

# PATENT PROSECUTION

Hodgson Russ attorneys work with Fortune 500 companies, universities, startups, and individuals to secure protection for their ideas and inventions. We provide comprehensive advice relating to obtaining patent protection for our clients' technologies at the U.S. Patent and Trademark Office and globally in collaboration with a network of patent attorneys in all major countries.

Our attorneys guide clients through the decision whether to file for a patent, including:

- Initial discussion and review of the technology
- Execution and analysis of prior art searches
- Evaluation of patentability

We prepare and prosecute patent applications before the U.S. Patent and Trademark Office. This includes:

- Drafting utility and design patent applications with claims tailored for the client's existing products and future commercial strategy
- Analyzing and responding to office actions
- Conducting interviews with patent examiners to accelerate prosecution
- Filing divisional and continuation applications to expand coverage
- Appealing adverse decisions to the Patent Trial and Appeal Board
- Coordinating patent prosecution to maximize coverage while strengthening the client's intellectual property strategy

We assist clients with post-issuances proceedings, license agreements, and technology transfers. Additionally, our attorneys assist clients with freedom-to-operate searches and opinions, infringement and validity opinions, and design-around strategies. We also actively advise clients on strategies related to the development and management of global intellectual property portfolios.

Our patent attorneys have degrees in engineering, chemistry, and the biological sciences, with many holding advanced degrees. Most of our attorneys have experience working in academia or industry, in fields that include software, energy, semiconductors, microelectronics, manufacturing, plastics, information technology, automotive, nanotechnology, chemicals, and life sciences.

## Contact

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## Professionals

### Attorneys

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### Registered Patent Agents

Rachel Watt

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We approach complex multi-discipline technologies as a team by bringing together attorneys with relevant technical backgrounds. Our depth and breadth of technical knowledge make Hodgson Russ an attractive firm for clients seeking protection for their technologies—whether simple or complex.

We regularly assist clients with:

- Prior art searches and reviews
  - Patent mapping and identification of the applicable patent landscape
  - Patentability opinions
  - Identification of strategies for protecting inventions as patents or trade secrets
  - Preparation and prosecution of U.S. and foreign patent applications
  - Advice on recent case law as applied to patent strategy
  - Strategies for global protection of technologies, products, and innovations
  - Strategies for building strong and valuable patent portfolios
  - Freedom-to-operate opinions
  - Invalidity and non-infringement opinions
  - Patent workshops and seminars for executive staff, researchers, and engineers
- Hodgson Russ has been awarded a prestigious "Best Law Firms" Metropolitan Tier 1 ranking by *Best Lawyers/U.S. News & World Report* in the Patent Law category.

## Experience

Hodgson Russ intellectual property attorneys have substantial experience in patent reexaminations and have been working on an *inter partes* patent reexamination matter related to a business method patent that involves a parallel patent litigation, with which our IP attorneys are also assisting.

Hodgson Russ defended two banks from patent infringement allegations by non-practicing entities. Our attorneys analyzed the patents for invalidity and non-infringement. Based on this analysis, our clients negotiated favorable settlements.

For a Canadian client interested in bringing a known consumable food additive into the United States, a Hodgson Russ intellectual property team evaluated a large number of relevant patents related to the process of preparation of that additive. The team then provided a freedom-to-operate opinion, based on which the client was able to proceed with its plans for preparing the product in Canada and bringing it into the United States for sale.

Hodgson Russ attorneys routinely provide patent-related opinions, including patentability, non-infringement, and freedom-to-operate analysis. For one client, we provided significant guidance involving freedom-to-operate analysis, which resulted in the client engaging in new product development in the biotech area.

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Hodgson Russ intellectual property attorneys manage a large and growing medical device patent portfolio for a designers and developer of medical products. The portfolio includes patents and patent applications in Europe, Asia, South America, and the Middle East.

Obtained a preliminary injunction in the SDNY against an infringer that infringed upon our client's trademarks, copyrights and patents. Our client is a furniture designer that decorated the Green Room at the Oscars.

A Hodgson Russ intellectual property team of attorneys evaluated several relevant patents for a new product developed for the food industry. Based upon this, our attorneys provided a freedom-to-operate opinion that allowed the client to move forward with development of the new product for the market without requiring any license from patent holders.

Hodgson Russ intellectual property attorneys handle U.S. patent and trademark filings for a well-known German manufacturer of microscopes and related systems. The relationship is now more than two decades old.

## In the News

Hodgson Russ Team Wins Dismissal of Patent Case  
April 2023

Why Tesla Is Taking a Big Risk by Opening Up Its Patents  
LXBN TV, July 23, 2014

## Press Releases

71 Hodgson Russ Attorneys Ranked in 2023 Edition of *Best Lawyers in America*  
*Hodgson Russ Press Release*, August 19, 2022

Hodgson Russ Receives Top Tier National and Metropolitan Rankings in 2022 Best Law Firms Listings  
*Hodgson Russ Press Release*, November 15, 2021

Hodgson Russ Earns Five National-Level Rankings in *U.S. News & World Report/Best Lawyers 'Best Law Firms' Report*  
*Press Release*, November 18, 2015

## Publications

A Silver Lining for Software Patents  
*Intellectual Property & Technology Alert*, October 17, 2016

Supreme Court Raises Bar for Patents in KSR  
*Buffalo Law Journal*, May 31, 2007

PATENT PROSECUTION

**Presentations & Events**

Intellectual Property Protection & Enforcement: Protecting Your Most Valuable Assets  
Hodgson Russ, 140 Pearl Street, Buffalo, NY 14202, October 12, 2023

Buffalo Niagara Manufacturing Alliance Lunch and Learn  
September 26, 2023

Legal Update for Colleges and Universities  
New York, NY, October 24, 2012

Update: America Invents Act  
New York, NY, February 7, 2012

*In re Bilski's* Impact on Patent Protection  
Buffalo, NY, September 2, 2010