



# INTELLECTUAL PROPERTY PRACTICE

## INTELLECTUAL PROPERTY PROSECUTION & COUNSELING INTELLECTUAL PROPERTY & TECHNOLOGY LITIGATION

THE INTELLECTUAL PROPERTY PRACTICE GROUP IS STAFFED TO MEET THE CHALLENGES  
OF ONE OF THE FASTEST-MOVING AREAS OF THE LAW.

Shook, Hardy & Bacon has a long history of success representing multinational and U.S. companies in patent, trademark and copyright infringement cases. Staffed to meet the challenges of this fast-paced area of law, the SHB Intellectual Property Prosecution & Counseling Practice comprises more than 45 patent attorneys who hold various Bachelor of Science degrees, eight patent agents and four patent analysts. The SHB Intellectual Property & Technology Litigation Practice includes attorneys with diverse undergraduate degrees that allow them to communicate on a wide variety of scientific matters.

In addition, these practices leverage the expertise of more than 125 SHB research analysts with advanced degrees in fields such as agriculture; biochemistry, immunochemistry and organic chemistry; electrical and mechanical engineering; pharmacology; toxicology; and computer software and hardware. With access to both veteran litigators and business law specialists, the SHB intellectual property team delivers cost-effective strategies calculated to satisfy the full range of legal needs.

### **Intellectual Property Prosecution & Counseling**

The SHB Intellectual Property Prosecution & Counseling Practice works on behalf of clients to procure both domestic and foreign patent, trademark and copyright protection. SHB maintains an active docket of cases

with the U.S. Patent and Trademark Office, in addition to managing hundreds of similar client files outside the United States. Toward this end, SHB attorneys have established a network of associate counsel in more than 80 countries to handle national filings and patent proceedings under the Patent Cooperation Treaty and the European Patent Convention. Well-versed in drafting and negotiating patent, trademark and trade secret licenses, this practice has also prosecuted patent applications in a wide variety of technology areas.

The SHB intellectual property group supplements this focus on portfolio development with extensive counseling services designed to assist clients in maintaining, protecting and exploiting proprietary trade secrets. In particular, this practice addresses ownership rights between employer and employee, as well as between businesses and their independent contractors. SHB attorneys also handle strategic acquisition projects involving the identification and attainment of third-party patents and applications of potential value to clients. Moreover, SHB practitioners excel at conducting offensive reviews in order to ascertain which target products or technologies are most likely to infringe on client patent holdings.

### ***Portfolio Development***

SHB drafts and prosecutes patent and trademark applications in a variety of technology areas.

### **Opinion Preparation**

SHB prepares and presents noninfringement and invalidity opinions with respect to third-party patents.

### **Strategic Acquisition Projects**

These projects involve searching for and identifying third-party patents and applications having potential strategic value to clients. As part of these projects, we may also negotiate the acquisition of any selected third-party patents or applications by or on behalf of clients.

### **Offensive Reviews**

SHB assists clients in conducting reviews of their current patent portfolio to determine which patents are most likely infringed by target products or technologies.

### **Reexaminations, Protests and Prior Arts**

SHB conducts ex parte and inter partes reexaminations to assist clients in getting targeted claims cancelled entirely or narrowed in scope. Reexams are filed separately or as part of a litigation strategy. In addition SHB files protests or submits prior arts, where appropriate, to aid the examination process before the issuance of any potential patent.

### **Intellectual Property & Technology Litigation**

The SHB Intellectual Property & Technology Litigation Practice regularly handles patent, trademark and copyright infringement cases, as well as trade secret violation cases, in state and federal courts throughout the country. For example, SHB intellectual property attorneys currently are representing four different pharmaceutical and/or medical device companies in significant patent infringement cases. In each of these cases, intellectual property attorneys draw on the firm's technology-specific resources to provide clients with broad expertise.

SHB intellectual property attorneys recognize that intellectual property issues frequently overlap with other areas of the law. Their first objective in today's global business environment is to avoid costly litigation through client counseling. This dual focus on preventive advice and resourceful defense takes advantage of the firm's established practitioners in international law, licensing, antitrust, franchising, and products liability. By addressing the full range of legal needs, SHB supplies the comprehensive solutions that often escape specialty law firms.

In addition, the SHB intellectual property team supplements its patent and trademark practice with a state-of-the-art graphics department and a jury research staff. At a fraction of the cost demanded by outside consultants, SHB graphics specialists work to create sophisticated demonstrative exhibits on an expedited basis, while jury analysts examine complex litigation issues from a juror's perspective. As a testimony to this competitive edge, three *Fortune* 250 companies have named SHB litigators to ALM's "Who Represents America's Biggest Companies."

### **Patent Infringement Litigation**

SHB's patent litigation group comprises patent litigators having both unparalleled legal expertise and outstanding scientific knowledge in a wide array of technologies. Our clients range from *Fortune* 50 businesses to start-up companies.

Our patent litigation group has the capability to represent clients in a number of jurisdictions. Although our main offices are located in Kansas City, Missouri, we have patent attorneys practicing in offices throughout the nation, including our offices located in Texas, Florida, California, and the District of Columbia. Additionally, we maintain a database of cost-effective local counsel that we team with in handling patent cases throughout the United States.

Nearly every attorney in our patent litigation group is licensed to practice before the U.S. Patent and Trademark

Office and has a technical degree. We also regularly enlist assistance from our corps of scientific analysts, who bring highly specialized expertise to our technically complex cases.

### ***Trademark Litigation***

The attorneys at SHB have extensive experience litigating cases for trademark and trade dress infringement, dilution, state and federal unfair competition, and Lanham Act claims. We have achieved major victories for our clients in various trademark matters and have attained excellent results for our clients in a cost-effective manner. Many of our attorneys are experienced in the procurement, monitoring and enforcement of trademark rights, including substantial experience in the prosecution of state and federal trademark applications. This breadth and depth of experience translates into a strategic edge when litigating matters based on federal and/or state statutory trademark rights.

### ***Copyright Litigation***

SHB's copyright litigation group has handled all aspects of copyright infringement litigation, from preliminary injunctions through trial. The group is composed of IP attorneys who not only have litigated copyright infringement matters, but who also have prosecuted copyright applications, handled the monitoring and enforcement of copyrights, and counseled clients regarding copyright issues.

For additional information about SHB's Intellectual Property Practice, please contact:

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