

# Industrial & Mechanical Technologies

## Industrial & Mechanical Technologies—Driving Innovation to New Heights

At Marshall, Gerstein & Borun LLP, our lawyers have a deep appreciation of the risks and rewards of innovation in mechanical and industrial technologies. Fast-paced changes in consumer behavior, the evolution of the global economy, and a crowded marketplace all require a focus on new solutions and products in order to maintain a competitive edge. Moving too quickly, however, means potentially overlooking important business and legal warning signs.

We advise clients from virtually every industry sector, from heavy equipment manufacturing and energy exploration to medical devices and consumer goods. Working alongside specialists from the electrical, biotechnical, chemical, and materials sciences, we help innovators meld time-tested, centuries-old arts with modern techniques to deliver new processes and designs.

### **Success-focused intellectual property strategies**

Recently named by *Managing Intellectual Property* as “Patent Prosecution Midwest Firm of the Year,” Marshall Gerstein’s attorneys combine in-depth legal knowledge and technical insight with hands-on industry experience to advance our clients’ IP portfolios through sophisticated patent counseling, prosecution, protection, and monetization strategies.

Our Industrial and Mechanical Technologies Practice Group is committed to advancing the success of our clients’ innovations at every turn. We evaluate invention ownership, conduct due diligence, investigate patentability, prepare, file and prosecute patents, and investigate infringements, among other core services.

### **Interdisciplinary teams**

Marshall Gerstein recognizes that innovation today is rarely confined to a single discipline. Our client service teams comprise attorneys whose experience and skill reflect the range of sciences relevant to the matter at hand. Such collaboration eliminates the barriers between traditionally disparate fields and fosters the creativity required to develop informed and efficient approaches to today’s multifaceted technologies.

Lawyers at Marshall Gerstein are building on well-established legal careers, and a high percentage of our partners have been with the Firm for decades. A number of our team members also gained significant in-house experience providing patent counseling and prosecution services for mid-sized and multinational, Fortune 500 corporations. This professional stability and real-world experience is one of our key strengths and helps us develop and deliver innovative, effective solutions.

### **Global perspective and wide-ranging industry experience**

In today’s global economy, a robust international patent prosecution and enforcement strategy is key to maximizing the value of many of our clients’ IP portfolios. We address the implications of domestic and international IP laws and regulations with equal facility, regularly prosecuting applications for U.S. and overseas clients with the U.S. Patent and Trademark Office (USPTO) and managing the process in foreign jurisdictions through our network of local IP counsel. We are familiar with the requirements for patents in countries of the European Union, across North and South America, and in Asia and other jurisdictions around the world.

We are skilled at identifying the subtle distinctions that define patentability, and prepare detailed applications that clearly explain the key elements of our clients’ inventions and why they deserve protection. We proactively address

issues likely to come under intense scrutiny, enabling us to save clients' money, reduce the time needed to enter international markets, and accelerate the realization of monetary rewards associated with new patent introductions.

Our broad industry experience includes:

- Medical devices
- Consumer products
- Industrial automation and materials processing
- Heavy equipment
- Food and beverage
- Aerospace
- Energy
- Manufacturing & Packaging

**Full-spectrum counsel**

Working with colleagues across the Firm, we offer clients a seamless approach to monitoring, enforcing, protecting, and leveraging mechanical and industrial IP portfolios. These broad capabilities encompass:

- Patent enforcement, including litigation in court and negotiated settlements
- Licensing
- Interferences
- Global IP portfolio management
- USPTO post-grant proceedings

**Representative clients**

- Amgen Inc.
- Ball Horticultural
- B-O-F Corporation
- BOSS Snowplows (a division of The Toro Company)
- Emerson Electric Co.
- Kenall Manufacturing
- Kronos AG
- Medela
- Newell Rubbermaid
- Northwestern University
- The Procter & Gamble Company
- Shop-Vac Corp.
- SSW Holding Co.
- Tuf-Tite, Inc.
- USG Corp.
- University of Michigan
- Walgreen Company
- XOMA Corp.

## Representative matters

- **Mobile Clean Room Plug-and-Play Design Could Revolutionize Industry**

When XOMA, a biopharmaceutical company, developed a flexible manufacturing design using mobile clean rooms, our team prepared effective patent applications to protect the company's innovation. We pursued a strategy of accelerated examination in the United States and helped expedite issuance of a fundamental patent that was subsequently included in a licensing transaction with the Texas A&M University. This clean-room design is expected to play an important role in the development of vaccine and medical countermeasure technologies, and we continue to advise XOMA on worldwide patent strategy and other transactions.

- **Eliminating Spillover via an Inter Partes Victory**

The Firm secured a complete victory for SSW Holding Company, Inc., in an inter partes review proceeding challenging the validity of an SSW patent, making its client one of just a handful to emerge from the newly established inter partes review process with every challenged patent claim fully intact.

Inter partes review (IPR) is a streamlined process for challenging patents created through the Leahy-Smith America Invents Act of 2011 and, to date, has proven favorable to those challenging patents. Of the 78 decisions issued in IPR proceedings through June of 2014, the Patent Trial and Appeal Board cancelled or invalidated nearly 80 percent of the patent claims before it. In only 14 percent of such cases did the board find in favor of the patent owner with respect to all of the patent claims under consideration, as it did in *Schott Gemtron Corp. v. SSW Holding Company, Inc.* The Patent Trial and Appeal Board's decision rejected arguments that SSW's patent—which covers spill-containing refrigerator shelving technology used by major manufacturers, including major appliance manufacturers—was “obvious” and therefore invalid. Oral argument in the case took place on June 23, 2014.