

Patents

The Patent team at Flaster Greenberg has a deep bench of attorneys with decades of experience both prosecuting and litigating patents in all industries. Our patent team is a full-service team versed in both litigation and transactional work.

Patent Prosecution

Our Patent team represents clients in drafting and prosecuting patents in the United States and managing patent portfolios in every major international jurisdiction, including in China, Korea, India, Taiwan, Australia, Canada, Mexico, Russia, Brazil, the European Patent Office, and dozens of other nations. Flaster Greenberg represents some of the most innovative and tech-forward companies in the world in diverse technological areas such as telecommunication systems, solid state devices such as light-emitting device, load control electronics and power systems, medical devices, software, electrical hardware, wireless technologies, and drug delivery.

Our clients in the patent field include large multi-national corporations such as pharmaceutical and diagnostic companies, electronics companies, as well as start-ups and other industry disrupters in the life sciences, biotech, artificial intelligence, and machine learning spaces.

We also routinely draft and negotiate patent licensing agreements for clients both in the context of U.S. and international patent litigation and for more transactional technology transfers.

Post-Grant Validity Proceedings

Flaster Greenberg has substantial experience representing both patent owners and patent challengers in post-grant validity proceedings both before the United States Patent Office (USPTO) and several foreign patent offices and courts around the world. For instance, our attorneys have substantial experience in Inter Partes Review (IPR), Post-Grant Review (PGR), and ex parte re-examination proceedings at the USPTO. In fact, one of our attorneys is a former Patent Trial and Appeal Board (PTAB) supervisory attorney who trained PTAB attorneys and Administrative Patent Judges (APJs) during his time working at the Patent Office. This experience provides Flaster Greenberg a unique insight into post-grant proceedings and the Judges on PTAB panels.

Attorneys

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In addition, our attorneys have significant experience managing foreign counsel in patent validity challenges in several jurisdictions worldwide. For instance, our attorneys have experience managing Chinese Post-Grant Invalidation Proceedings before the CNIPA Patent Re-Examination Board and appeals to the Beijing IP Court, as well as EPO Oppositions both before during the initial phase before the opposition division and on appeal to the EPO Appeal Board. These proceedings are often handled in the context of foreign litigation, and Flaster attorneys have successfully defended the validity of asserted patents while also maintaining a useful scope that is necessary for a successful international enforcement campaign.

Due Diligence, Licensing, and Strategic Counseling

Our attorneys also serve as trusted advisors to clients whenever a patent issue arises. We routinely counsel clients regarding the scope and validity of patent rights of third parties, providing freedom to operate and product clearance opinions. We also negotiate on our clients' behalf with various intellectual property owners around the world. When a company is presented with a threat of infringement from either a competitor or a non-practicing entity, our attorneys can provide the strategic guidance and insights necessary to minimize risk and costs, allowing you to focus on your business objectives without patent issues getting in your way.

We also handle due diligence analysis for both mergers and acquisitions, as well as providing pre-suit investigative opinions regarding your IP rights. Our attorneys have routinely mined patent portfolios to identify potential assets for enforcement, helping clients find value in their IP. We also negotiate and draft IP licensing agreements, both in the context of tech transfer and in enforcement/litigation campaigns.

Litigation

Our attorneys have substantial experience representing companies in patent litigation in U.S. patent jurisdictions including Federal District Courts (including district courts in Pennsylvania, Delaware, New Jersey, New York, Massachusetts, Texas, Virginia, California, Illinois, Florida, among others) and at the International Trade Commission. We have represented both defendants and plaintiffs in infringement actions, and understand the strategic advantages and potential risks faced by both sides. We have litigated cases involving software, electrical hardware, light emitting diodes, medical devices, pharmaceutical products, standards essential patents (SEPs), wireless technologies, industrial systems, and more. Flaster attorneys have also served as appeal counsel for clients before the Court of Appeals for the Federal Circuit.

We also have experience representing pharmaceutical companies in complex abbreviated new drug application (ANDA) cases both on behalf of pharmaceutical developers and new manufacturers. Given the interplay of federal drug regulations and U.S. patent law in these complex litigations, Flaster Greenberg is ideally suited to bring the knowledge and experience necessary to achieve a positive result in an efficient and responsive manner.

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When it comes to patent infringement, Flaster Greenberg understands that infringement suits brought by non-practicing entities are different than most types of litigation and that these suits have to be managed accordingly. Our track record in successfully defending these types of suits in an economic way having nothing paid to those bringing such suits is unparalleled. We approach every patent case with a fresh perspective and develop unique and situation-specific strategies to gain the leverage necessary to obtain cost-effective outcomes.

Recent Representative Matters

- Defending client against trade secret misappropriation claims and motion for preliminary injunction.
- Defending clients against patent infringement claims brought in the International Trade Commission.
- Defending clients sued for patent infringement in Florida, Illinois, Pennsylvania, California, and Texas.
- Assistance in the evaluation of new inventions, inventorship, ownership and related issues for new inventions.
- Preparation and prosecution of patent applications in the biotechnological, business method, chemical, chemical engineering, electrical, mechanical, and software areas, both in the U.S. and foreign countries with a focus on securing strong patent coverage.
- Representation in the litigation of utility and design patent infringement, inventorship disputes, and related patent cases, including appellate proceedings before state and federal appellate courts.
- Representation in governmental proceedings involving patents, including interference proceedings, reissue filings, inter parte and ex parte reexamination proceedings, and related appellate proceedings before the Board of Patent Appeals and Interferences and Court of Appeals for the Federal Circuit.
- Evaluation, creation, and negotiation of agreements related to patents, technology transfer, and research and development.
- Assessment of client and third-party patents through intellectual property audits and ongoing portfolio management and counseling.

The team has more than 60 years of combined experience practicing patent law and individually and collectively serve as our client's most trusted advisors for high quality patent procurement, licensing support, and strategic counseling.