

## Intellectual Property

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.

### 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, Massachusetts, and Kentucky, 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.

### Procurement and Transactions

We provide strategic 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, patent, trade secret, Internet domain name and technology licensing, acquisitions and sales
- Intellectual property due diligence and counseling in acquisitions and financing transactions

### PRACTICE CONTACT

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### RELATED PRACTICES

China Business  
Corporate and Securities  
Higher Education  
Insurance Coverage and Bad Faith  
International

### RELATED INDUSTRIES

Financial & Investment Services  
Food and Beverage  
Gaming  
Healthcare  
Insurance  
Technology

### PRACTICE HIGHLIGHTS

- Work with a wide array of industries and companies, ranging from emerging growth firms to multinational corporations
- Understand the essential value IP can provide to a business
- Possess extensive patent prosecution, litigation and alternative dispute resolution experience

## 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 a foreign manufacturer of pharmaceuticals 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 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

## **CASES & DEALS**

ROAR for Good Awarded Patent for Wearable Device Mesh Network System  
9.30.21

White and Williams Represents Autonomous Robot Manufacturer UBTECH in New Product Launch  
1.12.21

White and Williams Lawyers Deliver for Augmented Reality Company ImagineAR  
12.16.20

White and Williams Assists Japanese IT Client in Cross-Border Joint Patent Application Agreement  
11.12.20

Pennsylvania Waiver Granted for Ghost Robotics Amidst COVID-19-Related Closures  
3.25.20

White and Williams Ends Sale of Over 150 Patent-Infringing Baby Feeder Products on Amazon.com  
5.13.19

White and Williams Represents GoodWest Industries in Its Acquisition of Skinny Mixes LLC  
4.2.19

Court Denies AlphaCap's Motion for Reconsideration and Lifts Stay Citing Concerning Statements from AlphaCap's Attorneys in Gust Case  
7.7.17

White and Williams Represents Gust in Landmark Patent Troll Litigation  
12.27.16

White and Williams Represents Gust in Patent Infringement Cases  
11.20.15

## **NEWS**

White and Williams Ranked in Top Tiers of "Best Law Firms"  
11.5.21

Best Lawyers® Recognizes 38 White and Williams Lawyers  
8.19.21

Congratulations 2020 DE, MA, NY and PA Super Lawyers and Rising Stars  
11.5.20

White and Williams Earns Tier 1 Rankings from U.S. News "Best Law Firms" 2021  
11.5.20

Best Lawyers® Recognizes 43 White and Williams Lawyers  
8.20.20

White and Williams Adds Two Counsel in New York City Office  
8.7.20

13th Annual Coverage College Hosts Over 400 Insurance Professionals  
11.1.19

White and Williams Earns Tier 1 Rankings from U.S. News "Best Law Firms" 2020  
11.1.19

Mike Kassak and Josh Mooney Reappointed as Vice-Chairs of American Bar Association's Cybersecurity and Data Privacy Committee  
9.3.19

*Best Lawyers*® Recognizes 29 White and Williams Lawyers  
8.15.19

White and Williams Earns Tier 1 Rankings from U.S. News "Best Law Firms" 2019  
11.1.18

*Best Lawyers* Recognizes Twenty White and Williams Lawyers  
8.15.18

Randy Friedberg Guests on The Art of the CEO Radioshow  
IP - Protecting Your Brain Children  
2.6.18

*Best Lawyers* Recognizes Fifteen White and Williams Lawyers  
8.15.17

White and Williams Represents Gust in Landmark Patent Troll Litigation  
12.27.16

White and Williams Earns Tier 1 Rankings from U.S. News "Best Law Firms" 2017  
11.1.16

*Best Lawyers* Recognizes Twelve White and Williams Lawyers  
8.15.16

Congratulations 2015 DE, MA, NJ, NY and PA Super Lawyers and Rising Stars  
10.21.15

White and Williams Lawyers Recognized by *Best Lawyers*  
8.17.15

Randy Friedberg Discusses the Importance of Protecting Your Brand  
*Staples Business Hub*, 4.26.15

## **PUBLICATIONS**

Don't Be the Next Boeing: Fixing Tension Between Engineering, Legal  
*Bloomberg Law*, 6.25.21

Legal Use Case 7 Part III: The Analysis  
*Apex Ridge Reliability*, 6.3.21

Legal Use Case 7: A Conversation  
*Apex Ridge Reliability*, 5.11.21

Making Safer Robotic Devices  
*The Journal of Robotics, Artificial Intelligence & Law*, Volume 4, No. 4 | July – August 2021

Winter COVID-19 Relief Bill: Overview of Key IP and Entertainment Provisions  
*Intellectual Property Alert*, 1.4.21

USPTO Issues Third Notice Extending Certain Patent & Trademark Deadlines Due to COVID-19  
*Intellectual Property*, 5.1.20

The Supremes Are Addressing Intellectual Property  
*Intellectual Property Alert*, 4.28.20

USPTO Issues Notice Waiving Certain Patent and Trademark Deadlines Due to COVID-19  
*Intellectual Property Alert*, 4.3.20

Foreign Trademark Applicants and Registrants Must Now Be Represented By US Counsel  
*Intellectual Property Alert*, 7.16.19

Endorsements in Social Media  
*prforpeople.com*, 8.3.18

Ban On Disparaging Trademarks Deemed Unconstitutional  
*Intellectual Property Alert*, 6.21.17

Supreme Court Limits Venue in Patent Cases in TC Heartland  
*Intellectual Property Alert*, 5.23.17

Online Registration of DMCA Agents Becomes Mandatory  
*Intellectual Property Alert*, 3.23.17

Chinese IP Court Hands Down Groundbreaking Damages Award; Boon to U.S. Companies with IP Interests in China  
*Intellectual Property Alert*, 12.19.16

Supreme Court: Design Patent Damages May Be Limited to Infringing Component of End Product, Rejecting Apple's \$399M Award Against Samsung  
*Intellectual Property Alert*, 12.12.16

Challenged Patent Upheld in the First Post-Grant Review Decision Involving Pharmaceuticals  
*Intellectual Property Alert*, 12.8.16

A New Way to Protect Trade Secrets Will Likely Be Law Soon  
*Intellectual Property Alert*, 5.6.16

Supreme Court Refuses to Hear Appeal In Google Books Copyright Case  
*Intellectual Property Alert*, 4.20.16

The Appellate Standard of Review for Patent Claim Construction  
*Practical Law Company*, 7.15

## EVENTS

Intellectual Property Protection and the Potential Future of US-India Relations  
World Trade Center of Greater Philadelphia India and Southeast Asia Club (Virtual), 11.19.20

Protecting Copyrights on the Internet: Latest Approaches and Developments  
Navigating Fair Use, Infringement Claims, DMCA Safe Harbor and Secondary Liability Issues  
Strafford CLE Webinar, 5.13.20

Decoding U.S. Intellectual Property Laws  
ExploreNJ (Jersey City, NJ), 6.13.19

Analyzing the Fair Use Defense in Music Law  
Lawline Webinar, 2.14.19

Color By Numbers: Art Law 101  
Lawline Webinar, 4.17.18

In-House Counsel Guide to Trade Secrets  
Lawline Webinar, 6.27.17

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  
AIPLA 2017 Electronic and Computer Patent Law Summit (Toronto, Ontario, Canada), 6.21.17

In-House Counsel Guide to Trademarks  
Lawline Webinar, 6.21.17

In-House Counsel Guide to Copyright  
Lawline Webinar, 6.20.17

In-House Counsel's Guide to Patents  
Lawline Webinar, 5.25.17

Managing Risk in International Contracting and Transactions  
Global Business Conference: Navigating Trade in the New Environment (Atlantic City, NJ), 4.27.17

Trademark Selection and Clearance 101  
Lawline Webinar, 2.15.17

Intellectual Property Transactions in the United States: Considerations and Complications for Chinese Companies  
The 7th China IP International Annual Forum (Beijing, China), 1.17

Digital Creativity: Culture Reimagined  
Benjamin N Cardozo School of Law (New York, NY), 4.14.16

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), 1.22.16

Anatomy of an IP License  
Clear Law Institute Webinar, 10.29.15

Negotiating and Drafting License Agreements  
Lawline.com, 6.25.15