



## Intellectual Property Practice

*Protecting creative assets*

# Intellectual Property Practice



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Dickstein Shapiro's Intellectual Property Practice of more than 85 IP attorneys combines decades of litigation experience with a robust procurement and asset management practice to devise strategies that help clients protect IP assets while maximizing their value.

## IP Litigation

Experienced counsel recognize that litigation is a business tool that should be used to achieve the client's purpose. A successful approach to litigation therefore requires not only courtroom savvy, but also a comprehensive understanding of the client's goals and a case strategy to achieve them as quickly, efficiently, and agreeably as possible. Dickstein Shapiro's clients rely on the Firm to handle the most sophisticated IP matters while prioritizing their business objectives and bottom line. These matters include:

- Litigations on both the plaintiff side and defense side involving claims from a few million to hundreds of millions of dollars, including successfully defending suits where patent owners sought hundreds of millions in damages.
- Obtaining a judgment in excess of \$500 million on behalf of a plaintiff.
- More than 600 patent and trademark litigations before U.S. District Courts and the International Trade Commission.

Dickstein Shapiro manages cases in a client-focused manner by utilizing careful planning to avoid surprises, implementing customized client reporting systems, and using disciplined budgeting and cost control methods. All of these processes are designed to streamline the inherently difficult nature of the litigation process.

## Patent and Trademark Prosecution

Dickstein Shapiro's clients are best served through the integration of world class IP procurement and enforcement services. Litigation is made simpler and costs are significantly reduced if patents and trademarks are prosecuted with a view toward common litigation issues. As part of its integrated approach, the Firm provides its prosecutors with litigation experience and in-house training to ensure that they excel in the rapidly changing legal landscape.

In prosecuting patents, the Firm focuses on identifying the broadest concepts incorporated in clients' inventions and obtaining commercially valuable patents that will protect the clients' commercial position and provide an opportunity to monetize those patents, both within and outside their commercial space, thereby maximizing the value of IP assets.

In prosecuting trademarks, Dickstein Shapiro's attorneys help clients in the selection, clearance, and registration of marks, including addressing the unique challenges of Chinese character marks, co-existence agreements, and litigation of opposition and cancellation proceedings.

### **Asset Management**

Sound and strategic IP portfolio management is a complex endeavor. Companies must proactively manage assets across the organization, and Dickstein Shapiro helps clients in every aspect of IP portfolio management, including:

- mining and deriving value from patents;
- ensuring brand protection;
- establishing global IP programs;
- advising on effective invention disclosure programs;
- prosecuting patents sensibly and leveraging seasoned patents;
- creating corporate policies for employee education;
- safeguarding trade secrets; and
- counseling on Sarbanes-Oxley compliance requirements inherent in managing intangible assets.

Eighty percent of corporate value today is comprised of intangibles such as intellectual property assets. An authentic corporate risk management program necessarily includes a rigorous, concrete, and integrated IP asset management component. Dickstein Shapiro's IP attorneys, more than 65 of whom have technical degrees, are experienced in every aspect of IP asset management and are focused on maximizing the value of each client's IP portfolio.

### **Counseling**

The first step of any successful IP counseling program is to develop a clear understanding of a client's business, the marketplace in which it competes, its management philosophy, and its vision for the future. Dickstein Shapiro's IP attorneys work closely with clients to design IP strategies and programs that are practical and effective. These comprehensive programs include policing infringing activities, protocols, trademark piracy, domain names, and international issues such as multicountry and customs recordations.

### **Licensing**

Dickstein Shapiro's IP attorneys have negotiated hundreds of licensing agreements throughout the world, ranging in amounts up to hundreds of millions of dollars. These U.S. and global agreements include patent and know-how licenses, trademark licenses, software licenses, and distribution agreements.

## **IP Practice Awards & Recognitions**

■ **2009 Leading Firm,  
Intellectual Property**  
*Chambers USA*

■ **2009 Leading IP Firm**  
*Managing Intellectual Property*

■ **2009 Top Patent Firm**  
*Intellectual Property Today*

■ **2008 Top 10 Litigation Wins**  
*IP Law & Business*

■ **2008 Top 100 Verdicts,  
Ranked #3**  
*The National Law Journal*

■ **2009 Top Trademark Firm**  
*Intellectual Property Today*

## Representative Intellectual Property Experience

- Obtaining a total judgment of more than \$500 million for Dr. Bruce N. Saffran in a patent infringement action concerning drug-eluting stents, one of the largest jury awards ever to be delivered in a patent infringement matter in the United States.
- Representing Arthrex, Inc. against patent infringement claims involving the company's development of FiberWire® surgical sutures, thereby protecting Arthrex from potential losses of as much as \$300 million.
- Obtaining a favorable verdict on willful infringement in a multiple-patent case on behalf of Merit Industries, Inc., a worldwide leader in touchscreen entertainment devices.
- Defending Datamars SA and Crystal Import Co. in a patent infringement action concerning a radio frequency identification system for tagging companion animals so that these pets, when lost, can be identified using a handheld radio-frequency identification reader.
- Representing EBS Dealing Resources in a patent infringement action enforcing EBS's rights in the electronic trading systems industry, settling the action in favor of the client after a favorable Markman decision.
- Representing Swisslog S.A. and Translogic Corporation in defense of a patent infringement action pending in the District of Delaware concerning the technology of robotic systems for the automatic storage, retrieval, and distribution of pharmaceutical products from a hospital pharmacy to hospital patients.
- Representing LINQ Industrial Fabrics and successfully proving infringement of three patents in a jury trial (liability only) involving Flexible Intermediate Bulk Containers, a product used for storing and transporting chemicals (and other fine solids).
- Representing Arbitron, one of the world leaders in audience ratings and measurement for radio, in a patent infringement case involving technology for a portable electronic ratings system employing audio encoding.
- Representing plaintiff Safe Strap Corporation in a patent infringement case involving technology for child-resistant safety straps and buckles.
- Obtaining a favorable summary judgment on behalf of Rowe International in a patent infringement action relating to computer jukeboxes and networks that manage and distribute digital music to multiple jukeboxes.
- Obtaining a favorable verdict on behalf of Samsung Electronics Corporation in a patent infringement case related to DRAM semiconductor technology.

### AT A GLANCE

#### IP Practice Statistics

**22+** Average years of trial experience

**65+** IP attorneys with technical degrees

**13+** Partners with first-chair IP trial experience

**120+** IP Trials handled

**80+** IP Jury Trials handled

“Dickstein Shapiro’s attorneys, with superior technical, business, and legal knowledge, provide invaluable counsel when time is short and the stakes are high. Their strategic guidance has made all the difference in successfully resolving matters so Verint can meet our business goals and protect our vital IP assets.”

**Peter Fante**  
Chief Legal Officer & Chief Compliance Officer  
Verint Systems, Inc.

## Representative IP Clients

Adamas Pharmaceuticals, Inc.	Greenfield Industries, Inc.	Sallie Mae
Affymetrix, Inc.	Haldor Topsoe A/S	Samsung Electronics Company, Ltd.
American Society of Health-System Pharmacists	Harbour Group Industries, Inc.	Sega Corporation
Arbitron Inc.	IBM Corporation	Smoothie King Franchises, Inc.
Arthrex, Inc.	Inside Washington Publishers	Sumitomo Chemical Company, Ltd.
Asahi Kasei Corporation	Iowa State University Research Foundation, Inc.	Sumitomo Electric Industries, Ltd.
Astra Tech AB	Marposs S.p.A.	Sun Chemical Corporation
Chrysler Group LLC	Micron Technology, Inc.	Tethys Bioscience, Inc.
Clark, Inc.	Millipore Corporation, Inc.	The Johns Hopkins University
Codexis, Inc.	Murata Manufacturing Co., Ltd.	The University of Hong Kong
Discovery Laboratories, Inc.	National Grid US (f.k.a. KeySpan)	VeriSign, Inc.
Dunkin’ Brands LLC	NEC Corporation	W. L. Gore & Associates
DuPont	Nippon Columbia Co., Ltd.	Watson Pharmaceuticals, Inc.
EBS	Olympus Corporation	WestPoint Home, Inc.
Fannie Mae	Omron Corporation	XOMA Ltd
GEICO	Rensselaer Polytechnic Institute	Yamaha Corporation
Gilead Palo Alto, Inc.	Ricoh Company, Ltd.	

The above list includes current and former clients that have relied on Dickstein Shapiro for superior representation and counsel.

“The deep bench of IP litigators at Dickstein Shapiro anticipates our needs, identifies opportunities, and provides cost-effective strategies and customized solutions that advance our business objectives. We know we can count on them to handle complex and difficult matters.”

**Bryan Richardson**  
Director  
Samsung Electronics Company, Ltd.

## About the Firm

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**Dickstein Shapiro LLP**, founded in 1953, is internationally recognized for its work with clients, from start-ups to *Fortune* 500 corporations. Dickstein Shapiro provides strategic counsel and develops multidisciplinary legal solutions by leveraging its core strengths—litigation, regulatory, transactions, and advocacy—to successfully advance clients' business interests.

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