

Calfee has one of the largest intellectual property and information technology practices in a general practice firm within the Midwest. We have more than 30 attorneys registered to practice before the U.S. Patent and Trademark Office in addition to other skilled intellectual property attorneys. Most of the lawyers in our practice have undergraduate and/or graduate degrees in mechanical, electrical, computer or chemical engineering, or chemistry, bio-chemistry or the biological sciences. Our Intellectual Property practice develops and protects the intellectual property and technology assets of a broad spectrum of clients. The group includes attorneys with multi-disciplinary science and engineering backgrounds who understand the technical aspects and practical applications of intellectual property assets. Our attorneys offer a unique blend of technical capabilities and strong communication skills with pragmatic business counseling.

Our Intellectual Property group conducts patent and trademark searches, prepares and prosecutes U.S. and international patent, trademark and copyright applications; and works with clients to maintain issued patents and registered trademarks. We provide corporate counseling on issues of licensing agreements; assignments, security interest and confidentiality and non-disclosure agreements, trade secret protection; and patent and trademark infringement. Calfee attorneys also represent clients involved in intellectual property disputes and litigation -- helping resolve issues of infringement; trademark oppositions and cancellations; patent interferences; trade secret and unfair competition violations.

Serving a national and international client-base comprised of both established and entrepreneurial enterprises, Calfee provides fully integrated, high quality legal services throughout the United States and around the world. Our attorneys work with clients to develop strategies for utilizing the client's intellectual property, protecting trade secrets, and for dealing with adverse claims of patent, trademark and copyright infringement.

Representative Experience

Patent, Trademark and Copyright

- > Patent and trademark searches
- > Preparation and prosecution of U.S. patent, copyright and trademark applications
- > International patent and trademark prosecution
- > Patent validity studies
- > Patent infringement studies
- > Maintenance of issued patents and registered trademarks

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Corporate Counseling

- > License agreements, assignments, security interest agreements and confidentiality agreements
- > Merger and acquisition due diligence
- > Employee and consulting agreements
- > University technology transfer
- > Patent, trademark and copyright infringement

Litigation

- > Patent, trademark and copyright infringement
- > Trademark oppositions and cancellations
- > Patent interferences
- > Trade secret violations
- > Unfair competition violations
- > Technology contracts and licensing
- > International Trade Commission proceedings
- > U.S. Customs conflicts

Representative Projects

- > Represented a manufacturer and developer of optical analyzers in obtaining worldwide patent protection.
- > Negotiated an international joint venture agreement between Swedish and German corporations concerning joint development of a high technology gas system.
- > Counseled start-up biotechnology entity in planning concerning U.S. and international patent portfolio.
- > Represented a national consumer products company in connection with obtaining and maintaining U.S. and international trademark registrations, including licensing and protection.
- > Represented a national consumer appliance manufacturer in connection with trademark licensing of the company trademarks to a joint venture entity created to provide commercial services.
- > Represented a major publicly held corporation in a patent interference matter involving a personal computer and printer product.
- > Represented a manufacturer in defending a claim of false advertising in connection with comparative consumer products advertising.
- > Represented a major corporation in connection with defense of a multi-million dollar patent infringement litigation.
- > Represented a major manufacturer of automotive accessories in connection with obtaining patent protection for the vehicle safety technology currently manufactured and sold to U.S. and Japanese automotive manufacturers.
- > Counseled software development corporations in connection with ownership and sale of computer programs to distributors and end users.
- > Counseled clients in connection with proper marking of U.S. and foreign-made goods for U.S. and foreign sales concerning manufacturing claims such as “made in the U.S.A.”

- > Represented client in connection with U.S. Customs' seizure of goods alleged to infringe U.S. trademarks and copyrights.
- > Defended and enforced breach of contract claims involving trade secret materials.
- > Represented a major corporation in connection with enforcement of warranty claims related to design and performance of a high technology manufacturing operation.

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