We understand the essential value intellectual property provides to your business. Our interdisciplinary team regularly advises clients in acquiring, protecting and monetizing intellectual property rights and litigating or alternatively resolving disputes regarding such rights in the U.S. and abroad.

PROCUREMENT AND TRANSACTIONS

We provide strategic legal advice to clients ranging from emerging growth firms to established multinational companies in a wide variety of intellectual property procurement, management and transactional matters, including:

- Patent prosecution before the U.S. Patent and Trademark Office, including new applications, reexaminations, and appeals to the Board of Patent Appeals and Interferences
- Opinions of counsel regarding patent invalidity and non-infringement
- Freedom-to-operate analyses and opinions for new products
- Trademark and copyright procurement and management, including performance of searches, rendering of viability opinions, filing applications for registration, and monitoring and maintaining portfolios
- Trade secret protection, including crafting corporate confidentiality, security and non-competition programs
- Licensing and technology transfer transactions, including trademark, copyright, trade secret, Internet domain name and technology licensing, acquisitions and sales
- Intellectual property due diligence and counseling in acquisitions and financing transactions

LITIGATION

We have addressed issues involving patent infringement, trademark infringement, copyright infringement, unfair competition, internet domain name disputes, false advertising, false designation of origin, software licensing and product disparagement claims. We have litigated these cases in Pennsylvania, New Jersey, Delaware, Texas, California, New York, Virginia, Kentucky, and before the International Trade Commission, at both the trial and appellate court levels before state and federal courts, as well as in private
commercial arbitration and arbitration under the Internet Corporation for Assigned Names and Numbers (ICANN). Members of the group also practice before the U.S. Patent and Trademark Office and the Trademark Trial and Appeal Board in trademark cancellation and opposition proceedings.

**Representative Matters**

- Won landmark award of attorneys fees against patent troll and its attorneys in a patent infringement case for Gust, Inc. after having litigation transferred from Eastern District of Texas to Southern District of New York.
- Obtained judgment of patent infringement on behalf of manufacturer client kidsme and subsequently successfully ended the sale of over 150 similar patent-infringing baby feeder products on Amazon.com.
- Obtained Motion to Transfer from Eastern District of Texas to Southern District of New York in a patent infringement case.
- Represented major technology companies as plaintiffs and defendants in patent infringement litigations in federal district courts and the International Trade Commission.
- Represented technology companies in patent litigations brought by non-practicing entities (NPE’s).
- Acted as chief patent portfolio architect, drafting and prosecuting patent applications for a leading telecommunications services company.
- Represented a security company in a trademark action against a competitor, receiving favorable award and attorneys fees.
- Represented medical device manufacturer in major litigation regarding recently approved treatment for osteoarthritis.
- Represented clients in Hatch-Waxman litigation.
- Formulated university intellectual property policy and assisted in establishing technology transfer group for a leading university.
- Assisted national dental care provider in developing and implementing trademark strategy.
- Represented large commercial television shopping network against claims of false advertising, false designation of origin, and unfair competition under the Lanham Act for sale of a product on the network that allegedly was an unprivileged imitation of a competing product; summary judgment motion was filed on behalf of the network, leading the plaintiff to settle with the network for $10,000 against a damages claim of $640,000.
- Represented advertising agency against claims of copyright infringement arising out of the alleged copying of a copyrighted song in a television commercial.
- Represented a foreign manufacturer of pharmaceutical products and medical devices in the acquisition of worldwide marketing and distribution rights to a line of products.
- Represented a European-based pharmaceutical manufacturing, development and distribution company in the grant of exclusive U.S. distribution rights to a product in development to a large, U.S.-based pharmaceutical company.
- Represented a specialty pharmaceutical firm in obtaining a trademark license from a multi-national pharmaceutical company.
- Represented a clothing manufacturer in obtaining trademark licenses from large, publicly traded automotive manufacturers.
• Represented a privately held medical device development firm in the license of a patent-pending drug delivery instrument from a publicly traded pharmaceutical company
• Assisted a multi-national client in negotiating a favorable settlement with the Business Software Alliance
• Represented specialty software developer in license of its software to a national healthcare company
• Assisted world’s largest creative competitions firm in procuring and maintaining its intellectual property portfolio
• Represented a product manufacturer against claims of trade dress infringement and unfair competition in violation of the Lanham Act arising out of allegations by a competitor that the client’s trade dress for the product was likely to cause consumer confusion due to the alleged similarity in appearance
• Prosecuted cyber-squatting suit on behalf of a physical therapy service provider in National Arbitration Forum proceeding; obtained award in favor of complainant, including forced transfer of the domain name to complainant and reimbursement of attorney’s fees
• Defended software development company against breach of $1.1 million licensing agreement before a commercial arbitration panel arising out of alleged failure of program to deliver promised functionality; after extensive discovery focusing on technical aspects of both computer programming techniques and insurance underwriting and reporting functions so as to come to an understanding of the contract’s use of the term “functionality”, and the development of expert comment on these issues, the parties submitted to non-binding mediation; the remaining claims were settled for $350,000
• Represented insurer in Information Spectrum, Inc. v. The Hartford, 860 A.2d 926 (N.J. 2004) resulting in precedent-setting ruling governing coverage of copyright infringement and reverse passing off claims under the advertising liability provision of commercial general liability policies
• Represented a mid-size physical therapy services provider defending against trademark infringement claim, successfully defeated temporary restraining order and resolving matter to allow for continued use of a disputed mark in certain geographic locations
• Acted as local counsel in product disparagement claim arising out of underlying patent infringement allegations, focusing on the applicability of the absolute litigation privilege to cease and desist letters issued by counsel
• Litigated an international domain dispute with ICANN arbitrators pursuant to the Uniform Domain Name Dispute Resolution Policy

**News**

Mike Kassak and Josh Mooney Reappointed as Vice-Chairs of American Bar Association’s Cybersecurity and Data Privacy Committee
September 3, 2019

Randy Friedberg Appointed Chair of New York City Bar Association’s Entertainment Law Committee
September 3, 2019

*Best Lawyers®* Recognizes 29 White and Williams Lawyers
August 15, 2019
White and Williams Earns Tier 1 Rankings from U.S. News "Best Law Firms" 2019
November 1, 2018

Best Lawyers Recognizes Twenty White and Williams Lawyers
August 15, 2018

Randy Friedberg Guests on The Art of the CEO Radioshow
February 6, 2018

Melissa Nott Davis Joins White and Williams in Boston
September 13, 2017

Best Lawyers Recognizes Fifteen White and Williams Lawyers
August 15, 2017

Richard Borden Joins White and Williams as Chief Privacy Officer
May 15, 2017

White and Williams Represents Gust in Landmark Patent Troll Litigation
December 27, 2016

White and Williams Earns Tier 1 Rankings from U.S. News "Best Law Firms" 2017
November 1, 2016

Best Lawyers Recognizes Twelve White and Williams Lawyers
August 15, 2016

Congratulations 2015 DE, MA, NJ, NY and PA Super Lawyers and Rising Stars
October 21, 2015

White and Williams Lawyers Recognized by Best Lawyers
August 17, 2015

Randy Friedberg Discusses the Importance of Protecting Your Brand
Staples Business Hub | April 26, 2015

Congratulations 2014 DE, MA, NJ, NY and PA Super Lawyers and Rising Stars
October 22, 2014

Congratulations 2013 New York Super Lawyers and Rising Stars
Super Lawyers Magazine | September 13, 2013

Randy Friedberg Discusses Website Terms and Conditions on UK Radio
February 18, 2013

Prominent Intellectual Property Lawyer Joins White and Williams
January 28, 2013
Randy Friedberg Published in the Copyright and New Media Law Newsletter
October 17, 2012

Randy Friedberg Comments on Copyright Infringement Violations on Tech News World
February 6, 2012

Randy Friedberg Selected as a 2011 New York Super Lawyer
September 29, 2011

Randy Friedberg Quoted in E-Commerce Times on Android Patent Battle
August 4, 2011

Randy Friedberg Comments on Recent Recording Industry Settlement
May 2011

Randy Friedberg, Contributing Author of "Navigating Intellectual Property Disputes"
October 2009

Publications

Foreign Trademark Applicants and Registrants Must Now Be Represented By US Counsel
Intellectual Property Alert | July 16, 2019

Endorsements in Social Media
prforpeople.com | August 3, 2018

Ban On Disparaging Trademarks Deemed Unconstitutional
Intellectual Property Alert | June 21, 2017

Proposed "Tech Tax" Could Derail PA Start-Up Businesses
Corporate and Securities Alert | June 15, 2017

Supreme Court Limits Venue in Patent Cases in TC Heartland
Intellectual Property Alert | May 23, 2017

Online Registration of DMCA Agents Becomes Mandatory
Intellectual Property Alert | March 23, 2017

Chinese IP Court Hands Down Groundbreaking Damages Award; Boon to U.S. Companies with IP Interests in China
Intellectual Property Alert | December 19, 2016

Supreme Court: Design Patent Damages May Be Limited to Infringing Component of End Product, Rejecting Apple's $399M Award Against Samsung
Intellectual Property Alert | December 12, 2016

Challenged Patent Upheld in the First Post-Grant Review Decision Involving Pharmaceuticals
Intellectual Property Alert | December 8, 2016
A New Way to Protect Trade Secrets Will Likely Be Law Soon
Intellectual Property Alert | May 6, 2016

Supreme Court Refuses to Hear Appeal In Google Books Copyright Case
Intellectual Property Alert | April 20, 2016

The Appellate Standard of Review for Patent Claim Construction
Practical Law Company | July 2015

Protecting Your Brand in the Brave New World
The Connector Magazine | May 2015

Boundaries of Fair-Use Defense in Trademark Infringement
The Legal Intelligencer | April 22, 2014

Intellectual Property Roundtable: Issues Facing Practitioners Today
The Legal Intelligencer | February 2014

Locked Out on LinkedIn: LinkedIn Account Belongs to Employee, not Employer
Intellectual Property & Technology Law Journal | June 2013

Clients Benefit from Early Action in Response to Patent Infringement Notice Letters
Intellectual Property Alert | April 8, 2013

Proving Obviousness? Understanding the Implications of In re Cyclobenzaprine
China Intellectual Property Magazine | December 2012

Norman IP v. Lexmark: Post AIA Joiner and the Rule 42 Trump Card

Music Law 101: Legal Issues Surrounding the Recording and Posting of Concerts
Concertblogger.com | August 1, 2012

USPTO Offers IP Awareness Assessment

Foreign Trademarks in China: Why Registering for One is Necessary
China Business Alert | May 30, 2012

Recent Impact of Reexams on Stays in E.D. Texas
Gibbons IP Law Alert | May 15, 2012

Events

Decoding U.S. Intellectual Property Laws
ExploreNJ (Jersey City, NJ) | June 13, 2019
Analyzing the Fair Use Defense in Music Law
Lawline Webinar | February 14, 2019

Policing and Protecting Copyrights on the Internet: Latest Approaches and Developments
Strafford Webinar | November 1, 2018

Color By Numbers: Art Law 101
Lawline Webinar | April 17, 2018

In-House Counsel Guide to Trade Secrets
Lawline Webinar | June 27, 2017

How Not To Create an International Incident: U.S. and Canadian Perspectives on Counsel-to-Counsel and Counsel-to-Court Duties in Practicing Entity Litigation and Troll Litigation

In-House Counsel Guide to Trademarks
Lawline Webinar | June 21, 2017

In-House Counsel Guide to Copyright
Lawline Webinar | June 20, 2017

In-House Counsel's Guide to Patents
Lawline Webinar | May 25, 2017

Managing Risk in International Contracting and Transactions

Trademark Selection and Clearance 101
Lawline Webinar | February 15, 2017

Intellectual Property Transactions in the United States: Considerations and Complications for Chinese Companies
The 7th China IP International Annual Forum (Beijing, China) | January 2017

Fair Use After Guild v. Google
Lawline | October 24, 2016

IP Due Diligence Update: 2016
Lawline | October 23, 2016

Update on the "The Slants" Trademark Case
New York City Bar Association Entertainment Law Committee | October 17, 2016

Digital Creativity: Culture Reimagined
Benjamin N Cardozo School of Law (New York, NY) | April 14, 2016

Key US Trademark Trends: Significance and Implications for Chinese Companies & on Recent U.S. Trademark Decisions: Strategies and Considerations for Chinese Companies
The 6th China IP International Annual Forum (Beijing, China) | January 22, 2016
Anatomy of an IP License
Clear Law Institute Webinar | October 29, 2015

Negotiating and Drafting License Agreements
Lawline.com | June 25, 2015

An In-House Counsel's Guide to Patents
Lawline.com | July 1, 2014

An In-House Counsel's Guide to Trade Secrets
Lawline.com | July 1, 2014

Enforcement of Trademarks and Copyrights for In-House Counsel
Lawline.com | July 1, 2014

Roadmap to Patent Litigation in the U.S.: Procedures, Issues and Strategies
Annual Conference of In-House IP Managers in China (Beijing, China) | January 11, 2014

Strategic Patent Protection and Enforcement in the “New World” After the America Invents Act
The 8th Annual Corporate Intellectual Property Conference (Beijing, China) | May 28, 2013

U.S./China Intellectual Property Protection
Ben Franklin Technology Partners of Southeastern PA | May 22, 2013

Safeguarding Your Exports
Federal Reserve Bank, Philadelphia, PA | April 30, 2013

IP Due Diligence
Lawline.com | December 5, 2012

Inequitable Conduct: Getting to Therasense and Beyond
Advanced Practical Seminar on Protecting IP Rights Overseas (Beijing, China) | October 18, 2012

Social Media: Business Issues, Legal Issues and Risk Management Topics and Issues for the CFO and the CIO
Penn State Great Valley, Malvern, PA | July 24, 2012

**Cases & Deals**

White and Williams Ends Sale of Over 150 Patent-Infringing Baby Feeder Products on Amazon.com
May 13, 2019

White and Williams Represents GoodWest Industries in Its Acquisition of Skinny Mixes LLC
April 2, 2019

Stadium Goods to Be Acquired by Farfetch Limited
December 13, 2018
Cal Net Technology Merges With NexusTek
August 7, 2018

Court Denies AlphaCap’s Motion for Reconsideration and Lifts Stay Citing Concerning Statements from AlphaCap’s Attorneys in Gust Case
July 7, 2017

White and Williams Represents Gust in Landmark Patent Troll Litigation
December 27, 2016

White and Williams Represents Gust in Patent Infringement Cases
November 20, 2015

White and Williams Represents Leading Specialty Nutriceutical Company in Sale
July 28, 2014

Guest-tek Acquisition of iBahn Takes Hotel Technology to a Higher Level
March 21, 2014

Seton Company Relies on Broad Experience of White and Williams
August 31, 2011

Defense Verdict Obtained in Trade Secrets Case
Summer 2009