

# INTELLECTUAL PROPERTY & TECHNOLOGY

At Hodgson Russ, we attend to not only your immediate intellectual property needs but also work with you to devise a long-term IP portfolio-building strategy. The attorneys in Hodgson Russ's Intellectual Property & Technology Practice understand you are passionate about your work. So are we. Our practice is devoted to the protection and enforcement of all forms of intellectual property rights in areas that include patenting of inventions; protection of designs; protection of marks; protection of copyrightable works; freedom-to-operate analyses; portfolio management; challenge and defense of issued patents at the patent office; opinion work; technology agreements, including website agreements and agreements relating to cloud computing; and trade secrets and non-disclosure agreements.

The quality of our work stems from our experience and technical depth. Many Hodgson Russ IP attorneys have advanced technical degrees in addition to law degrees, and prior to attending law school, many of our IP attorneys worked in academia or industries that include software, energy, semiconductor, microelectronics, manufacturing, plastics, information technology, and automotive, giving our attorneys the ability to understand complex technologies. We work seamlessly as a team and that allows us to tackle technologies that may require knowledge of multiple fields. We take the time to listen to our clients' objectives and provide them economically sensible approaches to achieve their goals.

Hodgson Russ's Intellectual Property & Technology Practice is national and international in scope. Clients include Fortune 500 corporations, middle-market companies, and major research and educational institutions as well as smaller businesses and individuals. Our firm works directly with the U.S. Patent and Trademark Office and with a network of patent and trademark attorneys in all major countries of the world.

Hodgson Russ has been awarded a prestigious Best Law Firms Metropolitan Tier 1 ranking by *Best Lawyers/U.S. News & World Report* in the Patent Law category.

## Experience

Hodgson Russ intellectual property attorneys have substantial experience in patent reexaminations and have been working on an *inter partes* patent reexamination matter related to a business method patent that involves a parallel patent litigation, with which our IP attorneys are also assisting.

## Contact

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## Professionals

### Attorneys

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### Registered Patent Agents

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## INTELLECTUAL PROPERTY & TECHNOLOGY

Assist client in connection with trademark advice and strategy in dealing with Chinese trademark pirates.

A team of Hodgson Russ attorneys assisted a Canadian start-up company with their expansion plans into the United States. The matter required a full range of specialties including immigration, tax, corporate, technology, and intellectual property. Our services included preparing and prosecuting trademark applications, forming a beneficial U.S. corporate structure, preparing agreements with vendors and users, and researching the U.S. patent landscape.

Handled copyright (protect product packaging and artwork) and trademark (brand name and packaging designs) for a major international wine company and a large kosher food company.

Defeated motion for a preliminary injunction involving rival law firm advertising campaigns.

Defended client in a cancellation action involving a registration dating back from 1921 and simultaneously commenced a parallel opposition proceeding against adverse party.

Defended client in a trademark and copyright infringement action in New Jersey District Court. We were able to:

- Obtain insurance coverage for the client
- Commence a parallel Trademark Trial and Appeal Board action against the plaintiff
- Obtain a favorable settlement of all proceedings

Defended design patent infringement action involving jewelry designs for several large jewelry manufacturers and distributors.

Defended large clothing company against claims of trademark infringement and trade dress infringement and simultaneously sought to enforce an existing trademark coexistence agreement.

Defended sports & entertainment client against a cease and desist letter and threatened opposition from adverse party involving the client's signature trademark used in conjunction with the trademark portfolio. We were able to obtain a favorable settlement and coexistence.

Defended trademark infringement action for major clothing company in the Southern District of New York.

Hodgson Russ attorneys assisted an early-stage startup company in defending allegations of patent infringement. We researched and asserted weaknesses in the patent assertion entity's allegations to avoid litigation and settlement.

Development of trademark strategies and management of the international trademark portfolio for clients including a major alcohol beverage company, major sportswear company and major dairy company.

Hodgson Russ attorneys worked with a U.S. entrepreneur to develop an international IP protection strategy prior to his successful Kickstarter campaign. Our strategy included utility and design patent protection for his product, in the U.S., China, and Europe. In addition to patent protection, we are helping to secure trademark protection for the tablift® brand in a variety of foreign markets. The tablift® product is currently being sold internationally and has been featured in various news outlets.

## INTELLECTUAL PROPERTY & TECHNOLOGY

For a Canadian client interested in bringing a known consumable food additive into the United States, a Hodgson Russ intellectual property team evaluated a large number of relevant patents related to the process of preparation of that additive. The team then provided a freedom-to-operate opinion, based on which the client was able to proceed with its plans for preparing the product in Canada and bringing it into the United States for sale.

Obtained a favorable settlement involving a trademark applicant in connection with political speech website and a line of clothing. The case progressed from trademark watch services, to a cease and desist letter, negotiations, threatened opposition proceedings, an eventual settlement whereby the applicant transferred domains to our client, abandoned his applications and agreed to change the phrase.

Hodgson Russ attorneys are actively defending a pharmaceutical marketing company from claims of patent infringement. We initiated *inter partes* reexamination to invalidate the alleged patent. Based on our arguments, the U.S. Patent and Trademark Office held the alleged patent invalid. The USPTO decision is currently under appeal.

Hodgson Russ attorneys routinely provide patent-related opinions, including patentability, non-infringement, and freedom-to-operate analysis. For one client, we provided significant guidance involving freedom-to-operate analysis, which resulted in the client engaging in new product development in the biotech area.

Hodgson Russ represented a developer and marketer of pharmaceutical co-pay offset programs as a defendant in patent infringement litigation in U.S. District Court for the District of New Jersey. Hodgson Russ placed the patent in re-examination before the U.S. Patent and Trademark Office and obtained rejections of all asserted claims.

The Hodgson Russ Intellectual Property & Technology Team successfully assisted the University of Maryland Eastern Shore (UMES) in obtaining a U.S. Patent for a chemical formula treatment for epilepsy. The medical research project that led to this discovery was spearheaded by Dr. Patrice Jackson-Ayotunde, Ph.D., an Associate Professor of Pharmaceutical Sciences at UMES. 65 million people suffer from epilepsy and one in 26 Americans will be diagnosed at some point in their lifetime. Dr. Jackson-Ayotunde focused her research regarding the design and synthesis of novel anticonvulsant analogs as potential agents for treatment of therapy-resistant partial epilepsy.

Hodgson Russ responded to intellectual due diligence requests on behalf of client in the ophthalmic and analytical equipment business to help complete the acquisition of the client by a publicly traded company. The due diligence process involved a lengthy in-person meeting with representatives of the buyer. The intellectual property work has remained with Hodgson Russ since the transaction.

Hodgson Russ attorneys successfully defended a pharmaceutical marketing company from claims of patent infringement. In this case, we initiated *inter partes* reexamination to invalidate the alleged patent. Based on our arguments, the U.S. Patent and Trademark Office held the alleged patent invalid. The Patent Trial and Appeals Board upheld the invalidation on appeal. Our actions successfully resolved the patent infringement case without incurring the substantial expenses of discovery and litigation.

Hodgson Russ cultivated and prosecuted the intellectual property portfolio of a Western New York-based high-tech startup, which was later acquired by a Fortune 100 company.

## INTELLECTUAL PROPERTY & TECHNOLOGY

Hodgson Russ intellectual property attorneys manage a large and growing medical device patent portfolio for a designers and developer of medical products. The portfolio includes patents and patent applications in Europe, Asia, South America, and the Middle East.

Negotiated celebrity endorsement and co-branding agreement with a well-known celebrity.

Negotiated fragrance license agreement with clothing company.

Obtained a favorable settlement involving a trademark applicant in connection with education and entertainment services. The case progressed from trademark watch services, to a cease and desist letter, negotiations, threatened opposition proceedings, an eventual settlement whereby the applicant transferred his domains and trademark filings to our client.

Defended copyright infringement actions for large internet media company and obtained favorable settlements for client.

Obtained a preliminary injunction in the SDNY against an infringer that infringed upon our client's trademarks, copyrights and patents. Our client is a furniture designer that decorated the Green Room at the Oscars.

Hodgson Russ IP attorneys work closely with clients on building and maintaining robust patent portfolios. For a particular client, we provide advice related to patent portfolio management and protection on an ongoing basis and have been involved in evaluation of certain inventions related to devices and methods related to human health, which has resulted in an intricate patent filing strategy, both domestically and internationally.

A Hodgson Russ intellectual property team of attorneys evaluated several relevant patents for a new product developed for the food industry. Based upon this, our attorneys provided a freedom-to-operate opinion that allowed the client to move forward with development of the new product for the market without requiring any license from patent holders.

Hodgson Russ intellectual property and litigation attorneys defended a manufacturing client in a patent infringement lawsuit involving automated fabric-cutting machines. Our attorneys prepared strong non-infringement positions early in the litigation to help our client reach an early and favorable settlement.

A multidisciplinary team of Hodgson Russ intellectual property and litigation attorneys worked together on behalf of a plaintiff to commence a patent infringement lawsuit involving automated fastening systems for aircraft assembly. Our attorneys attended mediation that resulted in a settlement agreement in which the defendant pledged to stop offering infringing systems.

Hodgson Russ intellectual property and litigation attorneys defended a client in a patent infringement lawsuit involving package-tracking devices. Our team of attorneys formulated non-infringement positions and participated in settlement conference to help our client reach an early and favorable settlement.

Hodgson Russ represented a leading provider of DNA-based diagnostic services in two patent infringement lawsuits concerning patents used for testing canine DNA for genetic disorders. The first suit, against an offshore testing enterprise and a large research university, was settled favorably for our client. The second suit, against a Florida-based genetic testing company, was also resolved favorably.

## INTELLECTUAL PROPERTY & TECHNOLOGY

Prosecuted opposition proceeding for client. Adverse party had filed trademark applications in the US and EU. We negotiated favorable settlement and coexistence agreement.

Represented a large kosher wine company in connection with a trademark acquisition agreement.

Hodgson Russ intellectual property attorneys handle U.S. patent and trademark filings for a well-known German manufacturer of microscopes and related systems. The relationship is now more than two decades old.

### **In the News**

Coronavirus Resource Center

Can China's fraudulent trademark registration in the United States eliminate subsidies?  
*VOA*, June 27, 2021

Hodgson Russ Assists UMES In Securing U.S. Patent For Epilepsy Drug  
May 9, 2018

Protecting information is on the minds of these Buffalo-area law firms  
*Buffalo Business First*, April 6, 2018

Ownership and control of websites vary  
*Buffalo Law Journal*, March 7, 2016

Albany Business Review- Industry Roundtable: Technology  
*Albany Business Review*, February 26, 2016

Startup Podcast (Vol. 29): Talking Startups With Jordan Walbesser of Hodgson Russ  
*Buffalo Business First*, May 29, 2015

### **Press Releases**

Hodgson Russ LLP Launches "The Semi Interesting Podcast"  
January 19, 2023

Fifty-Nine Hodgson Russ Attorneys Ranked in 2022 Edition of Upstate New York Super Lawyers  
*Hodgson Russ Press Release*, August 23, 2022

Hodgson Russ Earns Five National-Level Rankings in *U.S. News & World Report*/Best Lawyers 'Best Law Firms' Report  
*Press Release*, November 18, 2015

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**Publications**

USPTO Warns of New Phone Scams Targeting Trademark Filers

*Hodgson Russ Intellectual Property & Technology Alert*, February 7, 2023

The Latest Fraud Scheme at the USPTO: Be Vigilant in Reviewing and Monitoring Your Trademarks

*Hodgson Russ Intellectual Property & Technology Alert*, May 24, 2021

First Action Interview Program to Discontinue in the New Year

*Hodgson Russ Intellectual Property & Technology Alert*, January 7, 2021

New COVID-19 Pilot Program and Extensions for Patents and Trademarks

*Hodgson Russ Intellectual Property Alert*, May 8, 2020

Trademark Licensee Rights Expanded by Recent SCOTUS Decision

*Hodgson Russ Intellectual Property Alert*, July 8, 2019

Lessons From The Equifax Data Breach

*Cybersecurity & Privacy Alert*, December 17, 2018

Great Scott! The return of the DeLorean trademark dispute!

*Intellectual Property & Technology Alert*, October 17, 2018

2200 Non-Competes Impacted by Settlement between New York AG and WeWork

*Intellectual Property Litigation Alert*, October 1, 2018

Publish or Perish, or Publish AND Perish!

February 28, 2018

FDA Applicant Not Subject To Injunction Under BPCIA

*Intellectual Property & Technology Alert*, July 7, 2017

**Presentations & Events**

Dive into Intellectual Property

UB North Campus, 330 Student Union, Buffalo, NY 14228, September 18, 2023

Nathaniel Lucek and Sarah Grimaldi Speak at Cleantech Open Northeast Event

Cleantech Open Northeast, June 22, 2023

US Readiness Online Immersive 6.0

June 20, 2023

Ranjana Kadle, PH.D., Guest Lectures at University at Buffalo

November 14, 2022

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Protecting and Monetizing Your Innovation and Product  
Cornell Tech, January 25, 2022

Virtual Bridge Market Entry Program: Data Privacy, Cybersecurity, and Protecting Technology  
April 29, 2021

Protecting your Technology and Brand when Doing Business in the US  
April 12, 2021

Trademarks 101: Considerations to Keep in Mind when Forming a New Company or Food Establishment  
March 11, 2021

A Superhero's Greatest Ability: Inventing — How You Can, Too!  
February 26, 2021

World Trade Center Buffalo Niagara's Global Business Academy (GBA)  
February 17, 2021

