

Intellectual Property

Clients from many industries entrust their intellectual property (“IP”) matters to the highly qualified lawyers at Goulston & Storrs. Our clients want smart and savvy counsel that can help them protect and leverage the value of their IP assets, which are competitively critical to their enterprises.

Our IP team includes advocates who have acted as outside General Counsel to life science and technology companies, served in leadership positions in bar association IP groups, lectured on IP matters at law schools and legal conferences, and worked in a university technology licensing office.

We offer to clients a unique blend of scholarly understanding of the law and real world experience in dealing with IP issues arising from multiple diverse situations and industries. We also deal with all kinds of IP matters, including but not limited to: patents, copyrights, trademarks, domain names, rights of publicity and privacy, and strategies for development, transfer and licensing of IP assets.

Our team is also particularly experienced at dealing with IP issues arising from or associated with non-profit endeavors, including those associated with hospitals, universities, museums and other large institutions.

This combination of experiences gives our IP team a unique and valuable perspective in assisting clients to develop and execute their IP strategies.

We also place a special emphasis on adding value to our clients, and we give each and every matter the specialized attention it deserves while focusing on responsiveness, efficiency and results.

Representative Matters

\$50M Multi-Site Community Service Organization Acquisitions and Dispositions

Representation of a \$50M multi-site community service organization for all significant information technology acquisitions and development projects, including a series of multi-million dollar enterprise software and technology contracts with ADP and Oracle.

Asset Manager Portfolio of Hotels and Resorts Intellectual Property Protection

Representation of asset manager of portfolio of first class U.S. hotels and resorts in connection with intellectual property protection and licensing matters.

Heirs of Famous Author/Illustrator Rights to Copyrights

Represented heirs to famous author/illustrator in settlement of dispute over rights to copyrights in decedent’s works.

International Trademark and Business Model Licensing Strategy for Non-Profit

Developed and implemented an international trademark and business model licensing strategy for a New York-based non-profit organization engaged in promoting entrepreneurship through affiliates in Africa, the Middle East, Europe, the U.S., and Central and South America.

Manufacturer of Microwave Technology Treatment Systems

Represented manufacturer of microwave oven technology in collaboration with a clean coal technology company to design, develop, manufacture, and license coal treatment systems.

Non-Profit Teaching and Research Hospital Agreements

Representation of a major group of non-profit teaching and research hospitals in technology license agreements, collaboration agreements, and sponsored research agreements.

Retailers Brand Protection and Licensing Programs

Representing retailers of clothing, shoes, and accessories in connection with brand protection and licensing programs, e-commerce agreements, and various strategic ventures.

Software Vendors and Purchases Agreements

Advise software vendors and purchasers with regard to license agreements, services agreements, ASP/SaaS agreements, and website development and hosting agreements.

Trademark and Trade Dress Rights for Medical Devices

Representation of client in successfully enforcing the valuable trademark and trade dress rights associated with its medical devices.

Consortium Funding Agreement for International Medical Research

Crafted a new consortium funding agreement template for French research institute to fund transatlantic research in the areas of cardiovascular and neurovascular disease.

Formed and Represented Spin Out Company in Licensing of Medical Treatments

Formed and represented a university spin-out company to license founder's therapeutic treatments for cataracts and dry eye from founder's Nebraska-based medical center.

Master Service Agreement for Technology Company

Represented an online courseware developer entering into a \$10M deal to provide entire K-12 curriculum to a non-profit education center.

Research, Licensing and Technology Transfer Counsel to Medical and Educational Institutions

Provide ongoing research, licensing and technology transfer counsel to academic medical centers, research institutions, and universities, advising on deals valued from thousands of dollars to over a hundred million dollars.

For-Profit Medical Journal Lifecycle

Represented a for-profit medical journal over its entire five-year lifecycle. The representation included the initial formation of a joint venture to launch the journal, the withdrawal of a co-founding partner, numerous personnel and operational matters, and the eventual sale of the journal assets to a non-profit academic consortium.

International Non-Profit Organization Intellectual Property Agreements

Represented an international non-profit organization in a regional intellectual property ownership and licensing agreement with another international non-profit. The project required establishing the scope of certain jointly owned rights based on collaborative work in one country and negotiating ground rules for each party to make independent use of that intellectual property and modified versions thereof in other territories.

Owners and Managers of Real Estate in Agreements for Artwork

Represent owners and managers of real estate in agreements to commission, license, or borrow public art, including original sculptures, murals, and other two- and three-dimensional artworks. Recent transactions have involved artworks installed in the Fenway, Seaport, and Back Bay districts of Boston and installations in three different locations on Boston's Greenway.

Purchasers Software Development, Customization, and Licensing Transactions

Represent a wide range of purchasers in connection with software development, customization, and licensing transactions to support their business operations. Recent transactions have included the acquisition of rights to use cloud-based software and services for purposes such as accounting systems, telecommunication systems, investment management systems, tenant management systems, and web sites and e-commerce. Many of these transactions require particular sensitivity to the protection of personally identifiable information of the client and its customers and the vendor's compliance with applicable data protection laws.

Trademark and Domain Name Matters

Handled and supervised numerous trademark and domain name matters over the past 20 years, including prosecution of applications to register trademarks in the United States, coordination of international trademark protection efforts, management of clients' trademark portfolios, negotiation of assignments and licenses of trademarks and domain names, and counseling of clients with regard to trademark and domain name selection, registration, and disputes. Trademark portfolios under management at various times have covered over 1,000 trademarks for hundreds of different clients.

Women's Apparel Company Intellectual Property Issues

Represented a women's apparel company in brand protection, copyright advice, category licensing, its e-commerce fulfillment agreement, and the eventual sale of its intellectual property and other assets. The sale and license transactions were with one of the client's licensees, which had purchased the client's debt and was able to use that control as leverage in negotiations. Nonetheless, the Goulston & Storrs team was able to secure licenses back from the purchaser and save the client's core business.

Our Service Difference

Our IP team uses an interdisciplinary approach drawing upon the expertise of IP lawyers in our business and IP Litigation groups. Our business lawyers focus on the identification and protection of our clients' intangible assets and assist our clients in structuring, negotiating and documenting transactions involving those valuable assets. Our IP litigators focus on enforcing and defending our clients' intellectual property rights.

Frequently, we blend the skills and experiences of both business lawyers and litigators to achieve our clients' objectives with regard to protection and leveraging of IP assets, as well as resolution of disputes in or out of courts and other forums. We also examine and account for the tax ramifications of IP transactions.

We give each case the individualized attention it deserves, focusing on responsiveness, efficiency and results. Our lawyers make particular efforts to understand the business context in which IP decisions must be made, paying attention to each client's business, IP strategy and industry concerns.

We understand and appreciate that our clients are entrusting us with some of their most valuable assets, most significant transactions, and most challenging disputes. By working collaboratively with our clients and colleagues to ensure that we take a holistic and pragmatic approach to the IP matter at hand, we strive to achieve our clients' goals as efficiently and effectively as possible.

Our Clients

Goulston & Storrs provides intellectual property advice to a wide array of clients, including multi-national corporations, universities and hospitals, individual entrepreneurs, authors, and artists, investors and lenders, small businesses, established and emerging companies, private and public companies, private equity funds and nonprofit organizations, including research hospitals and educational institutions.

Our clients, both foreign and domestic, cover a wide range of industries, including retail, fashion, real estate, banking, venture capital, private equity, healthcare, education, music and entertainment, pharmaceuticals and medical devices, telecommunications, and computer technology.

Our Experience

The IP legal team at Goulston & Storrs handles a broad range of IP matters. Some of the work, such as trademark clearance research and filings, or the negotiation of licenses to software and software services, is frequently recurring and common to a well-developed IP practice.

But our IP team also has experience in less common IP matters such as public art installations, publishing agreements, unusual technologies, and providing advice to foreign businesses with established IP portfolios abroad seeking to enter the U.S. market.

Our intellectual property practice has extensive expertise and experience virtually all areas of IP, including:

- Trademarks, trade dress and domain names
- Patents and design patents
- Trade Secrets
- Copyrights
- Publicity and Privacy Rights
- IP Strategies and Development
- IP Due Diligence
- Transfers and Licensing

Our team also handles the resolution of IP disputes through mediation, arbitration, and litigation. For more information about these IP dispute resolution services, check out the section of our website dedicated to "Intellectual Property Litigation"

Trademarks, Trade Dress and Domain Names

The goodwill of a company is inextricably tied to the strength of its brand and, as a result, a company's trademark or trade dress is frequently its most valuable asset. Our lawyers assist clients with all aspects of branding, ranging from adopting new trademarks, trade dress and domain names, to securing trademark registrations, to policing the marketplace, to resolving conflicts between brand owners.

Goulston & Storrs maintains a substantial trademark prosecution practice before the U.S. Patent and Trademark Office and is currently managing and developing both U.S. and international trademark portfolios for clients in a wide range of industries. From trademark clearance searches, to trademark prosecution and proceedings before the Trademark Trial and Appeal Board, we successfully secure the strongest and broadest brand protection possible for our clients. We also work closely with clients to develop, maintain and protect their web presence through the acquisition and protection of domain names, including counseling clients in connection with new generic top level domains.

Furthermore, we handle trademark and domain name disputes for a wide range of clients, ranging from Fortune 500 companies, international retailers and famous brand owners, to start-up companies, nonprofits and entrepreneurs. Goulston & Storrs has experience litigating trademark disputes in state and federal courts around the country and before the Trademark Trial and Appeal Board, as well as engaging in alternative dispute resolution processes, including mediations, arbitrations, and proceedings under the Uniform Domain Name Dispute Resolution Policy (UDRP).

Patents

Assessing the value of both utility and design patents, highly qualified members of our team work closely with clients to navigate the complex patent landscape and to develop strategies that take full advantage of the patent statutory schemes.

Combining the expertise of our business and IP groups, we assist clients with due diligence research into the patent portfolios of clients, prospective business acquisitions and competitors. Our team develops patent acquisition and licensing strategies that assist with the growth of our clients and works to nurture the development of joint venture and venture capital relationships through the licensing, assignment or acquisition of patent rights.

Our corporate lawyers and litigators work collaboratively to assert our clients' patent rights, as well as to protect our clients from claims of patent infringement in a broad range of business contexts involving healthcare, medical devices, pharmaceuticals, technology, manufacturing, retail, real estate, banking, venture capital, private equity, consulting and other fields of enterprise.

From less complex design patents to more complex mechanical, software and pharmaceutical technologies, our team works closely with clients to effectively and efficiently compete in the complex patent landscape.

Trade Secrets

The protection of a trade secret requires, first and foremost, secrecy. Our team works closely with clients to develop strategies and protocols for protecting a company's trade secrets, including the creation of internal procedures for protecting proprietary information, negotiating and preparing non-disclosure agreements, and drafting agreements with employees, consultants, and independent contractors that carefully identify, define and explain an individual's responsibility for preserving the company's trade secrets.

We counsel clients regarding trade secret issues involving mechanical and medical devices, computer code, systems, business and manufacturing methods, and client and customer lists. Our team advises clients how best to preserve and leverage their proprietary information, and how to

choose between the pursuit of patent protection or the preservation of secrecy and know-how through tight control of information without publication.

When the need arises, as often happens when employees leave a company to work for a competitor, our IP litigation and employment lawyers take appropriate enforcement action to protect the valuable trade secrets of our clients. Navigating each state's trade secret-related statutes and federal laws such as the Federal Computer Fraud and Abuse Act, as well as monitoring pending federal and state legislation relating to misappropriation of trade secrets, we ensure that our clients' valuable trade secrets remain safe and proprietary.

Copyright Law

We have handled matters and counseled clients regarding copyright protection for original designs in the retail and fashion industries, as well as original works of authorship such as books, articles, web content, business manuals, dramatic works, photographs, business-related films, architectural and other drawings, artistic works and computer software. Our team assists clients with all aspects of copyright protection and commercialization, facilitating the acquisition of rights in copyrightable works, licensing such works to others, and enforcing and defending copyrights.

With the ever-expanding use of the internet, we also work closely with clients to protect their copyrighted material from online abuse through various approaches, including through litigation or the use of non-litigation tools provided by the Digital Millennium Copyright Act. When necessary, our lawyers expertly help clients to navigate around or acquire rights in the copyrights of others to avoid expensive confrontations in court.

Publicity and Privacy Rights

We have worked with clients such as authors, artists, sponsors, retailers, property owners, and government agencies on matters involving rights of publicity and privacy, dealing with issues related to the use of a person's name, image, and likeness. Some of the contexts in which we have counseled clients on these rights have involved advertising, films, and art installations.

Intellectual Property Strategies

We also help clients to craft and implement cost-effective intellectual property strategies, enabling them to identify valuable IP of their own or of others, acquire and protect such IP, periodically audit their own IP portfolios and exploit the value of their IP. In doing so, we strive to balance the level of

investment in IP assets with the return on that investment, and we work with our clients to develop realistic, practical budgets for these efforts.

Transfers and Licensing

Our lawyers also help businesses maximize the value of their own intellectual property and acquire rights in the intellectual property of others. We accomplish these objectives through so-called out-licenses, in-licenses and outright transfers, often as part of larger business agreements. By helping clients with the transfer and licensing of technology and other IP assets, we often enable them to grow their revenue substantially and turn their legal function into a profit center instead of a cost center.

False Advertising and Unfair Competition

The way competitors conduct business can significantly impact the ability to compete in the marketplace, especially when it involves confusion as to the source or branding of products. When competitors overstep their bounds by engaging in false or misleading advertising to customers and potential customers, the goodwill, reputation and profits of a company can suffer significant harm.

We help our clients to combat false advertising and unfair competition tactics. We also work closely with clients to ensure that they are carefully advertising themselves and engaging with others in compliance with federal and state statutes so as to avoid unnecessary disputes.

Apart from the federal Lanham Act, which offers protections against false advertising, each state has various forms of false advertising and unfair competition laws that companies must keep in mind when engaging in commerce, and we can help our clients in using these laws to their advantage. A common misconception is that there must be an underlying patent or trademark in a claim of false advertising or unfair competition, but the law often protects against the misappropriation of the value of a company's business even when traditional forms of intellectual property are not involved. Therefore, we can help many clients who do not have patent or trademark protection.