Intellectual Property

Overview

Carlton Fields' intellectual property attorneys represent some of the most respected and recognized brands in the world in patent, trademark, copyright, trade secret, and false advertising matters.

Intellectual Property Litigation

Our world-class intellectual property litigators and appellate attorneys represent clients in venues where IP cases are most often litigated, including the Middle and Southern Districts of Florida, the District of Delaware, the Southern and Eastern Districts of New York, the Eastern District of Texas, the U.S. Court of Appeals for the Federal Circuit, the U.S. Court of Federal Claims, the U.S. International Trade Commission (USITC), the Patent Trial and Appeal Board (PTAB), and the Trademark Trial and Appeal Board (TTAB).

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Our team has first-chaired seminal cases that have changed the IP landscape. And our deep industry experience in high technology, financial services and insurance, media and digital media, entertainment, software, medical devices, pharmaceuticals, telecommunications, construction, and other fields makes every case we litigate more efficient.

Our team regularly handles disputes involving:

- Patent infringement
- Trademark and branding litigation
  - TTAB opposition and cancellation proceedings
- Copyright litigation and counseling
- Internet and social media
- Entertainment
- Advertising and promotions
- Pharmaceutical and life sciences
  - ANDA, biosimilars and follow-on biologics, biotechnology
- Data security and privacy
- Digital Millennium Copyright Act
- PTAB post-grant review proceedings
  - Inter partes reviews, post-grant reviews, and covered business method reviews
- USITC Section 337 proceedings
- Trade secrets and related litigation
  - Defend Trade Secrets Act; Computer Fraud and Abuse Act; Stored Communications Act; Electronic Communications Privacy Act; Economic Espionage Act; and various state Uniform Trade Secret Acts, unfair and deceptive trade practices statutes, and computer hacking and privacy statutes
- ICANN domain disputes
  - UDRP, URS, cybersquatting
- Commercial disputes and unfair competition
- Restrictive covenant enforcement

Intellectual Property Protection & Portfolio Management

We secure domestic and international IP rights through patents, trademarks, copyright registrations, domain names, and other forms of intellectual property. Our registered patent lawyers and brand specialists devote their practices to helping clients establish and transform their intellectual property rights into business assets.
Patents
Our registered patent lawyers practice in a wide range of technologies and fields, including software, financial services, medical devices, health care, telecommunications, mechanical devices, and pharmaceuticals. Our team also has deep industry experience and a cutting-edge understanding of high technology, including software design and programming, blockchain, and cybersecurity. Our team provides a variety of patent portfolio services including:

- Patent applications, prosecution, and representation of clients before the U.S. Patent and Trademark Office (USPTO) and international patent offices
- Patent infringement, invalidity, clearance, and patentability opinions
- Cease-and-desist letters
- IP audits
- Patent licenses
- Assignments and ownership transfers

Trademarks, Websites, and Domain Names
Our trademark lawyers are recognized by industry publications as among the best in the United States. We establish and manage global trademark and domain name portfolios for world-class brands. Members of our team include Apple’s original trademark attorney who developed and implemented Apple’s domestic and international trademark program; the author of World Trademark Law and Practice (LexisNexis, five volumes), a treatise that addresses trademark procedures in more than 150 jurisdictions around the world; and attorneys board certified in Intellectual Property Law by The Florida Bar. Our work includes:

- Global trademark applications, prosecution, and maintenance
- Trademark policing and enforcement
- Opposition proceedings
- Cancellation proceedings
- Domain name registration, maintenance, and enforcement
- Cybersquatting policing
- Unfair competition
- Passing-off claims

Copyrights, Entertainment Law, and Publicity Rights
Our copyright and entertainment lawyers advise clients regarding the acquisition, sale, and licensing of copyrighted works, and all types of development, licensing, and distribution transactions. Our practice includes two nationally recognized specialists in creative talent and entertainment ventures, and our team represents a veritable who's who of Michelin-starred chefs and restaurateurs, and multiplatinum-selling recording artists, songwriters, producers, and mixers.

Our services include:

- Content acquisition and license agreements with major film and television studios and other major content companies
- Copyright applications and registrations and representation of clients before the U.S. Copyright Office
- Copyright licensing
- Authorship and joint ownership agreements
- End-user license agreements
- Work-for-hire agreements
- Copyright audits
- Endorsements agreements
- Personal appearance agreements
- Celebrity commercial real estate transactions
- Talent agreements
Company IP Programs, Policies, and Procedures

We also design and implement internal IP portfolio management procedures for clients, including invention reporting, intercompany licenses, patent incentive programs and committees, employment agreements and procedures, confidentiality agreements, invention agreements, trade secret protection practices and policies, and copyright maintenance, licensing, and enforcement programs.

**Technology & IP Transactions**

Our IP transactional team negotiates and structures complex deals involving IP assets such as patents, trademarks, copyrights, trade secrets, industrial designs, and other forms of intellectual property. As an integral part of Carlton Fields’ corporate, M&A, and private equity practices, our IP transactional lawyers provide expert and efficient advice on IP issues in commercial agreements, acquisitions, divestitures, joint ventures, alliances, and investments. Our team regularly conducts IP due diligence, prepares agreements and assignments, and advises on IP ownership, licensing, website terms of service, and privacy issues.

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Our transactional team provides the following types of IP transactional services:

- Software development and licensing arrangements
  - End-user license agreements (EULAs), app licenses, evaluation of open-source software
- Nondisclosure agreements (NDAs), noncompetition agreements, work-for-hire agreements
- Internal IP policies
- Website terms of use and privacy policies
- Patent, trademark, and copyright licensing arrangements
- Technology and know-how licensing and royalty agreements
- IP assignments and ownership changes
- Marketing, reseller, and distribution agreements
- R&D, teaming, and collaborative research agreements
- Evaluation of government-funded patent and technical data rights

**All Insights**

**Florida's Fourth District Gives Protection to an Obvious Secret**

MAY 29, 2020

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**7 Tips for Restaurants Switching to Takeout or Delivery-Only “Ghost Kitchens” During the Coronavirus Crisis**

MARCH 19, 2020

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Canna We Talk Cannabis? Not So Patently Obvious: Patent Infringement in the Cannabis Industry
MARCH 2, 2020
There are many obstacles and complexities that cannabis companies face in securing IP rights on their products. In this podcast, Carlton Fields intellectual property attorney Coy Stull discusses a pending patent infringement case involving two cannabis companies and the key takeaways for entities selling CBD products.

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Bitcoin is Speech: Notes Toward Developing the Conceptual Contours of Its Protection Under the First Amendment
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Getting Creative With Video Games: Sync Rights and Wrongs
OCTOBER 21, 2019
In this series, we will discuss some of the fundamental concepts of intellectual property law as they relate specifically to video game companies and other unique players in the space, including esports teams and content creators.

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Getting Creative with Video Games: Whose Game Is It, Anyway?
OCTOBER 2, 2019
In this series, we will discuss some of the fundamental concepts of intellectual property law as they relate specifically to video game companies and other unique players in the space, including esports teams and content creators.
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Getting Creative with Video Games: DMCA Takedowns and You
SEPTEMBER 18, 2019
In this series, we will discuss some of the fundamental concepts of intellectual property law as they relate specifically to video game companies and other unique players in the space, including esports teams and content creators.
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Getting Creative with Video Games: Copyright, Public Domain, and Fair Use
SEPTEMBER 11, 2019
In this series, we will discuss some of the fundamental concepts of intellectual property law as they relate specifically to video game companies and other unique players in the space, including esports teams and content creators.
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Supreme Court: Trademark Owner in Bankruptcy Can’t Cancel Its Trademark Licenses
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The Game of the Name: Making Sure Your Trademark Is Available
AUGUST 29, 2019
In this series, we will discuss some of the fundamental concepts of intellectual property law as they relate specifically to video game companies and other unique players in the space, including esports teams and content creators.
The Game of the Name: Choosing a Trademark for Your Video Game
AUGUST 15, 2019
In this series, we will discuss some of the fundamental concepts of intellectual property law as they relate specifically to video game companies and other unique players in the space, including esports teams and content creators.

Global Protection For Cannabis Trademarks: Real Or Smoke And Mirrors?
JULY 22, 2019

Changes to the Patent Landscape for the Insurance and Financial Industries
JULY 11, 2019

JULY 8, 2019

The U.S. Supreme Court Swears the Lanham Act Violates the First Amendment. Again.
JUNE 24, 2019
The U.S. Supreme Court today struck down the Lanham Act’s bar on immoral or scandalous marks. This client alert discusses the Court’s decision and its impact on future trademark applications.

S1:E10 - Covering Your Digital Assets: Intellectual Property Rights and Gaming
JUNE 19, 2019
Steve and Nick explore intellectual property rights issues in gaming, and discuss recent cases involving alleged copyright and trademark infringement with intellectual property lawyer Gail Podolsky.
Managing an international trademark portfolio is complex. Global companies may have hundreds of trademarks, which need due diligence, prepares agreements and assignments, and advises on IP ownership, licensing, website terms of service, and commercial agreements, acquisitions, divestitures, joint ventures, alliances, and investments. Our team regularly conducts IP corporate, M&A, and private equity practices, our IP transactional lawyers provide expert and efficient advice on IP issues in more than 150 jurisdictions around the world; and attorneys board certified in Intellectual Property Law by The Florida Bar. Our services include:

- Evaluation of government-funded patent and technical data rights
- Patent, trademark, and copyright licensing arrangements
- Endorsements agreements
- Copyright audits
- Copyright applications and registrations and representation of clients before the U.S. Copyright Office
- Passing-off claims
- Global trademark applications, prosecution, and maintenance
- Patent licenses
- Patent applications, prosecution, and representation of clients before the U.S. Patent and Trademark Office (USPTO)
- Trade secrets and related litigation
- Data security and privacy
- Advertising and promotions
- Trademark and branding litigation
- Patent infringement
- ANDA, biosimilars and follow-on biologics, biotechnology

Our team has first-chaired seminal cases that have changed the IP landscape. And our deep industry experience in high-profile cases involving alleged copyright and trademark infringement with intellectual property applications. This client alert discusses the Court's decision and its impact on future trademark marks. This client alert discusses the Court's decision and its impact on future trademark marks.

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Foreign Trademark Applicants, Registrants, and Parties in TTAB Proceedings
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Getting Creative with Video Games: DMCA Takedowns and You
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Stull discusses a pending patent infringement case involving two cannabis companies and there are many obstacles and complexities that cannabis companies face in securing IP.

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7 Tips for Restaurants Switching to Takeout or Delivery-Only "Ghost Kitchens"
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The interactive trademark portfolio tracker provides a quick reference regarding motions and objections that may be made immediately prior to, during, and immediately after trial to preserve issues for appellate review.

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Managing an international trademark portfolio is complex. Global companies may have hundreds of trademarks, which need to be monitored and enforced in various countries. To address this, firms often use tools that can track trademark filings across the globe. One such tool allows clients to view trademark data on a map, with each country marked by a pin. When a client performs a search (e.g., for socks), the tool displays a pin in the relevant country, indicating one or more trademark filings. This feature helps clients navigate the complexities of international trademark management.
contacts/corporate/Carlton-Fields-IP-Transactions.pdf#page=1

Carlton Fields TMap solution enables clients to search and view trademark registrations by specific brands, status (e.g., pending versus registered), and classes (the goods covered by the filing). Clients also can do a full text search for specific keywords.

Clients can access the interactive trademark portfolio tracker to view applicable filings, search and analyze trademark applications, and determine which applications are pending or registered. The user can enter the filing application number and search for the specific application, which will include any previous applications and pending or registered applications.

To learn more about the Carlton Fields TMap solution, contact your Carlton Fields trademark attorney to set up your custom TMap.

Carlton Fields' intellectual property attorneys represent some of the most respected and recognized brands in the world in the most sophisticated and technically challenging IP matters.

Our IP transactional team negotiates and structures complex deals involving IP assets such as patents, trademarks, copyrights, trade secrets, industrial designs, and other forms of intellectual property. As an integral part of Carlton Fields' Technology & IP Transactions team, our attorneys structure and negotiate complex deals involving IP assets.

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Carlton Fields TMap solution enables clients to search and view trademark registrations by specific brands, status (e.g. pending versus registered), and classes (the goods covered by the filing). Clients also can do a full text search for specific terms.

Contact your Carlton Fields trademark attorney to set up your custom TMap.

Related Capabilities

- Copyrights, Entertainment Law, and Publicity Rights
- Patents
- Trademark Portfolio Tracker
- Intellectual Property Litigation
- Blockchain and cybersecurity:
  - R&D, teaming, and collaborative research agreements
  - Marketing, reseller, and distribution agreements
  - IP assignments and ownership changes
  - Patent, trademark, and copyright licensing arrangements
  - Celebrity commercial real estate transactions
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  - Cancellation proceedings
  - Global trademark applications, prosecution, and maintenance
  - Assignments and ownership transfers
  - Patent licenses
  - Cease-and-desist letters
  - Inter partes reviews, post-grant reviews, and covered business method reviews
  - TTAB opposition and cancellation proceedings

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Carlton Fields has developed an intellectual property transactional practice that is integrated into our corporate, M&A, and private equity practices, our IP transactional lawyers provide expert and efficient advice on IP issues in the context of corporate transactions. Our expertise includes copyrights, trade secrets, industrial designs, and other forms of intellectual property. As an integral part of Carlton Fields’ Technology & IP Transactions practice, we advise clients on all aspects of intellectual property law, including copyright, trademark, patent, and trade secret matters.

Our Copyright and Entertainment Practice

Our copyright and entertainment lawyers advise clients regarding the acquisition, sale, and licensing of copyrighted works, including software, music, films, and other creative works. We represent clients in a wide range of industries, including the highly regulated medical device, health care, telecommunications, mechanical devices, and pharmaceuticals sectors. Our team also has deep experience working with clients in the entertainment industry, including esports teams and content creators.

Our Patent Practice

Our patent team has first-chaired seminal cases that have changed the IP landscape. We have a deep industry experience in the technology, medical device, health care, telecommunications, construction, and other fields. Our team provides a variety of patent portfolio services including patent applications, prosecution, and representation of clients before the US Patent and Trademark Office (USPTO). We also represent clients in USITC Section 337 proceedings, patent infringement disputes, and opposition proceedings. Our team also provides advice on patent-related issues such as Nondisclosure agreements (NDAs), noncompetition agreements, work-for-hire agreements, and End-user license agreements (EULAs), app licenses.

Our Trademark Practice

Our trademark practice includes advising clients on all aspects of trademark law, including the evaluation of government-funded patent and technical data rights, Nondisclosure agreements (NDAs), noncompetition agreements, work-for-hire agreements, and End-user license agreements (EULAs), app licenses. We represent clients in a wide range of industries, including esports teams and content creators.

Our Cybersecurity Practice

Our cybersecurity practice includes advising clients on all aspects of cybersecurity law, including Nondisclosure agreements (NDAs), noncompetition agreements, work-for-hire agreements, and End-user license agreements (EULAs), app licenses. We represent clients in a wide range of industries, including esports teams and content creators.

Our Litigation Practice

Our litigation practice includes advising clients on all aspects of litigation law, including Nondisclosure agreements (NDAs), noncompetition agreements, work-for-hire agreements, and End-user license agreements (EULAs), app licenses. We represent clients in a wide range of industries, including esports teams and content creators.

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Prerequisite to a Copyright Infringement Suit

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JUNE 12, 2019

OCTOBER 21, 2019

NOVEMBER 22, 2019

NOVEMBER 25, 2019

FEBRUARY 20, 2020

Back to Basics: A Primer on Intellectual Property Rights in Video Games

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Ending the Plain Language Debate: Text Only

The Orlando Police Department v. Thomas

Inter partes reviews, post-grant reviews, and covered business method reviews

Literal Meaning of Claims

Comparative Claims

Claim Construction

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Carlton Fields has developed an interactive trademark portfolio tracker enabling clients to search and view trademark registrations by specific brands, status (e.g. active, pending, expired), and geography. This solution can also be used to view filings made with the United States Patent and Trademark Office (USPTO) and Foreign Trademark Office (FTO). To learn more information on those filings, click on the pin and use the left and right arrows to scroll through the filings.

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Managing an international trademark portfolio is complex. Global companies may have hundreds of trademarks, which need to be registered, renewed, monitored, protected, and enforced. International trademarks add an array of complexity due to the differences in the trademark systems of different countries. Carlton Fields’s Intellectual Property group specializes in international trademark matters, including registration and maintenance, oppositions, and invalidations. Our team is well-versed in the nuances of trademark law in various countries and can advise on the best strategies for managing a global trademark portfolio.

Carlton Fields has extensive experience in trademark law, including registration and maintenance, oppositions, and invalidations. Our team is well-versed in the nuances of trademark law in various countries and can advise on the best strategies for managing a global trademark portfolio. We can help clients navigate the complexities of trademark law and ensure that their brands are protected both domestically and internationally.
Related Capabilities

RELATED INDUSTRIES
- Technology & Telecommunications

RELATED PRACTICES
- Aviation
- Business Transactions
Carlton Fields TMap: Trademark Portfolio Tracker

Managing an international trademark portfolio is complex. Global companies may have hundreds of trademarks, which need to be registered, renewed, monitored, protected, and enforced. International trademarks add an array of complexity due to varying requirements, translations into new languages, differing local laws, and counterfeiting policies.

Carlton Fields has developed an interactive trademark portfolio tracker for clients to quickly view all of their pending and active trademark registrations worldwide. Each filing is marked on the map with a pin icon; clients can view information on those filings by clicking on the pin.

Contact your Carlton Fields trademark attorney to set up your custom TMap.

MAP OVERVIEW

Carlton Fields TMap solution enables clients to search and view trademark registrations by specific brands, status (e.g. pending versus registered), and classes (the goods covered by the filing). Clients also can do a full text search for specific types of goods (e.g. search for socks). If a country has one or more trademark filings, a pin will display in that country. To get more information on those filings, click on the pin and use the left and right arrows to scroll through the filings.
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