

## Intellectual Property & Intellectual Property Litigation

### Related Industries

Dental Service Organizations  
Industry Group

Food & Beverage

Mobility and Advanced  
Transportation Team

## Overview

Continued business success and growth in today's global economy increasingly depend on a company's ability to safeguard invaluable Intellectual Property (IP). Dykema's Intellectual Property attorneys have the breadth of legal, technical and scientific knowledge and experience, as well as the support of firmwide resources to counsel clients in all aspects of the procurement, management, and enforcement of Intellectual Property rights. Named a "Go To Law Firm" for Intellectual Property by General Counsel at America's top companies (*Corporate Counsel 2010*), Dykema delivers strategically focused solutions across the life cycle of intangible Intellectual Property assets in virtually all industries.

For companies of any size, including patented inventions, trademarked brands and copyrighted works create and build their success. By helping clients protect their Intellectual Property assets, we help them achieve and maintain competitive market advantages. Our attorneys—many of whom are registered with the U.S. Patent and Trademark Office—draw on technical backgrounds in such diverse fields as mechanical, electrical and computer engineering; aerospace and automotive technologies; chemistry; biochemistry and molecular biology to provide exceptional representation to clients. Our range of IP legal services includes IP litigation, counseling and prosecution, as well as due diligence on Intellectual Property asset portfolios.

## Patent Prosecution

For our automotive, communications, computer, electronics, biotechnology, consumer products and other clients, we prepare and prosecute patents, establish in-house patent programs, and provide counsel on the patentability of inventions, patent infringement issues and the validity of patents. **Read more.**

## Intellectual Property Litigation

Our Intellectual Property team is dedicated to the defense or enforcement of matters arising from patent, trademark, and copyright infringements. We resolve internet and technology-based disputes and litigate matters involving trade secret and unfair competition claims, false advertising, publicity rights and Intellectual Property transfers. **Read more.**

## Trademark

We provide effective, efficient counsel on every facet of trademark law, beginning by identifying and clearing potential trademarks and service marks to registering and enforcing these marks. **Read more.**

## Copyright

By identifying copyrights and related issues, implementing copyright protection programs and registering, licensing and enforcing copyrights, we help clients protect the full range of copyrightable assets. **Read more.**

## Portfolio Due Diligence

Dykema offers complete due diligence counseling and Intellectual Property asset and patent portfolio management to clients from a wide range of industries. [Read more.](#)

## Experience Matters

- Dykema's Intellectual Property and Intellectual Property Litigation Department Director served as a principal author of the Local Patent Rules for the Northern District of Illinois.
- Prepared and procured patents in a broad range of technologies, including semiconductor devices, automotive, computer-implemented inventions, medical devices, and biotechnology.
- Represented a power distribution equipment company in a multimillion-dollar patent infringement action involving 14 asserted patents over “smart” electric power meters.
- Obtained a record-setting jury verdict of more than \$100 million in a high-stakes patent infringement case.
- Obtained a defense verdict for a client against claims alleging misappropriation of trade secrets, breach of contract, tortious interference and conversion defeating plaintiff's claims of actual damages over \$30 million, as well as a permanent injunction and punitive damages.
- Represented a plaintiff alleging superior rights in the use of a trademark related to investments, electronic trading and financial services against related entities using the mark in similar service areas.
- Represented a foreign OEM in defense of a luxury brand trademark.
- Obtained at trial and preserved on appeal, in a published opinion, an injunction and \$1 million damage award for trademark infringement and unfair competition in favor of machine tool manufacturer client.
- Filed and prevailed in more than 30 proceedings under the Uniform Domain Name Dispute Resolution Policy, resulting in the transfer of many valuable domain names to a wide-variety of clients.
- Represented an affiliate of Citicorp in defense of a software copyright matter in which the claimant sought over \$15 billion in damages. Prevailed on summary judgment finding no liability and won award of attorneys' fees, upheld on appeal.
- Defended a television station in a copyright infringement claim arising from the use of a deceased police officer's photograph on a news program. The copyright owner's claim, which was based upon a contract to photograph all police officers and ownership of resulting photographs, was rebuffed on grounds of fair use.
- Defeated asserted apparel design copyright infringement claims for lack of originality.
- Obtained summary dismissal on behalf of a major television network in a copyright infringement case.

## Publications

“The Digital Oil Field”

January 30, 2019

*Intellectual Property Magazine*

“Hunting and Gathering for the Trademark Audit”

September 1, 2018

*Intellectual Property Magazine*

"Judge Kavanaugh On Intellectual Property"

July 16, 2018

“Drawing the Battle Lines: Adidas's Mission to Protect Its Three Stripes”

April 24, 2018

*World Intellectual Property Review*

“Preparing for the Trademark Office's Permanent Audit for Registrations”

April 2018

*Intellectual Property & Technology Law Journal*

Intellectual Property & Intellectual Property Litigation (Cont.)

"Cesari V. Peju May Have Reverberating Results"  
December 21, 2017

"Amendments in IPRs? Welcome Back to the Future."  
October 25, 2017  
*IPWatchdog*

"Service and Software-based Revenue Streams to Sculpt Legal Activities"  
September 1, 2017  
*Automotive World*

"Who Will Own the Rights to Autonomous Cars?"  
July 26, 2017  
*Legaltech News*

"Hazy Future for Federal Registration of Marijuana Marks"  
January 4, 2017  
*Westlaw Journal Intellectual Property*

Presidential Candidates May Come and Go, But Their Monikers Last Forever  
November 8, 2016  
*Editor & Publisher*

"Defend Trade Secrets Act: What does it mean in the real world — and what do lawyers do now?"  
June 23, 2016  
*Inside Counsel*

"The Defend Trade Secrets Act: a valuable tool for IP owners"  
June 21, 2016  
*World Intellectual Property Review*

Trade Secrets vs. Patents: Has the Decision Climate Changed?  
June 18, 2016  
*Texas CEO Magazine*

"Legal mash-up"  
March 3, 2016  
*Intellectual Property Magazine*

"3D printing and the constitution"  
March 2, 2016  
*Intellectual Property Magazine*

"Know Your Domain: An audit of Internet domain names can become an undiscovered asset on the bottom line"  
November 28, 2015  
*Metropolitan Corporate Counsel*

"Form 18: much ado about nothing?"  
November 24, 2015  
*World Intellectual Property Review*

"Cuba and your brand strategy"  
November 2015  
*Intellectual Property Magazine*

"Biosimilars: Poised to Turn to *Inter Partes* Review to Resolve Patent Disputes"  
June 2015  
*Metropolitan Corporate Counsel*

"Federal Circuit Affirms Broad Interpretation of the Phrases "Associated with" and "Related to" during Patent Examination "  
January 20, 2015  
*SerendIPity*

Intellectual Property & Intellectual Property Litigation (Cont.)

"Recent Supreme Court Opinions Lead USPTO to Issue New Interim Patentability Guidelines"

December 19, 2014

*SerendIPity*

"3-D Printing and Intellectual Property: New Technologies and Products to Protect as Infringement Becomes Commonplace"

November 2014

*Intellectual Property Today*

"Patent Reform is Back on the Table (Maybe)"

November 18, 2014

*SerendIPity*

"What Massachusetts Court's Ruling on Tesla Means for Automakers, Dealers"

October 23, 2014

*WardsAuto*

"Update on U.S. v. Trek Leather: Important Veil Piercing Case"

September 26, 2014

*SerendIPity*

"Third Circuit Expands Octane Fitness Standard to Trademark Cases"

September 25, 2014

*SerendIPity*

"Note to Musical Performers—You Are Only "Entertaining" When You Are Performing Live"

September 5, 2014

*SerendIPity*

"Illinois Has A New Weapon Against Frivolous Patent Assertions"

September 3, 2014

*SerendIPity*

MPHJ Technology Investments LLC v. FTC: Fighting for Patent Owners' Rights in a Tide of Patent Reforms

August 29, 2014

*Bloomberg BNA Patent, Trademark & Copyright Journal*

"Understanding the Risks Associated With the Use of Virtual Currencies"

August 19, 2014

*SerendIPity*

"Supreme Court Pulls the Plug on Aereo's Streaming TV Service Holding it Illegal"

June 26, 2014

*SerendIPity*

"The Supreme Court Delivers Clarity for (Some) Software Patents"

June 20, 2014

*SerendIPity*

"The Future of Patents, All Eyes Up High"

May 23, 2014

*Inside Counsel*

"Stopping the 'Patent Troll': Or, What You Need to Know About the Current Litigation to End Abusive Patent Litigation"

April 24, 2014

*Metropolitan Corporate Counsel*

"The America Invents Act: Big Changes Not Just for Patent Lawyers"

April 22, 2014

*Inside Counsel*

*The Extraterritorial Reach of U.S. Patent Law*, Minnesota IP Institute, (Co-Author)

3rd Edition, 2005

Intellectual Property & Intellectual Property Litigation (Cont.)

"New Year's resolutions: Document Your Intent to Use the Mark in the U.S. or Your Application Could be at Risk"

February 1, 2014

*Trademark Lawyer Magazine*

"Helping Clients Navigate Uncertain and Rapidly Developing Privacy and Data Security Regulations"

2013

*Recent Trends in Privacy and Data Security, Inside the Minds* (Aspatore Books)

"Internet Domain Name Landscape About to Expand; Is Your Brand's Trademark Protected?"

February 5, 2013

*Lexology daily newsfeed in cooperation with ACC*

"Risks of the Cloud: How to Address Potential Pitfalls Before Moving Ahead with Cloud Computing"

April 2012

*Smart Business Dallas*

"A Path Forward for Online Piracy Legislation?"

February 6, 2012

*IPFRONTLINE.com*

"Under Wraps: How Trade Secrets Can Help a Company Protect its Vital Intellectual Property"

October 2011

*Smart Business Los Angeles*

"The King is Dead - And Overruled"

September 19, 2011

"If It's Not .Bank, It's Not Safe"

June 7, 2011

*IPLaw360*

"Fighting Online Counterfeiters at Internet Speed"

December 28, 2010

"Intersection of Patents and Trade Secrets: Often Precarious"

December 13, 2010

*The National Law Journal*

"New Indictment of In-House Counsel Indicates Enhanced Efforts to Hold Corporate Executives Accountable for Food and Drug Law Violations"

November 15, 2010

"IP: Considerations When Filing Patent Infringement Claims"

August 10, 2010

*InsideCounsel Magazine*

"Designing an Effective Intellectual Property Compliance Program"

2009 (updated annually)

*Thomson West*

"Intellectual Property and Open Source: A Practical Guide to Protecting Code"

2008

*O'Reilly Media*

*FCC Citator (2nd ed.)*, 13 *Hastings Comm/Ent L.J.* 325 (1991)

## Speaking Engagements

Emerging Issues in Trade Secrets Protection and Litigation

May 15, 2018

*Let's Make a Federal Case Out of It!: Trade Secret Misappropriation and the Federal Courts*, The Judge Paul R. Michel Intellectual Property American Inn of Court, Los Angeles, CA

Intellectual Property & Intellectual Property Litigation (Cont.)

April 25, 2017

Who Owns What?, Moderator, Panel Discussion on Intellectual Property Ownership in the Context of Universities and Government Contracts, State Bar of Texas Advanced Intellectual Property Law Course, Austin, TX  
February 23, 2017

Proactively Protecting Trade Secrets, Co-Presenter with Alex Walther and Dan Stern, Texas Society of Certified Public Accountants CPE Expo Conference, Houston and San Antonio, TX  
December 2 & 9, 2017

Intellectual Property Fundamentals, The University of Texas at San Antonio, College of Business, Management of Technology Program, Guest Lecturer  
2008-2015

Innovation Fellows Program of the Medical Device Center at the University of Minnesota, Advisor  
2011-Present

*Injunctions in IP Cases After the United States Supreme Court Decision in eBay, Inc. v. MercExchange, LLC*, Panelist, Seminar hosted by UBIC and co-sponsored by Dykema and Bae, Kim & Lee LLC., Seoul, Korea  
November 2014

*America Invents Act and Med Tech Innovation*, Moderator, 12th Annual Design of Medical Devices Conference  
April 2013

*Litigating Copyrights*, Guest Lecture, Golden Gate University School of Law  
January 2013

*Patents and Medical Device Innovation from an In-House Perspective*, Speaker, 11th Annual Design of Medical Devices Conference  
April 2012

*Three-in-Five Competition*, Panel Judge, 11th Annual Design of Medical Devices Conference  
April 2012

*Maximizing the Effectiveness and Impact of a Limited Anti-Counterfeiting Budget*, 7th Annual Anti-Counterfeiting & Brand Protection East Coast  
September 28, 2011

*2011 AICPA Conference on Doing Business in China - IP Challenges for US Brand Owners Doing Business in China*, American Institute of Certified Public Accountants (AICPA) International Business Conference, New York, NY  
June 15, 2011

*Ask the Experts: What Would You Do? 30 Answers in 30 Minutes* Anti-Counterfeiting & Brand Protection West Coast  
January 26, 2011

*Practical Considerations in Formulating Patentability, Noninfringement and Invalidity Opinions*, Speaker, American Bar Association, Section of Intellectual Property Law  
April and October 2002

*Recent Trends in Patent Prosecution: Software & Business Methods*, Speaker, American Corporate Counsel Association  
September 1999