

## Mechanical

### Practices and Industries

---

#### PRIMARY CONTACTS

**Mark A. Tidwell**

+1 713.547.2551

**Dustin T. Johnson**

+1 972.739.6969

---

#### Real World Experience

With over 15 individuals having Mechanical Engineering degrees, the Mechanical Practice Group prides itself not only on delivering the highest quality intellectual property (IP) services in prosecution, litigation and business transactions, but drawing upon prior work experience in doing so. As engineers, our prior work experience included analyzing, researching, designing, simulating, testing, certifying and implementing, among other things, in various technologies and industries such as:

- Motion control systems
- Flight hardware for the International Space Station
- Materials research for flat panel displays
- Electric power industry, including traditional gas and steam-driven turbines, nuclear power and renewable energy
- Manufacturing
- Tooling systems
- Hydrocarbon processing
- Cigarette production
- Municipal and industrial water and waste water treatment and systems
- Alumina refining
- Gypsum board and corrugated paper manufacturing
- Aircraft engine testing and maintenance
- Oilfield services, including tool R&D and offshore oil rig experience
- Network security and software vulnerability
- Custom production test solutions for the Boeing 787 Dreamliner systems (flight controls, networks, cabin systems, landing gear, doors, cargo handling, lighting, etc.)
- Cellular base transceiver stations
- Separation/filtration systems and pressure vessels

The actual work experience of our lawyers in these technologies and industries affords us a better understanding of your business and permits us provide clients with a “whole business” approach to help manage IP, taking into account the need to customize our analysis and service for our client’s particular industry, developmental stage, budget, and individual goals.

## **Prosecution and PTO Representation**

The Mechanical Practice Group has prosecuted and obtained hundreds of mechanical-related patents. We assist our clients in developing a prosecution strategy that best achieves their business goals utilizing both our technical experience, legal experience and practical experience.

Our lawyers have also developed international patent portfolios for clients ranging in size from small start-up companies to mid-market enterprises to large multinational corporations. In this regard, we have developed a network of foreign counsel that provide us with experienced representation with prosecution and other patent matters in numerous countries.

In addition to a robust prosecution practice, our lawyers have experience in more contested matters before U.S. Patent and Trademark Office, including patent reviews and reexaminations, reissues, and other similar proceedings.

## **Counseling and Opinions**

In many cases, patenting an innovative invention is merely one aspect of a client’s overall IP strategy. Our Mechanical Practice Group offers a wide variety of patent counseling services to our clients in order to address the complex IP issues that often face technology companies. We are frequently involved in performing patent landscape analysis and “white space” analysis to help our clients direct their R&D and patenting efforts to maximize both patent protection and enforcement against competitors.

We likewise provide counseling and opinions regarding avoidance of third party IP rights through clearance assessments, freedom-to-operate opinions, product design-around alternatives, and invalidity opinions. We provide counseling in patent portfolio development in view of appellate patent jurisprudence, and can assist clients in developing cost-effective enforcement strategies.

To ensure that clients are identifying and capturing all of their IP, we provide comprehensive due diligence analysis of patent and trade secret rights through complete IP audits, provide training to employees and innovators regarding IP, and develop corporate innovation processes and policies to achieve these goals.

## **Transactions**

We advise clients with respect to a full range of transactional issues, including patent and related IP-diligence and the negotiation and drafting of various agreements in connection with mergers, acquisitions, divestitures, secure financings, and partnering arrangements such as joint venture and distribution arrangements. The Mechanical Practice Group team is familiar with trade secret, patent, copyright, and software issues that arise in the chemical industry.

Our lawyers can address the intersection of technology and contracting. In many technology transactions, the transfer of knowledge involves agreements that include patents, copyrights and software. Our team in this area includes skilled negotiators who routinely draft complex agreements including licensing agreements, master purchase agreements, mergers and acquisitions,

divestitures, business process outsourcing arrangements, secured financing, manufacturing and supply, joint venture, partnering and collaborative research agreements, among other agreements.

These lawyers also provide the deep dive IP due diligence that is often a component of well-rounded counseling regarding such agreements. Such due diligence may include interviewing principles, employees and innovators regarding IP involved in a transaction; identification of patents, copyrights, trademarks and trade secrets that could exist around a transaction; determination of the status of identified IP to ensure rights have not been abandoned, expired or lost; verification of IP ownership through analysis of assignments and chains of title; conducting comprehensive freedom-to-operate studies to identify potential liabilities and ensure IP may be utilized as contemplated by a transaction; analysis of the scope and enforceability of patents and other IP to assist in confirming valuation of IP; and finally, scouring dataroom agreements and documents that could impact any of the foregoing.