H. Levitt
Intellectual Property Practice Leader
151 North Franklin Street
Suite 2500
Chicago, IL 60606
312-704-3515
dlevitt@hinshawlaw.com