

→ Patent Prosecution and Counseling

Sheppard Mullin offers a complete patent practice, including patent prosecution, licensing and related transactional matters, as well as client counseling. Our patent prosecutors have experience in a range of technologies, including pharmaceuticals, software, biologics, electronics, industrial manufacturing, polymers, diagnostics and interdisciplinary technologies such as personalized medicine and medical devices.

A number of our attorneys are registered to practice before the United States Patent and Trademark Office ("USPTO"). Our patent attorneys have a variety of technical backgrounds in such fields as electronics, computers, aerospace, semiconductor devices and device processing, instrumentation, mechanical, chemical and biology. Many of our patent practitioners have advanced technical degrees and substantial industry experience.

We have significant expertise in assisting companies, from small start-up ventures to global enterprises, in developing and implementing company specific patent strategies, evaluating the patentability of new products and inventions, and preparing and prosecuting patent applications in the United States and throughout the world. Our patent practitioners handle the initial preparation and filing of the applications and the subsequent prosecution of the applications before patent examiners and before the USPTO's Patent Trial and Appeal Board. We also have experience searching and analyzing the prior art to evaluate an invention's patentability and to craft patent claims. We have a support group of highly experienced administrative assistants to handle administrative tasks and post-issuance matters, including the preparation and recordation of assignments and the payment of maintenance fees and annuities. We are skilled at managing global patent portfolios, and our network of foreign prosecution associates spans most foreign countries, including Australia, Canada, China, the European Community, Japan, Korea, Mexico and Taiwan.

In addition to patent prosecution, we offer counseling services to our clients on the complete range of issues that can arise in connection with patent matters. For example, after assisting our clients by patenting their inventions we offer strategic counseling to enable them to exploit their patents through licensing and, where necessary, through enforcement. Because our patent attorneys and agents have substantial experience licensing and enforcing patents, they are better able to write and obtain patents that have value and that will withstand the scrutiny of litigation and licensing negotiations.

We also render opinions concerning the validity, enforceability and infringement of patents. Any company having notice of a patent which may apply to its activities has a legal duty to act with due care for the rights of the patent owner. This duty normally requires that the company obtain a formal opinion of outside counsel to assess whether the patent applies to its activities and is valid. Our expertise in prosecuting and enforcing patents enables us to efficiently and thoroughly review patents and to advise our clients how best to proceed. We review patents to determine whether they have been properly issued and whether they are valid and enforceable. This usually involves a carefully study of the patent, its claims and its prosecution history (the written record of prosecution of the patent from filing to issuance), to determine whether or not the patent claims comply with the requirements for patentability, including novelty, non-obviousness and support by an enabling disclosure. Such opinions frequently involve a thorough prior art search, because it is sometimes possible to find highly relevant prior art not considered by the patent examiner.

We prepare product clearance opinions so that a company can have a reasonable comfort level that a new product does not infringe patents held by others. To formulate such an opinion, we normally conduct a thorough prior art search and an initial screening of the search patents to identify any of them that might include claims arguably applicable to the product. We then perform a detailed study of any close patents, to assess the potential for a problem. In some cases, when it is determined that the risk of infringement is substantial, our attorneys will consult with the client to propose and consider various alternative product designs to reduce or eliminate the infringement risk.

Our attorneys have expertise with licensing and other transactional matters concerning patent rights. This includes preparation of license agreements, assignments, and settlement agreements in connection with litigation. It also includes preparation of license agreements and assignments by a company's employee inventors. We negotiate and prepare license agreements, assignments and other agreements for arm's length transactions.