





# Our ‘Big 3’ philosophy – providing the highest quality work product, very promptly and at a very reasonable cost.

## KEY STATISTICS:

- We consistently rank among the top five law firms based on the number of U.S. utility patents issued.
- We consistently rank among the top firms in the category of U.S. Patent Prosecution Counsel in a ranking of intellectual property law firms representing the world’s largest companies.
- We consistently rank among the top 10 firms in the country for patent quality in each of the categories of electrical, mechanical and chemical patents.

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# Firm Overview

Oloff PLC was established in January 1983 with a commitment to providing the highest quality, most cost-effective and prompt intellectual property legal services. At Oloff PLC, we maintain a client-centered approach, dedicated to handling each client matter as we would want it handled if we were the client, maintaining a close working relationship with

our clients, based on clear, frank and prompt communications.

Our firm provides a full spectrum of intellectual property legal services from procurement, including patent and trademark application preparation and prosecution, opinions, counseling, licensing, litigation, and dispute resolution.

Oloff PLC represents a large and diverse group of U.S. and international clients. Our services are tailored to meet the needs and style of each



client. We travel worldwide several times each year to meet with our clients. We welcome all of our clients to visit our offices at any time. We also focus on client training to enhance our clients' ability to protect their important intellectual property in the U.S.

For more than 35 years, our growth continues with the strong support of our clients, and our continued commitment to Oliff PLC's "Big 3" philosophy — providing the highest quality work product, very promptly and at a very reasonable cost.

# Patent Prosecution Practice

We have substantial expertise in patent application drafting and prosecution, supported by well established systems to ensure an efficient, cost-effective patenting process, resulting in high quality, successful results across a wide range of technologies. Most importantly, our systems provide the ability to customize our patent practice to fit the specific needs of each client.

## GROWING DIVERSE PRACTICE

With the careful and thoughtful guidance of its members, Oliff PLC has experienced significant,

virtually continuous growth since its founding in 1983.

We focus on personal interviews, which results in a higher rate of issuance of broad patents, and reduces overall prosecution time and costs. Interviews also allow us to develop a rapport with USPTO Examiners in technologies in which our clients have many applications. We also regularly assist our clients in providing technical presentations to Examiners and attending USPTO technology fairs, which further enhances the understanding of Examiners.

To further strengthen our working relationships and the quality of their patent portfolio, many of our foreign clients send representatives who work in their patent department to our office to work with our attorneys in patent application preparation and prosecution, and to study U.S. patent law.

The patent prosecution group at Oliff PLC has a wide range of academic and practical experience in a variety of technologies including:

- Aerospace
- Artificial Intelligence & Machine Learning
- Augmented Reality/Virtual Reality
- Automation
- Automotive
- Biochemistry
- Business Methods
- Chemistry
- Communications



- Computer Control
- Computer Hardware & Software
- Construction Equipment
- Digital Health
- Gaming
- Consumer Electronics & Office Equipment
- Materials Science
- Medical Devices & Diagnostics
- Molecular Biology
- Physics/Optics
- Power Transmission Equipment
- Precision Measurement
- Robotics
- Textiles

We provide a broad spectrum of patent prosecution services to our clients, including:

- conducting patentability, validity and infringement searches and studies;
- drafting and filing applications for utility, design and plant patents;
- providing advice and strategies for effectively responding to Office Actions;
- drafting Amendments and Requests for Reconsideration in response to Office Actions;
- conducting personal interviews with Patent Examiners;
- briefing and arguing appeals to the Patent Trial and Appeal Board;
- instituting, prosecuting and monitoring interference, inter partes review, reexamination, reissue and patent term extension proceedings;
- patent portfolio management, counseling and licensing;

- coordinating foreign filings through our associates in Europe, Asia, South America and elsewhere;
- translating Japanese language documents in-house;
- providing Japanese-English interpretation services for in-person meetings, video and telephone conferences; and
- drafting drawings in-house to reduce costs, expedite the application process, and ensure accuracy of electrical, mechanical and chemical patents.

# Trademark Practice

## OUR TRADEMARK TEAM

Our trademark practice is an integral part of our overall practice and, consequently, many of the firm's members and senior counsel spend a significant portion of their time assisting clients with trademark issues. All of the members also have significant litigation, opinion drafting, counseling and licensing experience, which provides a solid, diverse foundation for optimally handling our clients' trademark matters.

Our litigation practice complements our trademark practice, when litigation is necessary to enforce or defend our clients' rights. We have also tried multiple cases in the evolving



field of product design trade dress, including a case that helped to establish the standards for determining when an asserted product design is functional.

### **GROWING DIVERSE PRACTICE**

Our trademark experience spans a broad spectrum of goods and services in all classes, including:

- chemical products;
- clothing;
- computer hardware/software;
- cookware;
- food;
- gasoline service stations;
- industrial devices;
- injection molded products;
- jewelry;
- machine tools;
- medical devices;
- musical instruments;
- oil candles;
- personal grooming products;









- restaurant services;
- retail store services;
- shoes;
- sporting goods;
- trade association services;
- videos and laser discs;
- vitamins;
- watches;
- website design;
- writing instruments.

Our experience includes work with different

forms of non-word marks, such as design and product configuration marks, as well as the special considerations involved with protecting a family of marks, or a portfolio of house and product line marks.

U.S. and international trademark services we regularly provide to our clients include:

- searches and advice relating to selection of new marks;
- preparation and prosecution of state, federal and international registration

applications, including Madrid Protocol extensions, and maintenance of registrations over time;

- coordination of foreign filings through our worldwide network of foreign associates, with whom we have long-established and close relationships;
- licensing, assignment and acquisition of marks;
- enforcement and conflict resolution through negotiation, opposition and cancellation proceedings, and court litigation;
- performing trademark audits, and developing corporate policies and procedures relating to adoption, use and protection of marks;
- watch services; and
- counseling on related issues such as unfair competition, dilution, privacy and publicity rights, trade dress, trade secret protection, internet and e-commerce enforcement, copyright protection, and licensing.

## **MANAGEMENT OF PORTFOLIOS WORLDWIDE**

We assist with strategizing management of international trademark portfolios. We have handled licensing matters, domain name disputes, monitoring of potentially infringing applications, and enforcing of marks in the U.S. and all around the world. Our experience with enforcing trademarks internationally makes it possible for us to provide our clients with effective global branding strategies.

## **WATCH SERVICES**

We can implement professional watch services worldwide to watch newly filed applications, common law usage, business names and domain names that may infringe our clients' marks.

## **COUNTERFEIT GOODS**

We are experienced in developing anti-counterfeiting measures and policing gray market goods. We can work with U.S. Customs and Border Protection to register our clients' marks so as to facilitate the seizure of counterfeit goods.

## **TRADEMARK TRIAL AND APPEAL BOARD ACTIONS**

Our Trademark Team is very experienced and highly trained to handle U.S. trademark opposition and cancellation proceedings. This way, we are able to offer our clients all effective means of enforcement and defending their trademark rights.

# Copyright

Our copyright practice similarly spans a broad spectrum of works, with particular expertise in technical works — such as computer-related technology in all of its many forms, including computer software, micro code, mask works,



user interfaces, multimedia, databases and the Internet.

We are experienced in conducting copyright clearance searches, registering and protecting creative works, monitoring and investigating potential infringements, negotiating copyright issues, representing plaintiffs and defendants in copyright litigation. Our Litigation Team is experienced to handle any copyright disputes that arise.

## Design Patent Practice

Our Design Patent Team assists our clients in developing and enforcing design patent portfolios to meet business objectives.

Design patents quickly and effectively protect novel and inventive ornamental designs embodied by articles of manufacture. Patentable designs may be found in a wide variety of articles.

The members of our Design Patent Team regularly:

- advise clients regarding infringement, validity and freedom to operate;
- prepare and prosecute design applications;
- enforce our clients' design patent rights, and defend against assertions by third parties.



# Litigation Practice

Our litigation practice is diverse and long-established. Since we opened our firm in 1983, we have litigated extensively on behalf of our clients in courts and other tribunals throughout the United States, including:

- various state courts;
- all of the major District Courts;
- the Court of Appeals for the Federal Circuit;
- the International Trade Commission (ITC);
- the Court of Federal Claims;
- the Board of Patent Appeals and Interferences;
- the Patent Trial and Appeal Board; and
- the Trademark Trial and Appeal Board.

Our main office is just across the river from the U.S. Court of Appeals for the Federal Circuit, where all patent appeals and appeals from the USPTO are heard. We are also just minutes from the U.S. District Court for the Eastern District of Virginia (the “Rocket Docket”), where we have been involved in many cases, both as primary counsel and as local counsel. Our office is also very close to the USPTO, where we have handled numerous inter partes matters, including patent interferences, Inter Partes Reviews, reexaminations, and trademark opposition and cancellation proceedings.

We have represented plaintiffs and defendants in patent infringement and declaratory judgment

actions across a range of technologies. In addition, we regularly represent clients in trademark and trade dress infringement actions. We also represent clients in trade secret misappropriation, unfair competition, antitrust matters, ITC investigations, and other IP-related litigation.

## Post-Grant Practice

We understand the critical importance of bringing new products to market and maintaining markets for existing products while avoiding patent traps. Throughout the history of our firm, we have successfully represented numerous clients in post-grant matters, including ex parte and Inter Partes Reexaminations, as well as hundreds of administrative appeals in the USPTO.

Post-grant proceedings available under the America Invents Act (AIA) can provide a relatively prompt, cost-efficient way of challenging the validity of third party patents. The new Inter Partes Review proceeding, for example, has quickly become an effective, cost-efficient way to challenge a third party patent and can provide a less burdensome alternative to litigation.

With our significant experience in these matters, and our extensive litigation experience, we are



well-suited to effectively handle Inter Partes Review and Post-Grant Review proceedings under the AIA. Our highly-trained attorneys have handled and are prepared to handle these post-grant matters in all technical disciplines, and to advise our clients on the best and most sensible ways to achieve success in trials before the Patent Trial and Appeal Board. As with everything we do, our long-standing and widely regarded “Big 3” philosophy — providing high quality work product, promptly and cost-effectively — ensures that our clients receive the best results possible.

## Opinion and Counseling Practice

Our clients rely on our substantial experience to help them make the best business decisions, taking into account the IP landscape, and third party patents. We work with our clients around the world to develop the best strategies for determining effective offensive and defensive patent strategies.

We regularly provide our clients with expert opinions in all technologies, advising them on patent infringement and validity issues, freedom to operate assessments, patentability assessments, and alternative design options. We work as a team with our clients’ in-house

IP staff and technical personnel to promptly evaluate and provide advice regarding the most effective strategies and potential risks.

As with everything we do, we take the most cost-effective approach by evaluating our clients’ objectives. For example, in some situations, a brief “summary” opinion, or even an oral opinion, may be appropriate, and can avoid significant expense to the client. In circumstances where litigation is anticipated and an opinion may be necessary to defend a potential willful infringement allegation, we can provide a comprehensive and detailed written opinion so the client is in the best position possible to ensure the strongest litigation position. Even after the Federal Circuit’s *Seagate* decision, it is still important to obtain formal opinions from counsel. Post-*Seagate*, the Federal Circuit has reaffirmed that opinions of counsel can provide a basis for establishing that an accused infringer made an informed business decision in obtaining an opinion and did not act in an objectively reckless manner.

We also provide our clients with comprehensive counseling services in a variety of areas, including, for example, due diligence and patent portfolio assessments, licensing options, trade secret protection, potential unfair competition issues, etc.



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