PATENTS, TECHNOLOGY & TRADE SECRET IMPLEMENTATION

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Related Practices

Intellectual Property
Intellectual Property
Litigation
Trademark, Copyright
& IP-Related
Advertising/Media

Corporate in-house counsel, inventors and entrepreneurs rely on our patent team for counsel on protecting their valuable technological innovations. Our attorneys draw on a high level of skill, experience and technical knowledge to provide a full range of patent services. Our team handles patent prosecution and portfolio management, domestic and foreign, as well as patent litigation. We have extensive experience in highly technical areas including electrical, mechanical, chemical and pharmaceutical patents.

Our work in patent protection includes:

- Patent prosecution
- Patentability, state-of-the-art, validity, infringement and freedom-to-operate opinions
- Strategic counseling on timing and geographic reach of patent applications
- Structuring and enhancing patent portfolios from defensive and offensive perspectives
- Strategies for design-arounds to avoid patent infringement
- Post-grant proceedings, including reexamination and inter partes review proceedings

We can also assist with identifying your trade secrets and establishing a trade secret program, as well as with the maintenance and protection of that information via non-disclosure or non-compete agreements.

Post-Grant Proceedings

With the possibility of already-issued patents being challenged, our work doesn’t end when a patent is granted. Let us help you protect your interests from post-grant challenges. Our attorneys have experience handling all types of post-grant proceedings at the U.S. Patent and Trademark Office (USPTO), including inter partes reviews, post-grant reviews and requests for re-examination. We also assist clients with launching validity challenges against patents owned by your competitors.
Technology Transactions and Licensing

In conjunction with the attorneys in our Business Services group, we can assist with a range of transaction issues involving your IP such as:

- Transfers of intellectual property
- Complex licensing of intellectual property
- Assignments of licenses
- Perfection of intellectual property rights and ownership
- Due diligence regarding patents, trademarks, trade secrets and copyrights in connection with mergers, acquisitions and divestitures and other corporate transactions
- Contracts
- Estate ownership of intellectual property

Relating to your business’s intellectual property in particular, we can assist with the following contracts and agreements, providing a detailed explanation of the benefits of each approach, drafting and negotiating the terms, and providing ongoing advice on maintenance and enforcement:

- Corporate structure and partnership agreements
- Confidentiality agreements
- Employment agreements
- Non-disclosure agreements
- Non-compete agreements
- Independent contractor agreements
- Agreements to assign
- Joint development agreements
- Supplier/vendor agreements
- Terms and conditions on purchase orders
- Material transfer agreements
- Cooperative research and development agreements
- Software development agreements
- Research agreements
- Joint defense agreements
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- Software hosting and escrow agreements
- Export control

Whether you are the licensor or licensee, our team will provide guidance in using the appropriate licensing vehicle to develop, commercialize, monetize and transfer your technology and the underlying patent, copyright, trademark and trade secret assets. We don’t practice using “cookie-cutter” agreement, but we first understand the nature of the deal, what each party brings to it, and each party’s interests and goals to develop a comprehensive term sheet.

Given our experience with business formation, operation, and IP, we can turn a legal eye specifically toward your business plans, licensing models and intellectual property portfolio strategies to help you fully leverage your assets and meet short-term and long-term objectives.

Transactions we have experience structuring and negotiating include:

- Software development and license agreements
- Patent and technology license agreements
- Intellectual property acquisitions and asset sales
- OEM, reseller and channel partner agreements
- Joint development and strategic alliance agreements
- Web development and hosting agreements
- Content and database licenses

Trade Secret Implementation

Our experienced team — well-versed in various technology areas — advises clients on the best way to protect technology assets, whether by patent, copyright, technology agreement, trade secret or a combination of those. Often businesses grapple with whether to protect a given technology by way of patent or trade secret. We assist clients in navigating this decision for what is most practical and best supports their business objectives. Further, we assist with conducting trade secret audits and establishing trade secret programs.

NEWS

42 Greensfelder attorneys named to 2020 Best Lawyers
August 15, 2019
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Greensfelder's IP practice, startup involvement featured in St. Louis Business Journal cover story
March 8, 2019

Greensfelder ranks in top tiers in 2019 Best Law Firms report
November 2018