

Cleantech & Renewables

Cleantech and Renewables — Securing the Technology for a Greener World

Well before cleantech, green technology, and renewables were recognized as distinct industries, our attorneys were working to secure the intellectual property that will serve as the foundation for a better tomorrow. Today, we draw on this experience to help companies in the fields of energy, consumer products, chemicals, and other areas — as well as their non-profit research partners — secure, defend, enforce, and transfer IP rights in this rapidly developing sector.

Blazing a clear path across multiple disciplines

Research into, and the commercialization of, cleantech raises a number of issues at the intersection of science, sustainability, and IP law. Leveraging our knowledge and experience in many different technical disciplines, we use an integrated team approach to providing legal advice, often combining experience in the mechanical, electrical, chemical, and biotechnological arts to help clients select and pursue the path that is right for them. Examples of typical technologies include:

- Alternative energy production, including production from biomass, biowaste, geothermal, solar, wind, tidal/wave, and co-generation
- Biofuel distribution, storage, and use
- Bio-based chemicals
- Carbon capture or sequestration, pollution credit trading, and recycling
- Climate change abatement
- Commodity chemicals
- Energy conservation and storage, including fuel cells and smart batteries
- Environmental purification, protection, or remediation
- Green feedstock development
- Product packaging

Prompt, efficient results

Our attorneys understand and take advantage of tools provided by patent authorities to expedite patent prosecution in the most efficient manner possible. For example, our clients were among the first to benefit from the U.S. Patent and Trademark Office's Green Technology Pilot Program to reduce the time between the filing of an application and its issuance. In conjunction with this program, we are using the various Patent Prosecution Highways, our attorneys' global experience, and our worldwide network of patent agents and professionals to leverage the successes in one country into faster, coordinated examinations in many countries.

Full-spectrum legal counsel reflects client diversity

We provide end-to-end patent counsel at every step, from basic research, through technology development, to commercialization of products and processes. In addition to our patent prosecution and portfolio management services, our dispute-resolution team includes litigators with deep experience in the courtroom and in inter partes and other post-grant review processes. Our transactional attorneys regularly draft agreements involving confidential disclosures, material and technology transfers, and IP asset assignments and licenses. We also help clients protect their brands and hard-earned reputations through trademark, domain name, copyright, and related registration issues; conduct full IP due diligence in the context of mergers, acquisitions, divestitures, and joint ventures; handle freedom-to-practice analyses; and negotiate financing agreements.

This full-service approach reflects the breadth and diversity of our clients. We advise Fortune 500 corporations, non-profit research and educational institutions, individual and institutional investors, inventors, startups, and emerging-growth companies based in the United States and abroad. Our clients include the following:

- Blackhawk Technology Company
- Colloid Environmental Technologies Company (CETCO)
- Colorado State University Research Foundation
- Heartland Technology Partners
- Iowa State University
- MBI International
- OpenCEL LLC
- The Procter & Gamble Company

Representative matters

- **A Win for the Environment and at the USPTO**

Marshall Gerstein helped a client protect its innovative focused pulsed (FP) technology and extend its use in a range of new applications. FP technology helps eliminate waste from wastewater by generating a high-voltage electrical field several thousand times per second, and converts that waste into a form that facilitates its efficient conversion into energy. This technology is an all-around “green” win: cleaner water is returned to the environment, less waste is sent to landfills, and more energy is available from alternative sources. We also helped our client “win” at the USPTO. With an eye to streamlining the patent process, we made sure that the client was one of the first applicants to take advantage of the Green Technology Pilot Program, reducing in one instance a projected wait for a first office action from 21 months to two months.

- **Helping Heartland Technology Partners Protect and Monetize Innovative Wastewater Treatment Technology**

For more than five years, Marshall Gerstein has worked with members of the Heartland Technology Partners management team to file and process numerous patent applications designed to protect its cleantech innovations. We have also helped provide a basis for licensing this technology in various industrial contexts, including in landfill processing, oil and gas drilling, and water processing. Our attorneys negotiated finance agreements and prepared licensing agreements on the patent applications. We also issued key opinions on the validity and patentability of the technology over the prior art, the results of which were used to obtain very favorable partnership agreements with the companies that will be implementing and/or using this technology in the field.