

INTELLECTUAL PROPERTY

This brochure may be attorney advertising.

INTELLECTUAL PROPERTY

Stroock's Intellectual Property Department is a full service, cradle-to-grave intellectual property department, which handles all aspects of patent, trademark, copyright, licensing and trade secret law to service any intellectual property needs a client may have in any technology or business. Stroock's intellectual property attorneys use their broad experience in science, technology and business to provide comprehensive, creative and practical solutions to all manner of intellectual property and technology issues.

Combining the depth of an intellectual property boutique with the resources of a national law firm, Stroock advises clients on all aspects of U.S. and international intellectual property law, including:

- Litigation before state and federal courts, the U.S. International Trade Commission and the U.S. Patent and Trademark Office;
- Patent, trademark and copyright counseling, procurement and enforcement;
- Trade secrets;
- Licensing and other IP related transactions;
- Professional services agreements, including software development, consulting and outsourcing agreements;
- Technology transfer, joint venture and distribution agreements; and
- Intellectual property due diligence and valuation.

Protecting intellectual property requires both legal expertise and a strong understanding of technology and business issues. Our attorneys and scientific advisors are engineers and scientists with backgrounds including electrical engineering, computer science, chemical engineering, and the life sciences, and can advise clients on all technology disciplines. As authors and frequent lecturers in their fields of expertise, our intellectual property attorneys are informed of the latest legal advances impacting a broad range of technologies. By under-

standing these developments, Stroock's intellectual property attorneys help clients anticipate challenges and capitalize on opportunities that could affect strategic business goals.

We often merge our intellectual property services with Stroock's traditional strengths in investment banking, venture capital, and structured and corporate finance to help clients realize the true value of their intellectual property and achieve their business goals. Our attorneys' business acumen, technical backgrounds and courtroom experience give Stroock clients an edge in developing, protecting and monetizing their intellectual property assets.

Stroock's intellectual property clients range from individual inventors and emerging businesses to large domestic and multinational corporations. We represent companies whose businesses center on high-technology innovations, as well as traditional businesses with little or no technology. Client industries include electronics, computer software and hardware, telecommunications, semiconductors, pharmaceuticals, chemicals, biotechnology, medical devices, optics, financial services and trading, consumer products, food products, refining, manufacturing, textiles, fashion, publishing, digital rights management, entertainment, multimedia, retailing and a variety of service industries.

REPRESENTATIVE CLIENTS:

Axis Technology	Hamilton-Thorne Biosciences, Inc.
Biomedic Data Systems, Inc.	Hanger Orthopedic Group, Inc.
C2 Communications	The Hartz Mountain Corporation
Digital Angel Corp.	Hess Energy Trading Co.
Eco Chemical Corp.	Host Pharmaceuticals, Inc.
EMCOR Group, Inc.	HSBC Bank USA
Entrepreneur Media Inc.	Immunostics, Inc.
Estee Lauder Companies, Inc.	Interactive Brokers Group, Inc.
Evolution Markets, LLC	Intercast Europe S.p.A.
Eye Eco, Inc.	JPMorgan Chase
FUJIFILM Corporation	Kaonetics Technologies, Inc.
FUJIFILM North America	Kaz, Inc.
GIGABYTE Technology	Klausner Technologies
Goldman Sachs Group, Inc.	Lab Products, Inc.
Goodrich Corporation	LG Household & Health Care Ltd.

Stroock enforces its clients'
patents, copyrights and trademarks
before State and Federal Courts, the U.S.
Patent and Trademark Office and the
International Trade Commission.

Lord & Taylor LLC	Ringling Bros.-Barnum & Bailey Combined Shows, Inc.
LS Cable Ltd.	Rudolf Wild GmbH & Co. KG
LS Mtron	Schindler Elevator
Mark IV Industries	Seiko Holdings Corporation
Marubeni America Corporation	Seiko Epson Corporation
MBF Index Holdings Inc.	Selas Corporation Of America
MetLife	Speco Technologies
Mitsui Sumitomo Insurance	Summit VetPharm
Mirror Worlds LLC	Synthes, Inc.
New York-Presbyterian Hospital	Systemax, Inc.
The Newark Group, Inc.	Thales
Nomura Securities International, Inc.	TradeWeb LLC
Oneac Corporation	University of California
PPG Industries, Inc.	Wexco Industries, Inc.
Prudential Securities Credit Corp LLC	W. F Taylor, Inc.
Revlon Consumer Products, Inc.	WILD Flavors, Inc.
Richards Manufacturing, Inc.	

PROTECTING AND DEFENDING OUR CLIENTS' INTELLECTUAL PROPERTY RIGHTS

To maintain competitive advantages in the marketplace, clients rely on Stroock for its record of enforcing and defending their intellectual property rights. Stroock counsels individuals and corporate entities, as plaintiffs or defendants, involved in disputes over patent, trademark, copyright, and other intellectual property rights before state and federal courts, the U.S. Patent and Trademark Office and the U.S. International Trade Commission (ITC).

Fujifilm Corporation (Fuji) has been a longstanding client that has used Stroock to protect its patent rights as well as defend them.

Enforcing Fuji's Single-Use Camera Patents

Fuji needed our patent expertise in multiple venues to protect its single-use camera market against patent infringement by a host of foreign and domestic competitors. Following a two-week hearing and other proceedings, Stroock convinced the ITC to hold that every single-use camera at issue, whether refurbished or newly made by all 26 accused parties, infringed a number of Fuji's patents. The ITC granted Fuji a General Exclusion Order and Cease and Desist Orders barring the importation of infringing single-use cameras into the U.S. and directing Customs to police those Orders. Stroock successfully defended the appeal of the ITC's decision before the Court of Appeals for the Federal Circuit.

On the heels of its success before the ITC, Stroock then brought a patent infringement action for damages against the largest respondent in the ITC proceeding, Jazz Photo Corp. (Jazz). Stroock successfully obtained a judgment of almost \$30 million against Jazz, its Hong Kong subsidiary and founder, Jack C. Benun. Stroock successfully defended this judgment on appeal and prevented Benun from discharging a portion of it in bankruptcy.

When Benun and Jazz continued infringing Fuji's patents under the protection of the District Court, Stroock successfully brought an enforcement proceeding in the ITC that resulted in the assessment of \$13.675 million in civil penalties against Benun and Jazz— by far the largest civil penalty in the history of the ITC. And when Benun continued to infringe through a new company, Stroock obtained another judgment of over \$16 million against Benun and his new company, and a finding of willful infringement.

Stroock also successfully enforced the ITC's Orders against a new breed of single-use cameras developed in an attempt to evade Customs' enforcement of the ITC's Orders, resulting in the issuance of additional Cease and Desist Orders and collective penalties of over \$2 million against Fuji's competitors.

Defending Fuji Against Claims of Patent Infringement

When Honeywell brought a suit against Fuji and 24 defendants claiming infringement of its liquid crystal display (LCD) patent, Fuji turned to Stroock to defend itself against Honeywell's allegation that Fuji's digital cameras infringed Honeywell's patent.

Stroock was instrumental in uncovering evidence that Honeywell had offered the patented invention for sale more than a year prior to the application date. After the vast majority of the defendants settled, Fuji and the remaining co-defendant successfully moved for summary judgment that the Honeywell patent was invalid.

MANAGING COMPLEX LITIGATION WITH TECHNOLOGY

Stroock employs state-of-the-art computer and multimedia systems to provide our clients with the best possible representation throughout the entire litigation process. Attorneys, legal assistants and other support staff, skilled in computerized research methods and the Internet, are also trained to use specialized patent, trademark, medical and other scientific and technical databases.

Using Stroock's electronic litigation support system, attorneys and paralegals can quickly search deposition or trial transcripts for specific testimony, digitally image and archive graphical and physical exhibits for quick retrieval at deposition or trial, optically scan, store and organize discovery documents, and maintain digital versions of recorded testimony—all in a highly efficient and cost effective manner. Indeed, virtually an entire case file can be carried along with an attorney anytime, anywhere, on a standard laptop computer.

Clients also benefit from our document imaging and management technology. After years of providing our clients with their own CD-ROM versions of optically scanned document files, Stroock has employed a secure web server that allows clients to access, review, and perform multiple searches on these digitized documents, as well as pertinent pleadings, depositions, memoranda, and other such trial material as the client may be permitted to view. Clients can also add comments to this database, which can then be utilized by Stroock attorneys and paralegals in the management of their cases. The software program provides clients with real time access from anywhere in the world utilizing state-of-the-art security features to ensure confidentiality.

Additionally, our attorneys can access the database whenever they are traveling out of the office. Using this highly secure technology fosters enhanced communication between Stroock's intellectual property attorneys and clients around the world, while providing for more cost-effective litigation.

PATENT PROSECUTION AND COUNSELING

At Stroock, patent prosecution and counseling are at the core of the cradle-to-grave representation we enjoy providing to our clients to satisfy their complex legal needs in a broad spectrum of industries ranging from mechanical constructions, to complex biotechnology, to novelty items, to financial services, representing a range of clients from billion dollar companies to solo inventors.

We commonly meet with our clients to discuss their new innovations, discuss strategies for patenting their innovations and avoiding the patents of third parties; we also help them navigate threats of infringement from third parties, how to contact potential infringers and the litigation or licensing necessary to deal with their competitors or non-practicing patent holders.

Through their professional work and multifaceted representations, our attorneys are experienced in a vast range of technical fields, including telecommunications, life sciences, civil, electrical, chemical and computer engineering, business methods, chemistry, computer science and networking, electronic media, mechanical devices, consumer products, electronic trading platforms, financial instruments, GPS and radio frequency identification, tracking and sensing systems, the Internet, medical devices, mechanical systems, medical telemetry, nanotechnology, optics, pharmaceuticals, and semiconductors. Their technical backgrounds, often gained through pertinent industry experience, are of particular benefit to clients who wish to develop market-focused intellectual property portfolios.

We are experts in all facets of U.S. and foreign patent prosecution and counseling, including:

- Preparing and filing utility and design patent applications in the U.S. and abroad;
- Interacting with U.S. Patent and Trademark Office Examiners;
- Reexaminations, both *ex parte* and *inter partes*;
- Litigating patent interferences before the U.S. Patent and Trademark Office;

Trademarks:

Industry Representations

Chemicals

Clothing

Cosmetics

E-Commerce

Entertainment

Financial Institutions

Food, Beverage and Restaurant Services

Gasoline and Lubricants

Health and Beauty Aids

Jewelry

Luggage

Pharmaceuticals

Publishing

Retail Establishments

Software

Textiles

- Filing and arguing appeals before the U.S. Patent and Trademark Office
- Licensing patents;
- Patent clearance and patentability recommendations; and
- patent litigation.

We also assist our clients with patent issues related to specific products, processes and business methods, rendering advice on validity and infringement, as well as counseling our clients on specific strategies for infringement avoidance, or “designing around” a competitor’s patent, to help get a product to market.

In addition to the creation of rights through patent prosecution, our patent attorneys are actively involved in litigating patent cases, both on behalf of clients asserting patent rights and those defending against charges of infringement. Stroock has particular experience litigating before the International Trade Commission, where a domestic patent owner seeks to protect its domestic market from infringing imports.

TRADEMARKS

Stroock counsels clients concerning trademarks, trade dress, trade names and domain names worldwide. We advise and represent clients on a variety of related matters, including litigating cases for both plaintiffs and defendants involving trademark and trade dress infringement, unfair competition, and false advertising in the United States and abroad. We assist clients with selecting, obtaining, and maintaining trademarks, developing branding strategies, licensing, and handling trademark oppositions before the U.S. Patent and Trademark Office. Clients receive expert advice in dealing with issues of dilution of famous marks, product copying, infringement avoidance, domain name disputes, and domain name and hyperlink usage.

With a range of experience in dealing with trademarks both in the U.S. and abroad, our intellectual property attorneys provide clients with counsel that often requires swift action to protect a client’s rights.

Seiko Corporation

Using the breadth of our expertise in New York, Los Angeles and Miami, Stroock represented Seiko Corporation in a counterfeiting action against an entity that was selling counterfeit Seiko brand watches and watch boxes in its stores in New York, Miami, Dallas and Los Angeles. We obtained a temporary injunction and a seizure order under the Federal Counterfeiting Act in the Southern District of Florida that directed the U.S. Marshals in New York, Miami, Dallas and Los Angeles to accompany Seiko's attorneys in seizing counterfeit watches in all four cities. The quick action of Stroock's lawyers around the country resulted in the seizure of tens of thousands of counterfeit watches and the identification of the offending suppliers of counterfeit goods.

The identification of the suppliers of counterfeit watches enabled Stroock to cut off the counterfeit goods at their sources by commencing a series of actions against the suppliers. Many of the suppliers agreed to cease selling the counterfeit goods after the lawsuits were commenced; however, one entity denied involvement in counterfeiting and refused to agree to cease selling counterfeit watches. After a trial in federal court, Stroock attorneys succeeded in obtaining a finding that the testimony of the supplier lacked credibility and a permanent injunction against that supplier was entered.

COPYRIGHT LAW

Stroock provides advice on issues concerning all matters of copyrighted works. Our attorneys enforce and defend our clients' copyrights in the United States and abroad, as well as defend their rights against claims of copyright infringement. We counsel clients on licensing and a broad array of issues relating to third party copyright claims.

Our lawyers are experienced in copyright law as it relates to the Internet, software and database protection, as well as traditional subject matter. We monitor copyright developments, advise clients on copyright compliance and business transactions, and actively litigate copyright issues.

Kanebridge Corporation

In a case that drew the attention of the Department of Justice, the Copyright Office, and the Patent and Trademark Office, Stroock's intellectual property attorneys won an appeal before the U.S. Court of Appeals for the Third Circuit, sitting en banc, for our client, Kanebridge Corporation.

Kanebridge, a master distributor of after-market computer parts, advertised its parts as alternatives to the plaintiff's parts by cross-referencing its part numbers to those of the

plaintiff. The plaintiff argued that by copying its part numbers, Kanebridge infringed the plaintiff's part number copyrights. Blurring the line between patent protection and copyright protection, the plaintiff convinced the district court that originality existed in the plaintiff's part numbering methodology and therefore in the part numbers that resulted from application of this methodology.

By educating the court on the distinction between patent and copyright protection, and establishing that the part numbers were not original but merely the result of mechanical application of the plaintiff's part numbering methodology, Stroock obtained a ruling from the Third Circuit that the part numbers failed to have the requisite originality.

On remand, the district court granted Stroock's motion for summary judgment based on the appellate ruling. The plaintiff appealed the grant of summary judgment and, by reverting to its old strategy of blurring the line between copyright and patent protection, convinced a different appellate panel to remand the case for further proceedings. In an effort to save the client from a costly remand, Stroock petitioned for, and obtained, a rehearing by the Third Circuit, en banc – a rarely obtained victory itself. Following an en banc reargument, the Third Circuit issued a 40-page precedential opinion affirming the grant of summary judgment in favor of Kanebridge. The opinion provides the legal support for our client to vigorously advertise its after-market alternative parts by cross-referencing those of competitors.

LICENSING AND OTHER TRANSACTIONS

For many of our clients, intellectual property represents their most valued asset and an important share of their net worth. Consistent with our multifaceted legal-business-technology approach to counseling, we advise our clients not only on structuring and documenting strategic alliances, mergers and acquisitions, and research and development investments, but also on the proper valuation of relevant intellectual property assets. Stroock clients also receive thorough counsel on the licensing of patents, trademarks and copyrights, the monitoring of licensing arrangements, and the negotiation of technology transfer, research and development agreements.

Our attorneys' technical knowledge and industry experience enables them to understand the most sophisticated licensing matters and transactions. This includes advising companies on the treatment and valuation of intellectual property licenses when forming, operating, financing and selling their businesses.

Stroock's intellectual property attorneys counsel clients on licensing and a broad array of issues relating to third party copyright claims.

Hamilton-Thorne Biosciences, Inc.

Protecting a client's intellectual property rights is only part of the equation. For biotech companies like Hamilton-Thorne Biosciences, obtaining the right strategic partnerships are often just as critical. Stroock's intellectual property attorneys worked with Hamilton-Thorne Biosciences to develop a portfolio, the client proceeded to find the right partner and we were there to help.

Stroock's Intellectual Property Group, in cooperation with the firm's corporate finance attorneys, has represented Hamilton-Thorne Biosciences in obtaining venture capital financing, developing a strategic partnering program with other intellectual property developers. Stroock's intellectual property attorneys have negotiated worldwide licensing and sponsored research agreements with universities and medical facilities to assist Hamilton-Thorne in the development of its patent estate.

TRADE SECRETS

Stroock advises clients on confidentiality and trade secret matters, including employment, consulting, non-competition and assignment agreements. Our intellectual property, litigation, and employment attorneys have extensive experience representing parties in disputes involving alleged trade secret misappropriation and breaches of confidentiality agreements.

NMB Technology

Trade secret and confidential information are often at the core of a company's business. It gives the company an advantage in the marketplace, but public disclosure can be detrimental to its business. When an employee with access to confidential information resigns or is terminated, the company's confidential information is perhaps at its most vulnerable.

This was the case at Stroock's longtime client NMB Technology. NMB discovered the misappropriation when it began receiving e-mails from its competitors alerting it to the fact that a third party had e-mailed them confidential documents. NMB knew that it had a serious situation on its hands. NMB turned to the attorneys in Stroock's Litigation and Intellectual Property Groups to help them identify the person(s) responsible for the misappropriation and to craft a strategy for ensuring that all of the disseminated trade secret and confidential information was properly returned or destroyed.

The job of identifying the person(s) responsible for the misappropriation was made more difficult because the person had created an e-mail account for the sole purpose of masking his/her identity. However, Stroock's intellectual property attorneys, experienced in Internet technologies, used information embedded in the e-mails to deter-

Legal Expertise, Technical Experience

Biotechnology

Business Methods

Chemistry

Computer Science and Networking

Electronic Media

Electronic Trading Platforms

Financial Instruments

GPS Location and Condition Systems

The Internet

Mechanical Systems

Medical Devices

Medical Telemetry

Nanotechnology

Optics

Pharmaceuticals

Radio Frequency Identification Products

Semiconductors

Telecommunications

mine the exact computer used to transfer the confidential information. With this information in hand only hours after the e-mails had been sent, Stroock was able to file an action against an unknown third party - a "John Doe action" - and obtain expedited discovery of the entity where the computer used to send the confidential information resided - in this case, a library at a university. By obtaining such discovery, Stroock was able to determine the identity of the user logged into the computer at the time the e-mails were transmitted. On Stroock's advice, NMB then engaged a computer forensic science firm to analyze the university computer for any additional information that would aid in assessing the breadth of the misappropriation.

Based on the information obtained by Stroock, both through its own forensic efforts and through third party discovery, the client was able to hand the case to the FBI for a criminal investigation.

PROFESSIONAL AND TECHNICAL EXPERTISE

The expertise of our attorneys is as comprehensive as the range of clients we represent. Stroock's Intellectual Property Group consists of outstanding legal professionals with consummate technical credentials. Our attorneys and technical advisors have served as engineers, product managers, computer analysts, developers, systems technicians and scientists for companies such as Thales, GE Capital, Wang Laboratories, Northrop, Olympus America and FMC Corp. One of our intellectual property partners served as a Patent Examiner for the U.S. Patent and Trademark Office.

When we're not winning cases for our clients, our attorneys and technical advisors are often authoring articles for U.S. and international publications, as well as lecturing for organizations ranging from the Practising Law Institute, the International Trademark Association, the Legal Aid Society, bar associations and universities, to Stroock's own accredited Continuing Legal Education program.

OUR INDUSTRY INVOLVEMENT

Our attorneys have published on pharmaceutical and biotech patent litigation, lectured before the Society for Biomolecular Sciences, the New York Biotech Association, Harvard University's Academic and Industrial Approaches to HTS & Drug Discovery Conference, ACI's Biotech Patents Conference, the Life Sciences IP Due Diligence Forum and the National Forum on Preventing and Defending Pharmaceutical and Biotech Patent Litigation and regularly attended industry conferences and meetings.

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