

Intellectual Property

The Intellectual Property Group at Sideman & Bancroft is on the leading edge of technology and intellectual property law. Setting the pace in this rapidly evolving practice area, we help information technology companies and diverse clients from a broad range of other industries to address laws and regulations governing national and global commerce, technology uses, branding strategies, and creative expression. We provide legal advice and representation on transactions in which rights to technology and other intellectual property assets are at issue.

Our litigation attorneys have extensive experience handling disputes, litigation, and other proceedings in which critical intellectual property assets are at stake. When these matters arise, our experience allows us to offer clients a broad spectrum of responses, from temporary restraining orders and other equitable remedies, to representation in the courts and before administrative bodies, including the Trademark Trial and Appeal Board, to alternative dispute resolution (ADR), and to criminal referral, where appropriate.

AREAS OF CONCENTRATION

Intellectual Property Transactions and Counseling

Technology Transactions

Attorneys in the Intellectual Property Group assist both large and small companies in all areas of technology development and licensing transactions. We regularly draft and negotiate agreements affecting the full range of intellectual property rights, including patents, copyrights, trade secrets, trademarks, trade dress, and know-how. Our experience includes domestic and international transactions involving computer software, computers and electronic devices, databases and information rights, and medical technologies. We have substantial expertise in software development and licensing transactions for personal computers, application service providers (ASP), cloud computing, and dedicated embedded systems. We help our technology clients write and negotiate agreements related to technology development, electronic rights, distribution and reselling, end-user licensing, original equipment manufacturers (OEM), manufacturing of components and electronic and medical devices, and sales or purchases of businesses having substantial technology assets, among other transactions. Our bricks-and-mortar clients look to us for assistance with acquisitions of hardware and software systems, and investments in technology-related businesses.

Online Transactions

We routinely address electronic commerce issues—including privacy and online contracting issues—for a variety of clients, including clients establishing online “stores,” games, and social networks, or providing other Internet services. We also advise our clients with regard to the ever-changing landscape of rights in digital content.

Patent Licensing

The firm addresses patent licensing, ownership, and assignment issues as part of its practice. Although Sideman & Bancroft does not prosecute patent applications, we are well-connected with the patent prosecution attorney community and can work with our clients to find the best suited independent counsel to file and to prosecute domestic and foreign applications.



Trademarks

Whether a client is the owner of a single trademark registration or several hundred, Sideman & Bancroft offers personalized, timely, and cost-effective service. We work with clients to design trademark and branding strategies that function best for them, whether in the context of company start-ups, new product roll-outs, or taking an existing successful company to the next level of brand protection. We routinely offer advice regarding what, where, and when to file, all with an eye toward calculated brand growth and development. Our advice includes counseling as to the availability of proposed trademarks. Our multi-stage clearance process begins with a basic search and can proceed all the way to a full international search. This maximizes the number of proposed marks searched while minimizing expense.

Upon completing a brand development strategy that fits with a client's needs, we take action to implement it. Our attorneys provide full representation in relation to trademark registration and enforcement before the United States Patent and Trademark Office. This includes filing and prosecuting applications, maintaining existing registrations, and representing clients before the U.S. Trademark Trial and Appeal Board. We work with our network of trusted foreign legal counsel to implement a global reach.

Copyrights

Our attorneys help clients protect their copyrights in valuable works of authorship, such as computer software, multimedia products, and other technology products as well as books, articles and other literary works, audiovisual works, works of fine art and design, sound recordings, musical compositions, architectural designs, and other copyrightable works. We regularly analyze the scope of copyright protection available for clients' works, provide advice on copyrights in the context of the Internet, and work with clients to register, license, and otherwise exploit their copyrights.

The Intellectual Property Group is well versed in the details of the Digital Millennium Copyright Act (DMCA). We frequently use the take-down provisions of the DMCA to circumvent infringers and to force ISPs to remove or block access to infringing material.

Trade Secrets and Confidentiality

Sideman & Bancroft regularly assists clients in protecting trade secrets and other confidential information relevant to their technologies, production processes, business and marketing plans, and customer lists. Our efforts include working with our clients to design, negotiate, and enforce non-disclosure and non-solicitation agreements, including agreements with employees, to protect their own confidential information. These elements are a part of an overall trade secret protection plan, which we help our clients to develop and to implement. We also advise our clients on their rights and obligations when receiving confidential information from others.

Intellectual Property Portfolio Audits

Attorneys in the Intellectual Property Group work with clients to assess the strength of their intellectual property assets, including copyrights, trademarks, trade secrets, and patents, and to identify potential issues regarding those assets. These assessments may be for internal audit

purposes or for the purposes of evaluating existing or potential investments in technology companies, or other companies with meaningful intellectual property assets. Sideman & Bancroft also assists clients in resolving issues identified through the audit process.

Trademark portfolios have a tendency to expand. Without a watchful eye, this results in unwanted costs and fees for the trademark owner. We specialize in auditing “runaway portfolios” and have been successful in significantly reducing trademark costs for clients. The goal of these audits is to cut unnecessary expenses while allowing for initiation and maintenance of registrations deemed valuable to our clients and their brands.

Taxation of Intellectual Property

The firm counsels clients on the many federal, international and state intellectual property tax issues. We advise clients with respect to the tax implications of licensing, distribution and related agreements; online services provider agreements; mergers and acquisitions of companies owning significant intellectual property; and the organization of start-ups and joint ventures.

Intellectual Property Litigation and Dispute Resolution

Copyrights

The proliferation of electronic media and Internet commerce has dramatically altered and increased the risk of infringement of copyrights and other rights of authorship. Sideman & Bancroft attorneys help clients meet this challenge as well as protect copyrights in traditional media by applying litigation skills to protect important interests. This includes infringement litigation involving computer programs, literary works, sound recordings, musical compositions, works of art and design, architectural designs, and many other protectable works. We also are experienced in litigating the often complex issues surrounding disputes involving authorship, ownership, works for hire, copyrightability, originality, and fair use.

Trademarks

The value of trademarks, service marks, and trade dress is greater than ever before. Our Intellectual Property Group routinely prosecutes and defends infringement, dilution, unfair competition, and false advertising claims involving both registered and unregistered trademarks and service marks, in addition to pursuing a wide variety of trade dress claims. We do so in all forums for resolving these types of disputes, including the federal courts, the Trademark Trial and Appeal Board, the state courts, and in a variety of alternative dispute resolution settings. Working closely with our Business Crimes Group, we advise technology clients and other brand owners on counterfeiting and customs issues.

Protection of a global brand means understanding risks and concerns regarding enforcement issues in the U.S. as well as in foreign jurisdictions. Our attorneys work with each client to design an individualized plan for protection and enforcement. We have obtained ex parte writs of seizure for counterfeit parts and labels in the U.S. and other countries. In collaboration with outside counsel, we also have pursued and defended trademark and service mark claims in numerous jurisdictions around the world.

Trade Secrets

The vast majority of intellectual property assets consist of compilations of confidential information that is not subject to the protections of patent, copyright, or trademark laws. Instead, these assets are protected under the body of trade secret law that gives the owner certain rights to prevent their use or disclosure, providing the owner can demonstrate that the information is, in fact, a trade secret.

Our lawyers regularly handle cases in which the use or disclosure of critical trade secret information is at issue. We have extensive experience with cases in which preliminary injunctive relief has been sought, along with claims of significant money damages. Our experience in this area is invaluable to clients facing the threatened use or disclosure of valuable trade secret information or claims that they have engaged in the theft of others' trade secrets. Our lawyers also have acted for claimants and creative companies on issues relating to the alleged misuse of creative ideas presented in confidence.

Employee Mobility Disputes

While certain intangible assets of a business can be protected through patents and copyrights, a business's trade secrets and goodwill often are protected through the use and enforcement of restrictive covenants, such as non-compete and confidentiality agreements. Our lawyers have substantial experience both prosecuting and defending claims involving such agreements on behalf of a wide range of clients.

Even in situations where a former employee is not bound by a confidentiality or effective non-compete agreement, we have been successful in obtaining injunctive and monetary relief under various other legal theories, such as misappropriation of trade secrets, unfair competition, breach of duty of loyalty, and the "inevitable disclosure doctrine."

Anti-Counterfeiting and Anti-Piracy

Sideman & Bancroft has developed a unique practice referring counterfeiting cases to law enforcement agencies and to prosecuting authorities when a client company has been the victim of a significant crime. We actively collaborate with law enforcement (including the FBI, Secret Service, ICE, and other state and federal law enforcement agencies) in connection with our representation of victimized companies. Our attorneys also have developed and implemented criminal enforcement programs for clients addressing trademark violations (counterfeits) and copyright violations (piracy).

Not every case is appropriate for criminal referral. We assist clients in assessing potential cases, making criminal referrals where appropriate, and pursuing civil remedies for counterfeiting and piracy when criminal enforcement is not warranted.