

# Technology/ Intellectual Property Law

## Practice Areas

Copyrights

IP Audits and Legal Opinions

IP Due Diligence

IP Litigation

Inter Partes Reviews [IPRs]

IP Portfolio Management and  
Counseling

Patents

Technology Transactions

Trade Secrets

Trademarks

## CONTACT

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## We Know Technology.

At Munck Wilson Mandala, we represent clients around the world, protecting their ideas, inventions and business. Our attorneys have diverse and distinguished technical backgrounds. We are fluent in Mandarin Chinese, Korean, Japanese, German, Spanish, and other languages. Many of us have been working together for more than 20 years. As a team, we have well over 500 years of combined experience representing clients in patent preparation and prosecution, licensing, and litigation.

In addition to representing some of the more well-known names in technology, the Munck Wilson Mandala team also represents smaller companies who have disputes over patent infringement and trade secret matters. Because we understand your technology and business, we are better equipped to understand your challenges, work with your management and inventors and shape your IP strategies.

## Copyrights

### Your Original Works Of Authorship Are Among Your Most Valuable Assets.

We regularly advise clients on the registration, licensing, sale and protection of their creations. We also assist clients with their use of the copyrighted works of others.

Our copyright lawyers work with our trial lawyers to enforce our clients' copyrights and to defend our clients against infringement claims.

We represent clients in federal court, as well as in proceedings before administrative agencies such as the Copyright Office or U.S. Customs agencies.

We defend clients in assertions of copyright infringement by business and trade associations designed to advance the interests of software developers (e.g., Business Software Alliance), the recording industries (e.g., Recording Industry Association of America), movie studios (e.g., Motion Picture Association of America) and the like.

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## IP Audits and Legal Opinions

**Maximize Your IP Portfolio.** An IP audit involves a comprehensive review of your IP assets and the role of each individual asset in your company's business. It can help ensure that your IP assets are protected properly and that you are not violating third-party rights or violating applicable regulations. An IP audit also is a valuable step in the development of your IP portfolio.

The results of the audit can be used to identify technical challenges, potential acquisition candidates, or additional patentable inventions to enhance your portfolio. Importantly, the audit can help pinpoint multiple, often significant, additional revenue streams from your IP portfolio, such as opportunities to license or sell IP rights, or to pursue litigation against infringers of your IP.

Another way we help you maximize opportunities from your IP portfolio is through the provision of legal opinions for you or for third parties such as your lender or acquirer. We render patentability, right-to-use or practice, and non-infringement opinions relating to your products or methods.

## IP Due Diligence

If you are contemplating a commercial transaction, you need to have a thorough understanding of the value and risks associated with the transfer of your intangible assets.

In an acquisition, IP due diligence can enable a buyer to make an appropriate offer, negotiate a lower price, or cancel an undesirable deal before it's too late. A seller can determine whether it can deliver all of the rights the buyer wants to purchase, remedy chain of title issues, strengthen its IP portfolio if necessary, obtain necessary assignments, licenses or transition agreements, and appropriately tailor its representations, warranties and indemnification obligations in the purchase agreement.

At a more strategic level, our IP due diligence can help you understand how the applicable IP assets relate to your business objectives, the

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strength of your portfolio, and the IP positions of competitors.

In the IP due diligence arena, our ability to work with the world's most prominent businesses and law firms as both a peer and a pinch hitter makes us a valuable partner in high-tech matters.

## IP Litigation

Munck Wilson Mandala has a distinguished nationwide intellectual property (IP) litigation practice. As the editors of Chambers USA wrote, our firm is “especially well known for its expertise in IP disputes.” This expertise comes from our combination of high tech knowledge and experience and exceptional trial skills. By teaming our talented IP lawyers with our accomplished trial lawyers, we deliver focused, strategic, high value representation in a wide range of patent, trademark, copyright, trade secret and unfair competition matters. Because we bring years of technology experience to each matter, we are uniquely qualified to understand — and explain to the judge or jury — the complex technical issues involved in patent litigation and other sophisticated IP litigation matters.

Clients call on us in these high stakes, bet-the-company matters because we know how to try — and win — complex cases. We have the knowledge, skill and resources to effectively and efficiently handle any IP dispute, whether we are aggressively enforcing our clients' IP rights or defending our clients against patent infringement claims. Our seasoned trial lawyers have significant experience handling IP disputes in state or federal trial and appellate courts around the country, including in popular venues for patent infringement actions such as the U.S. District Court for the Eastern District of Texas. We also represent clients in state and federal courts of appeal, including the U.S. Court of Appeals for the Federal Circuit. We also represent clients in interference or reexamination proceedings before the U.S. Patent and Trademark Office, in opposition or cancellation proceedings before the U.S. Trademark Trial and Appeal Board, in domain name proceedings under the Uniform Dispute Resolution Policy of ICANN or other registry rules, and in

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proceedings before the Copyright Office or U.S. Customs agencies

We also know technology. Our attorneys have diverse and distinguished technical backgrounds and business experience. Many of our lawyers have undergraduate training in highly technical fields — with advanced degrees in many cases. A substantial majority of our attorneys have practical work experience prior to law school and are as much business professionals as they are experienced lawyers. Because we understand our clients' technology and business, we are better equipped to shape their IP litigation strategy, manage litigation in ways that support their business objectives, and work directly with their scientists, programmers and engineers in their particular areas of expertise. Our firm includes attorneys fluent in Mandarin Chinese, Korean, Spanish and Italian, further enabling us to “speak your language.”

While our Dallas headquarters situates our firm in the heart of one of the leading business and technology climates in the country, our office in Marshall, Texas provides us a significant presence in the Eastern District of Texas, one of the country's premier patent litigation venues.

## Inter Partes Reviews (IPRs)

**You Will Benefit From Our Legal Experience And Technical Expertise.**

Munck Wilson Mandala attorneys are uniquely positioned to assist you with inter partes reviews. We have decades of experience from both ex parte and inter partes reexaminations, administrative trials before the Trademark Trial and Appeal Board, and intellectual property briefings and trials during civil litigation.

Our attorneys have used reexaminations as part of their defense litigation strategy for two decades. We have the advantage of knowing how to frame issues and craft arguments specifically for administrative patent trials.

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## IP Portfolio Management and Counseling

Trademarks, patents, copyrights and trade secrets are important assets and often possess significant value.

We counsel clients around the world in intellectual property (IP) matters, including the registration of trademarks and copyrights, the prosecution of patent applications, and the protection of trade secrets.

Our portfolio management services are developed in close consultation with you in order to meet your objectives. We assess and monitor the status of your assets in a portfolio, as well as develop strategies to address how your IP rights are -- or should be -- acquired, exploited, enforced and maintained. We help you identify areas of potential vulnerability and additional revenue opportunities.

We manage large portfolios for clients around the world. Over the years, we have developed an extensive global network of foreign associates that enables us to service the trademark, copyright and patent needs of clients outside the United States.

## Patents

With 18 licensed patent attorneys, Munck Wilson Mandala has one of the strongest patent prosecution teams in the southern United States.

Industry leaders and entrepreneurs alike select us to help protect their most important inventions. We are privileged to represent some of the world's largest technology companies, as well as offer the same exceptional service, creativity, and commitment to entrepreneurs and emerging businesses.

We prepare and prosecute utility and design patent applications across a full spectrum of technologies, including wired and wireless telecommunications, medical device, firmware, software, hardware, and pharmaceuticals.

Our patent attorneys have wide-ranging technical backgrounds, including specialized and advanced degrees in areas as diverse as

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electrical engineering, computer engineering, computer science, mathematics, physics, chemistry and molecular biology.

We are fluent in Mandarin Chinese, Korean, Japanese, German, Spanish, and other languages. Many of us have been working together for more than 15 years. As a team, we have well over 100 years of combined experience representing clients in patent preparation and prosecution, licensing, and litigation.

In addition to assessing patent rights and procuring patent protection, we regularly negotiate and prepare a full range of agreements related to inventions, patents or patent applications, including development, manufacturing, joint venture or license agreements.

## Technology Transactions

### At Munck Wilson Mandala, We Have A Passion For Technology.

Our attorneys have the background to address the complexities of technology related transactions. We represent businesses around the world in connection with royalty agreements, content licenses, invention agreements, and confidentiality/non-disclosure agreements.

We also have extensive experience with technology development and transfer agreements, software licensing and distribution arrangements, outsourcing agreements, e-commerce transactions and other contracts that are the lifeblood of technology companies.

The combination of our expertise in technology and intellectual property law and proficiency in transactional work enables us to offer you integrated solutions that provide a strong foundation for your success.

## Trade Secrets

In every industry, information technology has become more portable than ever before, and companies have never been more vulnerable to the loss, misuse or theft of their trade secrets or proprietary information, or to unfair competition targeting their employees or customers.

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Munck Wilson Mandala helps you identify and correct holes in the protection of your trade secrets and proprietary information. We recommend and implement cost-effective strategies to identify and safeguard trade secrets and proprietary information through internal policies, training practices and agreements with employees, independent contractors and other business partners.

When necessary, we relentlessly pursue those who would violate your trust, misappropriate your trade secrets and proprietary information, improperly solicit or hire your employees, interfere with your contracts or business relations, and otherwise unfairly compete. Recognizing the damage caused when claims of unfair competition arise, we are equally aggressive in defending you against such allegations.

Clients regularly call on us for guidance in this complex and important area – where federal law offers limited protection, state laws vary dramatically, and the law is constantly changing both from legislative action and court decisions.

## Trademarks

We understand the importance of your brand to your business and your reputation, and we are dedicated to helping you protect these critical assets.

We will guide you through the selection, strength and registrability of trademarks and service marks, the advantages of registration, and the maintenance and exploitation of trademark, trade dress and domain name rights.

With our extensive network of foreign associates and counsel around the world, and our experienced trademark attorneys, we can provide efficient, cost-effective trademark protection for you and manage your trademark portfolios on a global basis.

Our trademark lawyers work closely with our trial lawyers and litigators both to enforce your marks and to defend you against infringement claims. Our team has extensive experience handling trademark, trade

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