

Intellectual Property

The Intellectual Property Group at Bullivant Houser Bailey believes in a value added approach to Intellectual Property Rights (IPR), both for litigated and non-litigated matters. The IP Group believes that a client's reasonable business objectives should define common sense IPR goals and solutions. This is particularly true in litigation, and also in IPR consultation and prosecution.

The IP Group operates as a specialized division in order to expeditiously provide topical and important IPR services to its clients, and to promptly satisfy its clients' important IPR needs.

The IP Group assists mid-growth and mature business by —

- Helping *your* business grow
- Helping *your* business protect its IP assets

The IP Group focuses IP strategy on administrative protection of IPR, counseling as to best IPR practices within and outside of E-Commerce, and litigation protection of IPR.

Our lawyers have considerable experience bringing civil infringement claims, and litigating infringement claims, relating to copyright, trademark and patent. Our lawyers have considerable experience prosecuting patent, trademark and copyright applications, in litigating opposition and cancellation proceedings before the Trademark Trial and Appeal Board, and in representing IP interests before the U.S. Customs and Border Protection. Importantly, our lawyers are experienced in providing advice and counseling regarding importation of marked goods into the U.S.

Administrative protection of IP

The IP Group advises and counsels in the selection, registration, protection and enforcement of patents, trademarks, service marks, trade dress, copyrights, trade names, trade secrets, and domain names. Counseling relates to the E-Commerce environment, traditional business practices, and transactional and litigation experiences.

The IP Group:

- Counsels and prepares patent, trademark and copyright applications in the U.S. and in foreign countries
- Counsels and participates in trademark opposition and cancellation proceedings
- Counsels and files for U.S. Customs protection of U.S. IP registrations, and works with U.S. Customs regarding importation and product marking issues

Transactional Focus on IP

The IP Group advises on the protection and use of IP in business transactions, including the drafting of IP-focused documents.

The IP Group lawyers provide advice, guidance and document drafting on:



Patent Tip Sheet



Copyright Tip Sheet

- Use and protection of copyrights, trademarks, trade dress, product design, patents, trade secrets, confidential information, and all types of technology and intangible assets
- Technology licensing and distribution
- Structuring transactions involving IP assets of all types
- Use and protection of personal right of publicity
- Clearance and transfer of IP rights
- Securitization of IP rights
- Due diligence of IP rights in business and asset acquisition
- The use and protection of free open source software

Counseling of IP best practices

In addition to advising clients on issues of the availability, selection, use, and registration of patents, trademarks and copyrights, both within and outside the U.S., the IP Group counsels clients in developing customized domestic and global IP protection strategies.

Concerning E-Commerce assistance, Bullivant Houser Bailey PC's IP Group:

- Advises ISPs, online (web 2.0) businesses, traditional retailers selling online, and other clients on the Anti-Cybersquatting Act, the Digital Millennium Copyright Act, and the CAN-SPAM Act of 2003.
- Counsels and assists regarding license and transfer agreements, trade secret protection, intellectual property protection in cyberspace, Internet and e-commerce issues, domain name registration, IP audits and M&A due diligence, rights of publicity, trademark dilution, and copyright protection.
- Advises clients on relevant marking and counterfeiting regulations for importation of goods into the U.S.

Litigation protection of IP

The IP Group is able to litigate in all appropriate courts in the U.S. Members of the IP Group are skilled in all phases of intellectual property litigation, including copyright, trademark, unfair competition, false advertising, patent, trade secret and domain name litigation. Specifically, we counsel clients as to best practices in avoiding litigation when appropriate, best practices in preparing for litigation as either a plaintiff or defendant, and best practices in defending "bet the firm" cases.

The IP Group lawyers:

- Are acknowledged by The Chambers Guides (chambersandpartners.com) as being particularly skilled and respected litigators
- Have litigated matters arising under CAN-SPAM and numerous cases involving internet and e-commerce issues



Domain Name Tip Sheet



Trademark Tip Sheet

- Have litigated many Cybersquatting matters and served as counsel of record in one of the earliest Cybersquatting cases ([Panavision v. Toeppen](#))
- Have particular litigation experience in cases involving copyright, trademark, trade dress and patent infringement claims; unfair competition and false advertising claims in state and federal courts; and copyright claims
- Specialize in trademark opposition and cancellation actions in the United States Patent and Trademark Office and the Trademark Trial and Appeal Board

IP Representative Issues

The IP Group is skilled in all aspects of IP counseling, transactional work, E-Commerce and litigation.

- Provisional remedies, including preliminary injunctions and restraining orders
- Litigation of IP cases to jury verdict, plus appeals
- Alternative dispute resolution and mediation of intellectual property disputes (*We have obtained for our clients highly favorable settlements in numerous intellectual property disputes, in many cases also covering the cost of the client's enforcement program and serving as a deterrent to future infringement.*)
- Anti-piracy and infringement actions, including civil seizures
- Prosecution and defense of claims before the Trade Trial and Appeal Board and Board of Patent Appeals and Interferences
- Assist in all aspects of transactional work containing IP components, including due diligence and Sarbanes Oxley requirements
- Traditional litigation on the plaintiff side and for the defense
- Assist in border enforcement of IP rights, including border seizures and grey-market re-entry issues
- Litigate domain name disputes
- Cyber-squatting, DMCA, CAN-SPAM, and other targeted E-Commerce and Internet-themed issues

Our representative intellectual property clients include U.S. and foreign-based companies in a wide variety of fields, including companies in the computer technology, Internet service, footwear, cosmetics, hospitality, and luggage industries.