

Electrical & Computer Technologies

Electrical & Computer Technologies — The Depth to Deliver Superior Service

The fields of electrical and computer technologies, including software engineering, are in constant flux. The technology changes rapidly, as has recent, relevant law. For clients in this turbulent area, Marshall, Gerstein & Borun LLP has long provided a steadying hand.

Our large team efficiently handles matters involving the most sophisticated technologies developed and refined by corporations and leading research universities. Our work is as groundbreaking as that of our clients, and draws on our deep knowledge of software, process controls, e-commerce, telecommunications, semiconductors, and related technologies. As a result, emerging and Fortune 500 companies alike can trust Marshall Gerstein with substantial, complex, and growing patent portfolios.

We offer a full suite of services that address virtually all of our clients' IP needs, beginning with the patent prosecution experience that recently earned us recognition as *Managing Intellectual Property's* "Patent Prosecution Midwest Firm of the Year." Our attorneys manage a wide range of patent portfolios, provide patentability and other opinions, and handle licensing, due diligence, and other transactional services. We also regularly handle disputes in state and federal courts and before the Patent Trial and Appeals Board and the International Trade Commission, among other forums.

A deep bench

The depth of Marshall Gerstein's Electrical and Computer Technologies Group gives us the capacity to meet almost any client need, no matter how demanding or urgent. The Firm has more than two dozen attorneys with advanced degrees in electrical engineering, computer engineering, or computer science. Many members of our group also bring years of relevant industry experience to their work. While our attorneys typically operate in small teams that have developed in-depth knowledge of our clients' businesses and technologies over extended periods, our numbers also allow us to respond in force to the most intense demands within the shortest time frames.

Award-winning patent prosecution

Marshall Gerstein has a well-earned reputation for handling novel and highly complex patent prosecutions. We have secured the first patents ever granted in connection with technologies ranging from plasma display panels and digital imaging to the management of flexible spending accounts. In many instances, our strategic approach to patent prosecution has allowed our clients to capture significant market share, as it did when we secured a pioneering patent over wireless internet router systems, which subsequently provided critical protection to a client against its large competitors.

Unrivaled business method experience

The size of our team, the volume of our work, and the diversity of our clients have combined to give us repeated exposure to the most challenging legal issues arising in the area of business methods. We have unrivaled experience, in particular, assisting software producers and other industry participants in strategizing around *Alice* rejections.

Foreign prosecutions and partnerships

Marshall Gerstein prosecutes, develops, and manages patents for clients of varying size (from startups to Fortune 100 companies) and portfolio strategies (including those developed for offensive, defensive, and licensing purposes). We work closely with our clients to craft effective global IP strategies, and have developed substantial experience managing interrelated U.S. and foreign patent portfolios. Over time, our Firm has developed relationships with a network of more than 300 foreign law firms effective in navigating the frequently changing legal landscapes of their home countries and smoothing the process of securing foreign patent protection.

Industry experience/technologies

- Insurance
- E-commerce and internet
- Process controls
- Financial services
- Databases
- Digital imaging
- Mapping
- Security, safety, and surveillance
- Semiconductors
- Telecom and wireless

Representative clients

- CDW Corp.
- Charter Communications
- Citadel
- Emerson Electric Co.
- Xerox
- Gogo
- Google
- Peerless Network
- S&C Electric
- Shop-Vac Corp.
- University of Michigan
- Walgreen Company

Representative matters

- **Protecting Cancer-Detection Innovation**

On behalf of the University of Michigan, the Firm secured a patent covering software that greatly reduces the rate of false positives that occur in cancer screening. The patent provides IP protection for a healthcare innovation that eliminates heartache for vulnerable patients, as well as their families and doctors.

- **Greenlighting a Financial Service**

Marshall Gerstein regularly advises clients on the broad legal and competitive landscapes of their markets, identifying any IP barriers to new products or initiatives before resources are devoted to their development. For a client contemplating the creation of an entirely new financial exchange, the Firm conducted a patent search and analysis. Ultimately, we identified a way to create the new exchange without interfering with any existing IP rights.

- **Convincing the PTAB of our Client's Valid Patent Claims**

The Firm secured a near-complete victory for A-1 Packaging Solutions, Inc., in two inter partes review proceedings challenging the validity of an A-1 patent, leaving the vast majority, 27 of 30 claims, in fact, of A-1's patent claims intact. The Board agreed completely with our arguments, rejecting RF Controls' position that A-1's patent claims, which are related to antenna technologies and radio frequency identification (RFID) tracking, were "obvious" and therefore invalid. The Board said, "[A-1] argues [RF Control's position is unsupported and] provides nothing more than an infinite range of possible locations of the RFID tag ... We agree." Additionally, the Patent Trial and Appeal Board rejected several arguments that A-1's patent was "anticipated" by various prior art references.

- **A Prescription for Patent Success**

On behalf of a national drugstore and retailer, the Firm secured a family of 11 different patents that collectively cover a software tool that performs the important and intricate task of aligning refill dates on its customers' prescriptions. The software makes such an important difference in the lives of customers that the company, again with Marshall Gerstein's assistance, has further developed a successful licensing program for the technology.