INTELLECTUAL PROPERTY

In your business, ingenuity is the basis of your intellectual property. In our business, ingenuity, in addition to extensive legal experience and commitment to client service, is the basis of how we help you protect such property.

We partner with you to identify, develop and protect intellectual property and processes that are essential to your business, from patents and trade secrets to copyrights and trademarks. Our attorneys have reinforced their legal experience with scientific and engineering knowledge, which allows them to work with you at every step in the growth of your intellectual property portfolio. Some of our attorneys have substantial in-house intellectual property experience, giving them insight into the complex operational issues faced by technology-oriented companies, as well as an in-house lawyer’s perspective on cost efficiency.

Litigation and transaction support are major parts of our practice. We structure agreements to obtain the full value of large intellectual property portfolios and draw on a powerful and resourceful team of experienced attorneys in litigation matters in state and federal courts, as well as the International Trade Commission. Our attorneys also can help you navigate complicated reexamination and inter partes review proceedings in the U.S. Patent Office.

ADVERTISING

Copyrights, trademarks and rights of privacy and publicity may be at stake in advertising. We advise on fair use, endorsements, use of marks in comparative advertising and compliance with consumer statutes, among other things, and litigate false advertising claims on both the plaintiff’s and defendant’s sides.

COPYRIGHTS

We register and protect copyrights, and also take aggressive enforcement actions when necessary, including the filing of litigation. We also develop copyright registration programs for clients.

INTERNET/DOMAIN NAMES

We research and analyze the availability of domain names, secure registration, resolve disputes through arbitration or litigation and coordinate acquisition with trademark rights and marketing campaigns.

IP AND IT AUDITS AND DUE DILIGENCE

Many times companies undervalue or do not recognize their intellectual property and information technology assets. There also are situations where companies unknowingly are misusing another entity’s IP or IT, with significant consequences. Audits by experienced attorneys, who may work in concert with technical experts, enable companies to build a formal portfolio of intellectual property and take measures to register or protect it.

LITIGATION

Obtaining the highest-quality legal counsel is a must when dealing with disputes over intellectual property. At Taylor English, our unique platform allows us to offer such top-quality talent at a tremendous value for high-stakes IP matters. Our IP litigation team boasts a number of former AmLaw 100 attorneys, former judicial
clerks from the U.S. Courts of Appeals for the Federal Circuit and the Eleventh Circuit, and attorneys with technical degrees and significant industry experience. As one testament to our approach, litigants have selected Taylor English to be their counsel in more than 10 percent of all patent infringement cases filed in the U.S. District Court for the Northern District of Georgia since January 2016. If you consider only the cases that actually moved forward, where both sides made an appearance, our representation rises to more than 15 percent of patent cases.

Clients trust us with all types of IP disputes. We have efficiently resolved and won complex utility and design patent infringement cases, inventorship disputes, post-grant proceedings in the USPTO such as Reexaminations, Inter Partes Reviews and Covered Business Method Reviews, trade secret matters, and licensing disputes. We have successfully handled trademark and trade dress infringement cases, trademark opposition and cancellation proceedings in the USPTO, and cases involving trademark dilution, counterfeiting, unfair competition, defamation, domain name cybersquatting, and false advertising. We have also achieved great results for our clients in copyright infringement cases dealing with all kinds of works, including music, movies, screenplays, videos, photographs, artwork, literary works, websites, databases, educational products, maps, and software. Some of our recent engagements, which are highlighted on our Experience page, illustrate the depth and breadth of our IP litigation practice.

Although headquartered in Atlanta, Georgia, our IP attorneys litigate in courts throughout the country. We represent clients at all levels of the federal and state court systems and in all the other key venues for resolving IP disputes. We have experience before courts in Georgia, Florida, Tennessee, South Carolina, North Carolina, Texas, California, Utah, Delaware, New York, New Jersey, Massachusetts, Connecticut, Kansas, Virginia, and Wisconsin, to name a few. In addition to our successes in federal-district and state court, we have won IP cases on appeal, including at the Federal Circuit and Eleventh Circuit, in administrative proceedings at the Patent Trial and Appeal Board and the Trademark Trial and Appeal Board, and at trial in the International Trade Commission.

Our value-driven model allows us to represent businesses of all sizes — from Fortune 500 companies to startups — as well as solo inventors and individuals, to protect their valuable IP assets or defend against claims of IP infringement or misappropriation. We work with all our clients to understand their goals for each particular matter, minimize litigation risks, achieve optimal results, and manage litigation costs. In short, we strive to give clients the information they need to anticipate and manage IP litigation costs like their other business expenses.

**PATENTS**

We secure your ingenuity and innovation with patent applications, licensing, patent preparation and prosecution and enforcement through the courts or alternative dispute resolution. We advise early on in the invention process, giving you the advice you need to strategically position your product for protection and to avoid disputes. We also can handle reexamination and inter partes review proceedings in the U.S. Patent Office, which have become increasingly significant and strategic components of protecting patent portfolios and defending infringement claims.

**PRIVACY**

We monitor federal and state legal and regulatory issues related to cyberattacks and data privacy, including:
The Federal Trade Commission’s (FTC) use of the “Privacy by Design” and "Unfairness Doctrine" to enforce privacy claims against corporations,

The Children’s Online Privacy Protection Act (COPPA), Health Insurance Portability and Accountability Act (HIPAA), the Telephone Consumer Privacy Act, and the CAN-SPAM Act,

Criminal statutes governing data access, abuse and extortion, and

State breach statutes.

TECHNOLOGY/IP TRANSACTIONS

We counsel clients on securitization of intellectual property in debt transactions and address issues that come up in mergers and acquisitions, joint ventures, and licensing and service agreements.

TRADE SECRETS

We place great importance on assisting companies in developing systems and best practices that protect their trade secrets. This includes auditing to identify trade secrets and the key employees who have access to them, setting up employee agreements to discourage theft and enforcing rights through litigation, as well as defending claims of misappropriation brought by competitors.

TRADEMARKS/TRADE DRESS

Our attorneys advise clients in identifying, registering and enforcing trademarks. This includes:

- Searching for availability and analyzing risks of adopting a trademark,
- Acquiring trademarks through federal and state trademark registrations,
- Integrating trademark portfolios with branding strategies and marketing campaigns,
- Preparing trademark usage guides and programs,
- Creating trademark licensing programs to maximize revenue and protect trademark assets,
- Implementing trademark monitoring programs to identify infringing activities, and
- Prosecuting and defending trademark infringement actions.

PRACTICE HIGHLIGHTS

Successful defense of Comverge, Inc. in patent infringement action relating to energy usage management. At the client’s request, we took over the defense of a large and hotly-contested patent infringement case brought by Nxegen LLC and Nxegen Holdings Inc. The patents involved systems and methods for remotely monitoring and adjusting energy usage. Facing a tight discovery schedule, we managed to produce, review and analyze a voluminous number of documents, take and defend approximately 30 depositions in a one-month period, amend the complaint to allege inequitable conduct, engage and work with liability and damages experts, and reach a successful resolution of the case by settlement, in a matter of a few months' time. Nxegen, LLC and Nxegen Holdings, Inc. v. Comverge, Inc.

Dismissals of copyright claims and separate state action for international airline client sued over use of architectural plans. Represented a major airline in claims brought by a former vendor alleging...
Intellectual Property

misuse of architectural plans for office space. Won motion to dismiss state-court conversion claims, and in subsequent federal copyright-infringement case based on the same underlying facts, conducted discovery and negotiated settlement in which plaintiff dismissed the case with prejudice and with no payments from our client.

**Mueller Water Products patent prosecution and licensing matters.** Provided counsel to client Mueller Water Products, Inc. on patent matters, including prosecuting and maintaining the client’s patent portfolio.

**NCAA media and sponsorship license.** Assist prominent national sports association and rights-holder in renewal of multimillion-dollar license of media and sponsorship rights to NCAA. Issues included availability of talent and executives, coordination with sister organizations on sponsor offerings, exclusivities and carve-outs of existing deals.

**Successful defense of patent case involving claimed method to detect autism.** Led defense of patent infringement case involving claimed method to detect autism by analyzing bodily fluids. After we filed two motions for summary judgment, the parties reached a confidential settlement. *Great Plains Laboratory, Inc. v. Metametrix Clinical Laboratory*

**Patent and trademark prosecution and licensing matters.** Provided counsel to one of the largest providers of in-home residential delivery services in the United States on all intellectual property matters. These matters range from prosecuting and maintaining the client’s patent and trademark portfolio, to counseling the client on protecting its trade secrets, to anonymously negotiating and obtaining a licensing agreement with a prolific non-practicing entity with a history of targeting businesses in the client’s arena.

**Landmark U.S. Supreme Court case Bilski v. Kappos.** Provided counsel to Bernie Bilski and Rand Warsaw in conjunction with the landmark U.S. Supreme Court case *Bilski v. Kappos.*

**Achieved summary judgment for defendant in copyright case involving speech therapy cards.** Defended educational products company in lawsuit alleging infringement of copyrights in cards for assistance with speech therapy. The court granted our motion for summary judgment, finding that there was no infringement of any copyright in the selection and arrangement of Plaintiff’s cards as a matter of law. *Ristuccia v. Super Duper, Inc.*

**Managed international patent portfolio for Georgia-based biotech company.** Managed the prosecution of U.S. and foreign patent applications in a large patent portfolio relating to identifying humans using antibody profiling processes.

**Expanded Technologies, Inc. v. Wallner Tooling/Expac, Inc.** Represented Expanded Technologies, a leading manufacturer of expanded metals for the HVAC filter industry, in a suit for declaratory judgments of non-infringement, invalidity and unenforceability of patent held by competitor. The litigation resulted in in a favorable confidential settlement.