

# Top New Jersey Law Firms Help Innovators Protect Their Valuable Intellectual Property

New Jersey, known as the "Invention State," is home to many brilliant minds. Protecting innovations with patents and trademarks is a business necessity.

COMPILED BY MILES Z. EPSTEIN  
EDITOR, COMMERCE

**P**ATENTS, TRADEMARKS, COPYRIGHTS AND TRADE secrets—often referred to as intellectual property—are assets with significant financial value. They need to be protected from theft and misuse, and law firms are most effective in doing just that for companies, innovators and inventors. Here are some case studies—plus some unique practice areas—that are allowing attorneys to help protect intellectual property which, in turn, creates many important business and entrepreneurial opportunities.



## **Brach Eichler L.L.C.**

*By Jonathan D. Bick, Esq.  
Counsel*

A New Jersey firm owns the trademark and patent for a dietary food supplement. A competitor purchased Google Ad Words to direct Internet users to a site with misleading information about the client's product. The client wrote to Google: "Someone is abusing your search engine, infringing on my trademark and spreading false and malicious statements about a product my company sells. This abuse is coming from a competitor in Budapest, Hungary. If you type our trademark into your search engine, your search engine returns a false claim of ownership of my patent and content filled with deceptive trade practices." After Google failed to take any action, the client retained Brach Eichler. Brach Eichler prepared and presented to Google documentation, which demonstrated that fractional patent ownership permitted by Hungary did not permit a minority shareholder to claim ownership and demonstrated the alleged trademark infringement. This documentation was presented to Google with a notice letter to Google. Google stopped accepting payment for the Google Ad Words associated with the client's trademark, and the Google search engine no longer returns the offending site. The client's difficulties with the adverse Web site were resolved within weeks.



## **Connell Foley LLP**

*By Marc D. Haefner, Esq., Partner,  
Intellectual Property, Labor and  
Employment Law and Business  
Litigation Practice Groups*

We have had more than one case with New Jersey clients where the most effective "lawyering" that we can

do for them is to analyze the dispute and then resolve the dispute early. Given the expense of litigation, you do the client a big favor by initially analyzing the case completely to determine whether the best defense is for the client to change its practices. For example, in a trade dress case involving a New Jersey distributor of Asian food, the plaintiff alleged that our client's packaging looked too much like the plaintiff's packaging. We immediately examined the competing boxes with knowledge of the relevant law and with an objective eye and suggested that the best path forward would be for our client to change its box (which had come to the market years after the plaintiff's box) and resolve the case quickly. A knee-jerk reaction to fight every case all the way to motions or to trial is not doing the client any favors when the client does not have a real chance of winning. Further, a change of practices can often satisfy a competitor who really does have a legitimate gripe—without costing any significant money.



## **Greenbaum, Rowe, Smith & Davis LLP**

*By Eric H. Melzer, Esq., Partner,  
Corporate and Technology  
Practice Group*

In seeking to protect a client's intellectual property, our attorneys must play the role of both advisor and advocate. For one such client, a trademark application was filed to register the client's mark on the Principal Register of the United States Patent & Trademark Office (USPTO). The USPTO Examining Attorney issued a refusal to register our client's applica-

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tion based upon Section 2(d) of the Trademark Act, 15 USC 1052(d) on the grounds that the mark was confusingly similar with a registered mark. When the refusal was made final, the Examining Attorney's ruling was appealed to the USPTO Trademark Trial and Appeals Board (TTAB). As advocates, we asserted that the marks differed in sound, appearance and commercial impression and that the goods and services covered by our client's mark differ markedly from those encompassed by the registrant's mark. The TTAB reversed the Examining Attorney's refusal and determined that, based upon the record, confusion between the two marks is not likely. In determining that the Examining Attorney failed to show a likelihood of confusion to substantiate a refusal under 15 USC 1052(d), the USPTO has approved the publication of the mark for the opposition on the USPTO's Principal Register.



**Herten, Burstein, Sheridan, Cevasco, Bottinelli, Litt & Harz, LLC**

*By Arnold D. Litt, Esq.*

Our client is an inventor who developed an improved energy system with worldwide applications. Through Herten Burstein's Intellectual Property Department's expertise, a patent application was prepared and filed with the United States Patent & Trademark Office covering the invention. Unfortunately, our client had no contacts in the market-

place and was unable to procure investors who would fund and/or joint venture the development and marketing of a prototype of the invention. Always alert to potential cross-marketing opportunities within our firm, we were able to introduce one of our venture capital clients to our inventor, resulting in an opportunity to turn a "paper concept" into a possible business plan with funding possibilities. Herten Burstein is sensitive to both the legal and business opportunities that may exist in a particular transaction, and has the capability through its staff of attorneys whose expertise extends over such diverse disciplines as business law, corporate law and lending law, to provide broad-based legal and business analysis to our clients.

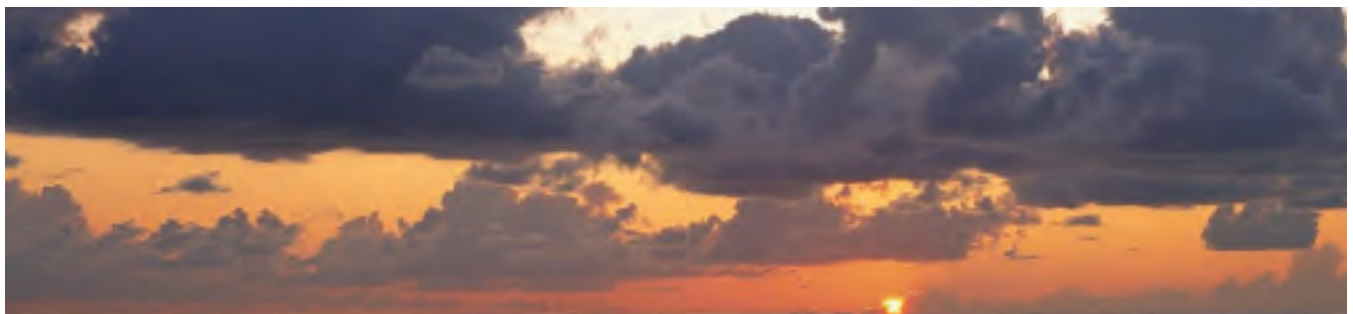


**Hill Wallack LLP**

*By Eric I. Abraham, Esq.  
Partner*

Hill Wallack LLP is patent litigation counsel to several manufacturers of generic pharmaceutical drugs. To bring these drugs to market, generic manufacturers need to defeat legal challenges brought by the patent holders of the branded versions of their pharmaceutical products. In January 2009, New Jersey's Federal Court adopted new rules for patent litigation, including the licensing of generic drugs. I created a template from these new rules that lays out a

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specific litigation timeline for any patent infringement litigation filed by the brand manufacturer to keep the generic competition off the market. Mapping out the litigation timeline provides generic drug manufacturers with several key business advantages: (1) clients can match internal manufacturing requirements with critical litigation events that would permit the sale of their product; and (2) clients can accurately budget litigation expenses, including legal fees and internal resources needed to support the case. One of the hardest jobs for generic manufacturers is managing the risk of patent litigation, especially given the tremendous expense of launching a generic competitor to a branded drug. With Hill Wallack LLP's help, the client is equipped to make the strategic decisions required for a successful launch.



**Norris McLaughlin & Marcus, P.A.**

*By Jeanne Hamburg, Esq.  
Member of the Firm*

For the convenience of our clients, the newly formed Internet Law Section of our Intellectual Property Practice Group brings together attorneys from our firm who have years of experience in dealing with the unique patent, trademark and copyright issues that arise on the Internet. For example, for a startup Web site, we cannot only secure registrations for brand names and domain names, we can also prepare terms of use and privacy statements, and advise clients on the appropriate provisions to include when those sites have interactive features such as chat rooms, blogs or other con-

tent-sharing capabilities. We also help draft Web site development agreements, licenses involving the exploitation of content available to their users, and assist in rights acquisition and clearance of Web site content. We also help our clients with related disputes, which may include litigating such issues as click-through license agreements, which provide access to copyrighted content; Digital Millennium Copyright cases against Internet Service Providers and infringers; competitor keyword purchases from an Internet search engine of a trademark owner's mark to influence user search ranking results; hyperlinking; framing; pop-up advertising; pay per view/click advertising; phishing; online software infringement; and online counterfeiting. In the end, there is no one issue we help clients with in this area, but many.



**Wolff & Samson PC**

*By Peter Nussbaum, Esq.  
Member of the Firm*

Wolff & Samson regularly advises clients on a wide range of intellectual property matters, including patent, trademark, copyright, false advertising, technology and Internet law. We recently represented a New Jersey-based technology company in connection with a trademark dispute with a company that was providing related services under a confusingly similar name and mark. The competitor's prior-filed United States service mark application stood in the way of our client's registration of its trademark with the United States Patent and Trademark Office (USPTO). Although our client had been using its trademark for a longer period of time than the competitor, the competitor filed for service mark protection prior to our client. The competitor's application was therefore cited against our client's subsequently filed trademark applications and prevented our client from obtaining federal trademark registration. In order to resolve this problem, Wolff & Samson filed an Opposition Proceeding before the Trademark Trial and Appeal Board (TTAB) of the USPTO, opposing registration of the competitor's mark. The TTAB granted our opposition, resulting in the abandonment of the competitor's prior-filed application. This cleared the way for our client to obtain registration of its valuable mark and simultaneously served to eliminate a confusingly similar mark from the Trademark Register. ■

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