



## Practices & Industries

# Patent Prosecution & Counseling

## Overview

Clients seeking to license their technology and business process advancements rely on Day Pitney for its extensive experience in patent prosecution, opinion, counseling and transactional services, including due diligence involving patent issues. We ensure that our clients are provided with the legal counsel and strategic thinking to further their business objectives.

Our clients range from Fortune 500 companies to startups, and are engaged in such diverse industries as manufacturing, packaging, information services, software, high-technology research and development, pharmaceuticals, publishing, retail sales, telecommunications, financial services, banking, insurance, healthcare, utilities, advertising and media.

## Experience

*No aspect of this advertisement has been approved by the highest court of any state. Prior results do not guarantee a similar outcome.*

A number of our attorneys are admitted to practice before the U.S. Patent and Trademark Office (USPTO) and have experience in all aspects of patent prosecution, including procuring patent rights in the United States before the USPTO and working with a broad range of associates to prosecute applications in foreign patent offices.

In addition to preparing and prosecuting patent applications, we counsel clients on maintaining and rebuilding existing patent portfolios, and in connection with re-examination and reissue proceedings.

Representative clients for whom we provided prosecution services include the following:

- A leading software manufacturer needing assistance with business-method patent claims
- A leading toy manufacturer, for management of its U.S. patent portfolio
- A leading manufacturer of printers, for management of its U.S. patent portfolio
- A leading packaging manufacturer, for management of its U.S. patent portfolio

**Opinion and Counseling** Day Pitney frequently counsels clients regarding patent or intellectual property questions, and provides opinions on infringement, validity or enforceability of a patent. In addition, we review competitors' patent portfolios with respect to freedom-to-operate and, risk analyses, and provide counsel on potential design around options. Some clients for whom we have recently provided opinion and counseling include:

- A major worldwide entertainment and publishing company in its investment in a digital rights management company, including performing a due diligence review of the company's portfolio of more than 350 patents and patent applications.
- A leading international real estate company seeking a freedom-to-operate analysis regarding an automated ticketing and admission gate system, including a review of more than 100 patent references.
- A leading pharmaceutical company seeking an opinion on the scope of a transfer of intellectual property.

**Transactional Services** Many business transactions today involve some form of intellectual property. We represent owners, licensees and other users of intellectual property, and provide counseling on a wide variety of transactions: simple assignments, employer/employee agreements, technology transfer, outsourcing, mergers and acquisitions, and complex joint venture and technology transfer arrangements. In each case, we advise clients to help them further their business objectives with respect to intellectual property at issue in the transaction. When needed, we work with other Day Pitney attorneys in areas of the law that can affect transactions, such as antitrust, tax, products liability, export control, bankruptcy, environmental, employment and other laws and regulations. We also regularly perform due diligence reviews of a target company's patent portfolio and other intellectual property.

Clients for whom we have provided advice on transactional matters include:

- A public company in connection with acquiring the assets of an early-stage company, the central focus of which is a pending business method patent application.
- A multinational public company in connection with the formation of a joint venture with a privately held company into which the parties contributed, through assignments and licenses, certain software and software technology along with certain software development resources.
- A multinational public company in connection with the acquisition of voice recognition software, including reviewing and advising the client with respect to current patents and pending patent applications in the field of voice recognition.
- A privately held manufacturer of electromagnetic interference shielding products in its acquisition of one U.S. and one foreign manufacturer of similar products, and its subsequent sale to a UK public company for more than \$250 million.
- A global manufacturer seeking a variety of patent license agreements in the fields of drug recovery, genomics and biochip analysis.