

Intellectual Property

Winstead has a large national and global footprint in intellectual property, with highly competitive rates and the deep technical diversity to advise corporations, inventors and authors, start-ups, and research institutions and universities. Our IP lawyers and supporting team function as a nimble IP boutique practice, working equally well with—and at the pace of—entrepreneurs, corporate counsel and executives.

With our large firm infrastructure, however, we can scale fast, and are able to quickly jump into huge litigation and large, tight-deadline prosecutions. Winstead IP lawyers perfect, protect and commercialize our clients' inventions, works of authorship, trademarks, trade secrets and know-how throughout the world.

We represent and advise clients on all aspects of intellectual property:

- Patent
- Trademark
- Copyright
- [IP Litigation](#)
- IP Licensing
- IP Enforcement Programs
- Trade Secrets
- Internet
- Unfair Competition
- Outsourcing and Managed Services
- [IP Issues in Business Transactions](#)

Our clients range from small startups to Fortune 500 companies for which we provide strategic advice and representation throughout the complete lifecycle of products and services, from research and development, financing, marketing, licensing, and regulatory approval to the enforcement of relevant rights. Our clients include:

- Technology companies that need to protect every aspect of their business and IP
- Non-tech companies that need to protect their brands, products, business practices and operations
- Research institutions and universities—both academic and sponsored—where the faculty are innovating and creating new technologies
- Non-U.S. companies and law firms seeking to obtain U.S. patents and copyright and trademark registrations
- Tech incubators and tech commercialization groups that connect inventors to money

Our clients are active in the following industries:

- Biotechnology and pharmaceuticals
- Chemistry and chemical processes
- Computers and software
- E-Commerce
- Electronics/display technology
- Entertainment/sports/music/publishing
- Finance and banking
- Information systems
- Manufacturing
- Mechanical
- Medical technology
- Nanotechnology

- Oil field/energy
- Real estate
- Semiconductor
- Telecommunications/Internet

Many of our clients have worked with us for years, reflecting the success of the values that drive our practice:

A hard-nosed attention to detail and a zero error mentality. As a firm that represents many banks and real estate companies, Winstead has a culture of precision that also is engrained in our IP practice. Winstead uses industry best practices docketing and document production/filing systems to effectively manage large volume prosecution files and to eliminate errors and missed due dates in a cost-effective way.

A desire to manage the work so efficiently that we come in under-budget. Winstead also sets regional-based rates and offers task-billing, so the cost to our clients will never be as high as firms that set national or international rates.

Snapshot of IP Strengths

Winstead is an experienced partner where science, technology and commerce intersect. These are the areas where we excel:

- Digital technology patents for everything from computer chips to programming
- Due diligence assessment of IP in mergers, acquisitions and licensing transactions
- Branding and trademark clearance, prosecution and enforcement
- Information technology needs involving Internet or cloud-based software and system licensing and/or networking services
- Life sciences innovation involving biotechnology, healthcare and nanotechnology
- Master agreements for computer hardware and software, including open source code
- University and nonprofit research center patent prosecution and enforcement

Featured Client Stories

Getting Social with Zimbra—How to Expand Your Company Internationally, Rebrand and Enhance Your Product Features, IP Portfolio and Customer Base in 30 days.

Our client's opportunity: In July of 2013, Texas-based Telligent, Inc. had a unique opportunity to acquire the Zimbra software product line for unified collaboration from VMWare. This acquisition, which enabled our client to significantly expand its business globally overnight, included software code and IP assets, offices, customers and operations located in at least five countries. The twist was that the transaction had to close in a tight timeframe.

Winstead approach and solution: Winstead's IP Team immediately began our due diligence to evaluate the Zimbra software, IP portfolio and licensing/contracts and advise Telligent. We worked closely with the Telligent business team to coordinate comments/revisions/suggested changes to the agreements and to participate in all party calls to finalize the closing. Our team further helped Telligent prioritize and coordinate the pre-closing and post-closing actions needed to fully effect the acquisition, implement the corporate-wide rebranding from Telligent to Zimbra and integrate two distinct companies into one unified global social community software and service provider.

Outcome: Mission accomplished! Zimbra was globetrotting by spring 2014. New integrated releases of software products and services were rolled-out to their client base by spring 2014. Corporate rebranding, contract integration and IP portfolio transition plans were implemented immediately following the closing. With its vibrant open source community and worldwide partner network, Zimbra is now the third largest collaboration provider in the world.

From Invention to Licensed Start-Up to Commercial Success

Our clients' opportunity: In November 2002, working with university client researchers, Winstead filed a patent application for multi-functional materials formed from oriented nanofibers in a polymer matrix. Other applications that

Winstead also prepared and filed followed, from both the initial university client, as well as two other universities. A resulting portfolio was assembled and licensed to NanoRidge Materials Inc. of Houston, TX, a start-up company formed in 2004 to continue research in developing and commercializing the material. The challenge was to take cutting edge technologies in the infancy of the field from the laboratory stage to successful commercialization.

Winstead approach and solution: Pursuing the mutual interest of quality patent protection, Winstead worked closely with NanoRidge and the university clients. Attention to quality and cost by the Winstead IP team for nearly a decade allowed NanoRidge – as a new company – to pursue a significant number of patents in technologies focused on applications of carbon nanotubes and other nanoparticles. NanoRidge’s goal was the production and sale of nano-enhanced materials.

Outcome: NanoRidge has outlasted and outgrown many, if not most, of its contemporaries in the nanotechnology field. In April 2014 it secured through a strategic partnership a long term contract with one of the largest multinational oilfield services companies with a forecasted average value of more than \$350 million per year. In the words of the strategic partner, “There hasn’t been any real innovation to replace copper wire in the last hundred years until now, this is a sustainable, lighter and stronger technology that combines the electrical and mechanical aspects of wire and cable into one product.” Per the agreement, the company will use, sell and distribute the first commercial scale production of a carbon nanotube technology in wire and cable form.

An Outstanding Result and Significant Cost Savings for the Client Due to Pre-Discovery Mediation and Favorable Settlement

Our client’s problem: A Fortune 500 manufacturing client was facing infringement of two valuable patents by a competitor, and the infringement was costing the client money and market share.

Winstead’s approach and solution: After a lawsuit was filed, we arranged for early mediation. The parties exchanged mediation statements and supporting information without resorting to expensive and disruptive formal discovery.

The outcome: As a result of post-mediation settlement, our client was paid an undisclosed, but substantial, amount of compensation and remained the sole supplier of the patented technology.

Next Steps

You’ve made a major investment of time and money in developing your technology and intellectual property and you need more than just everyday IP law counsel. Winstead IP lawyers help make intellectual property assets a source of great value to you and your organization. We get the business realities behind technology use and application, and offer you broad-based, experienced IP advice that reflects a geek-worthy understanding of both your technology and your business.

Experience

IP Transactions

- Act as co-lead trial counsel for defendants in a patent infringement case in which infringement had been found prior to our involvement. At trial, damages were limited to a minimal amount.
- Patent matters on Section 337 issues before the International Trade Commission.
- Declaratory judgment action over patent ownership and priority of invention.
- Prevail at trial and on appeal in the defense of a patent infringement suit involving thin film transistors and active matrix displays.
- Resolve copyright/contestant submission dispute for a producer of a high-profile musical talent showcase broadcast.
- Patent infringement, copyright infringement and trademark litigation, Lanham Act violations and misappropriation of trade secrets claims.
- White-collar crime claims based upon alleged counterfeiting activities.
- Internet-related, e Commerce disputes that transcend traditional bounds of trademark and copyright law.

- Patent disputes involving mechanical, electrical and chemical issues for inventors, patent holders, and alleged infringers.
- Trade dress disputes involving product configuration, restaurant décor and related unfair competition.
- Copyright conflicts involving computer programs, architectural plans and three-dimensional works.
- Defend allegations of patent infringement over high-temperature gel permeation chromatography instrumentation.
- Obtain favorable settlement in a state court trade secret case involving patent software products.

Transactional and IP procurement transactions/cases

- Negotiate major technology transactions. These include development and co-development agreements, enterprise agreements, license agreements, hardware and software purchase and maintenance contracts, ISP agreements, hosting agreements, data processing agreements, implementation and integration contracts and technology transfer agreements.
- Preparation and prosecution of trademark applications, including matters before the Trademark Trial and Appeals Board and domain name disputes before the World Intellectual Property Organization.
- Manage large intellectual property portfolios. Trademarks, copyrights and patents including prosecution, maintenance and licensing matters.
- Complex patent, copyright and trademark matters. Patent infringement, patent invalidity, copyright infringement, copyright invalidity, violations of technology licensing agreements, trademark infringement claims involving trade names, logos and trade dress.
- Initial public offerings. Assist technology-based companies and underwriters in IP valuations and protections.
- Pharmaceutical and biotech freedom to operate analysis of drug discovery targets, pharmaceutical formulations, assays, genetic constructs and bioprocessing including cell lines, culture media, and separation and purification methodologies.
- Biotech patent prosecution including recombinant proteins, molecular agonists and antagonists, and drug delivery devices.
- High-end computer software license agreements. Draft and negotiate these agreements for software companies, semiconductor companies, retailers, retail management companies and oil companies.