

Services & Industries

Patent Prosecution and 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.

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.

EXPERIENCE

A number of our attorneys are admitted to practice before the U.S. Patent Office and have experience in all aspects of patent prosecution, including procuring patent rights in the U.S. before the PTO 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 reexamination and reissue proceedings. Representative clients for whom we provided prosecution services are:

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Opinion and Counseling

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- 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 over 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 over 100 patent references
- A leading pharmaceutical company in an opinion of the scope of a transfer of intellectual property

Transactional Services

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- 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 (EMI) shielding products in its acquisition of one U.S. and one foreign manufacturer of similar products, and its subsequent sale to a U.K. public company for over \$250 million
- A global manufacturer seeking a variety of patent license agreements in the fields of drug recovery, genomics and biochip analysis

INSIGHTS

Patently Enabled January 2024 – What is Obviousness?

January 5, 2024

The purpose of this monthly series Patently Enabled is to share simplified patent related information to assist non-patent practitioners in making the best decisions when considering their intellectual property rights.

Patently Enabled December 2023 – Tax Consequences of Losing, Conveying, and Litigating a Patent

December 1, 2023

Patently Enabled November 2023 – Patent Acquisitions and Taxes

November 3, 2023

Patently Enabled October 2023 – Doctrine of Equivalents

October 6, 2023

Patently Enabled September 2023 – What is the On-Sale Bar?

September 1, 2023

NEWS

IP Stars from Managing IP

September 8, 2023

Day Pitney Intellectual Property Partners Elizabeth Alquist, Richard Brown, George Chaclas and Jonathan Tropp have been named to *Managing IP's* IP Stars 2023 Lists.

Chambers USA 2023 Ranks 35 Day Pitney Attorneys and 13 Practices

June 1, 2023

Day Pitney Press Release

Professional Excellence in Law Awards: Rhode Island Monthly

May 30, 2023

Day Pitney Partners George Chaclas and Renée Evangelista, and Senior Associate Leigh Furtado were each honored with a *Rhode Island Monthly* Professional Excellence in Law Award for 2023.

How I Made Practice Group Chair: 'Making Connections With The Right People,' Says George Chaclas of Day Pitney

July 27, 2022

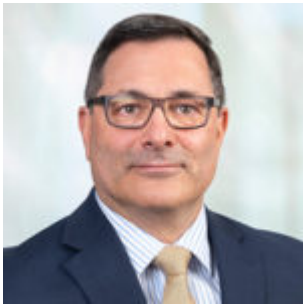
Day Pitney Partner and chair of the Patent Prosecution and Counseling group George Chaclas was featured in a Q&A on *Law.com* titled, "How I Made Practice Group Chair: 'Making Connections With The Right People,' Says George Chaclas of Day Pitney."

IP Stars from Managing IP

June 16, 2022

Day Pitney Intellectual Property Partners Elizabeth Alquist, George Chaclas and Jonathan Tropp have been named to *Managing IP's* IP Stars 2022 List.

CONTACTS



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