

# Intellectual Property Technology & Life Sciences

The Intellectual Property Group at Sullivan & Worcester LLP uses its extensive experience in both business and legal matters to find cost-effective solutions to client needs. The IP group works with clients across the spectrum of intellectual property law, including counseling, acquisition, enforcement and licensing of patents, trademarks, copyrights and trade secrets.

From securing and licensing trade names or copyrights to initiating and maintaining extensive patent programs and enforcing our clients' IP rights worldwide, our team provides strategic guidance in developing, protecting and maximizing the returns on their IP portfolios.

## INDUSTRY EXPERTISE

Our IP lawyers have diverse backgrounds and a range of experience in many industry sectors including chemical, pharmaceutical, biotechnology, medical device, software, communications and mechanical technology. All of our IP lawyers are registered to practice before the U.S. Patent and Trademark Office and all have advanced coursework in their technical areas of expertise.

## DUE DILIGENCE

Our patent lawyers have considerable experience in due diligence and risk assessment of patent and trademark portfolios in financings, for both companies and underwriters, and for mergers and acquisitions, joint ventures, public offerings, and SEC compliance documents.

Due diligence experience includes:

- Represent Pequot Capital Management, a venture capital firm, in connection with due diligence analyses related to a number of medical device technologies, including spinal implants, ocular lens implants, vascular grafts, aortic valve repair and replacement and cardiac ablation devices
- Conducted Iron Mountain Incorporated's IP due diligence in relation to the acquisition of a leading software company
- Worked with a venture capital firm on a complex due diligence analysis related to combination drugs

## PATENTS

Our intellectual property lawyers have experience in the strategic preparation, prosecution and analysis of patent portfolios that protect clients' business objectives in both the United States and abroad for industrial, academic, technology, life science, health care and venture clients. Our patent lawyers work closely with the firm's other practice groups, particularly the Technology, Life Sciences, Litigation, Corporate, Tax and Private Equity/Emerging Company Groups.

Our patent lawyers counsel clients on all aspects of patent rights including the creation, maintenance and enforcement in a wide range of technologies. Our patent lawyers are also experienced in the preparation of patent validity, infringement, non-infringement and freedom-to-operate opinions.

Patent experience includes:

- Represent a Fortune 500 life sciences company in connection with freedom to operate opinions for antibody-based drug systems
- Represent a dental company in connection with the strategic development and prosecution of its patent portfolio related to medical and dental devices and compositions
- Represent a chemical company in a patent infringement action involving water purification
- Represented a veterinary pharmaceutical company in a patent infringement action (settled favorably prior to trial)
- Represented a medical device company in connection with the strategic development and prosecution of its patent portfolio related to surgical devices
- Represented a public life sciences company in a non-infringement analysis relating to a phagemid expression system

## LICENSING AND COMMERCIAL CONTRACTS

Our Intellectual Property Group has experience assisting clients with the business advice, business connections, and legal experience necessary to create and implement multi-million dollar licensing programs and to draft and negotiate a wide variety of commercial contracts from distribution and manufacturing agreements to materials transfer and professional services agreements.

Licensing and commercial contracts experience includes:

- Represented a publicly traded life sciences company with 43 subsidiaries worldwide on patent licensing, technology transfer, distribution agreements, terms and conditions of sale, and related matters
- Represented a leading communications rating software company in connection with drafting and negotiating a \$3 million master software license agreement, marketing agreement and consulting services agreement

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- Represented a life sciences company with ongoing strategic planning in connection with the development of technology licensing relationships with large pharmaceutical and leading educational institutions
- Represent a privately held developer of software for use in the commercial real estate market in complex source code cross-licensing arrangements
- Developed and negotiated complex licensing, manufacturing, distribution and joint venture agreements for a life sciences company seeking to collaborate in the research and development of antibodies for human therapeutic uses

## TRADEMARK AND COPYRIGHT REGISTRATIONS

Our intellectual property registration and maintenance programs include full-service work in connection with the clearance, prosecution and maintenance of trademark and copyright registrations and ensuring the protection and correct usage both domestically and abroad. Our attorneys focus on strategic portfolio development, protection and enforcement, and manage worldwide trademark portfolios for several large public and privately held companies, such as Samuel Cabot Incorporated.

Our attorneys have successfully registered thousands of domestic and international trademarks. Our trademark services include:

- **Selecting trademarks:** formulating and executing search strategies; advising clients regarding possible trademark conflicts; advising as to the strength and registrability of trademarks; and attending to trademark issues relating to Internet domain names and Web sites
- **Managing the registration process:** preparation and filing of domestic and foreign trademark applications, including intent-to-use and community trademark applications; response to office actions; and negotiation with Trademark Office examiners; and handling trademark assignments, security interests, renewals and section 8 and 15 affidavits
- **Making the most of trademark rights:** developing licensing programs, enforcement strategies, and plans for doing business on the Internet; drafting and negotiating trademark licensing agreements in a variety of contexts
- **Infringement and protection:** advising clients in dealing with allegations of infringement of adversely held trademark and/or domain name rights; and handling petitions for cancellation and opposition proceedings as well as the preparation of and response to cease and desist letters

## INTELLECTUAL PROPERTY ENFORCEMENT

Our enforcement work includes extensive experience in domestic and international investigations into infringing, counterfeiting and gray market activity for a wide variety of consumer goods, using a select network of

investigators and local counsel. We establish comprehensive enforcement programs using a variety of tools and techniques, such as service of cease and desist letters, criminal prosecutions, U.S. Customs enforcement to bar importation of unauthorized goods, and civil actions. Our experience has shown that vigorous enforcement of intellectual property rights outside of the litigation context can effectively reduce reliance on litigation and result in cost-savings to our clients.

## LITIGATION

While risk analysis, prevention and protection are at the core of our client IP programs, our team understands that when a client's intellectual property is being compromised, there is often no other option but to consider litigation.

Litigation experience includes:

- Successfully represented a leading manufacturer of natural enzyme and phosphate removal products for use in pools, Jacuzzis and spas in settling a patent infringement action against a competitor. The competitor agreed to cease sales of the product at issue, change all labeling of future products, make a settlement payment, and issue a press release regarding the settlement
- Represented a publicly traded life sciences company in a dispute with a French multi-national corporation concerning license supply, marketing and distribution rights for superparamagnetic iron oxide nanoparticles
- Represented an Australian engineering software development company in a dispute concerning the theft of confidential, proprietary and trade secret information relating to software used to simulate the three-dimensional flow of molten plastic
- Represented a publicly traded life sciences company in a license/trade secret dispute relating to methods to treat mitochondrial disease using uridine analogs
- Represented a publicly traded technology company and its Irish subsidiary in a dispute concerning worldwide distribution rights
- Represented a life sciences start-up company in a theft of trade secrets dispute relating to insulin pump technology
- Represented a publicly traded life sciences company in connection with an inventorship and trade secret dispute relating to the development and use of magnetic resonance imaging contrast agents

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For further information about our Intellectual Property Group, please visit our website at [www.sandw.com](http://www.sandw.com) or contact:

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