




NEAL ■ GERBER ■ EISENBERG

INTELLECTUAL PROPERTY &  
TECHNOLOGY TRANSACTIONS



Our culture of teamwork, focus on client needs and practical solutions, willingness to adapt quickly to meet marketplace demands and drive to be the best providers of legal services are key factors behind the firm's success. Our greatest asset is our people and their dedication to fostering long-term, effective relationships among each other and with each of our clients. The aim of our client-focused approach is to listen to, learn from and respect the needs of each client in order to employ our skill in the delivery of superior legal counsel that best serves the unique needs of the client. Our "client team" approach allows us to draw upon our concentrated practice groups according to client-specific needs for experience, industry knowledge, responsiveness and cost-effectiveness.

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## INTELLECTUAL PROPERTY & TECHNOLOGY TRANSACTIONS

Neal Gerber Eisenberg's Intellectual Property Practice Group is eminently qualified to handle a wide variety of strategic intellectual property counseling, litigation and prosecution matters involving patents, trademarks, service marks, domain names, trade dress, trade secrets, copyrights and advertising claims. Our attorneys are also well versed in helping clients leverage their intellectual property assets through transactions, including developing and negotiating licensing programs, and transferring technology and know-how. We work closely with our Corporate group to create value through joint ventures, mergers, acquisitions and other corporate transactions. Finally, our attorneys are experienced litigators who represent clients in federal and state courts throughout the country, as well as before administrative tribunals such as the Trademark Trial and Appeal Board and the International Trade Commission.

Our attorneys are committed to partnering with our clients to educate them through seminars, presentations and published articles, while simultaneously deepening our understanding of the business models and industry and legal needs that exist. We believe that by formulating a detailed understanding of each client's business through a long-standing symbiotic relationship, we are best suited to providing excellent legal advice geared toward creating market share and generating revenue.

Neal Gerber Eisenberg is recognized as a leading law firm in Chambers USA: America's Leading Lawyers for Business (recommended in "Intellectual Property").

The firm is highly ranked at both national and regional levels in U.S. News- Best Lawyers "Best Law Firms" (within "Intellectual Property" and including a First Tier ranking for the Metropolitan Chicago regional level).

“ Our attorneys are also well-versed in helping clients leverage their intellectual property assets through transactions, including developing and negotiating licensing programs, and transferring technology and know-how. ”

## TRADEMARK COUNSELING, CLEARANCE AND REGISTRATION

Neal Gerber Eisenberg's Intellectual Property Practice Group counsels Fortune 500, multi-national, mid-sized and emerging technology companies, start-ups, non-profit organizations and individuals in all stages of the trademark protection process, including selecting, registering and policing our client's trademarks. More particularly, our attorneys have extensive experience in reviewing preliminary and full search reports and providing written clearance opinions to our clients. This experience also extends to managing and expanding domestic and foreign trademark portfolios and protecting our clients' trademarks through opposition, cancellation and ICANN proceedings and litigation in state and federal courts. Many members of the trademark counseling, clearance and registration group have cleared and registered hundreds of marks and as a group we manage thousands of domestic and international registrations. To ensure that these services are provided in the most cost effective manner, we have also spent considerable time training our paralegals to assist in many of the routine facets of the trademark clearance and registration process.

## LICENSING

In order to fully exploit intellectual property assets, various forms of licenses are sometimes required. Our attorneys have extensive experience in negotiating and drafting trademark, copyright and patent licenses and various technology agreements, including software license agreements, outsourcing agreements, technology transfer agreements and hosting agreements. Moreover, we have represented clients with respect to agreements that range in value from thousands of dollars to more than ten million dollars. We also have a particular skill with respect to negotiating and drafting Internet banking and software development agreements for some of the world's largest banks. Lastly, several of our attorneys have acted, or are currently acting, as in-house counsel for various clients, including overseeing crucial licensing programs.

## LITIGATION AND ENFORCEMENT

Owners of intellectual property assets are often forced to protect their proprietary rights from infringement and misappropriation by others. We have a depth of experience in protecting intellectual property assets, such as patents, trademarks, copyrights and trade secrets, in federal and state courts, as well as in the United States Patent and Trademark Office, the International Trade Commission, and the Trademark Trial and Appeal Board. Our attorneys have been successful in obtaining favorable decisions to protect proprietary rights of its clients at all stages of litigation, including gaining preliminary injunctions, decisions by various district courts and courts of appeal. We have also been successful in negotiating favorable settlements for clients without resorting to litigation in instances where this was in the best interest of the client.

## PATENT COUNSELING AND PROSECUTION

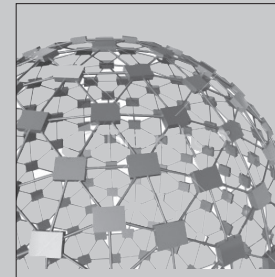
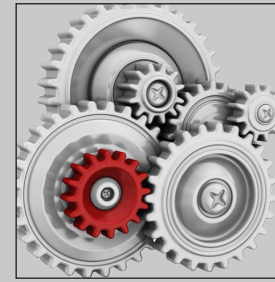
Neal Gerber Eisenberg's Intellectual Property Practice Group includes twelve attorneys and one patent agent who are licensed to practice before the U.S. Patent and Trademark Office. Our patent professionals routinely conduct prior art searches and prepare domestic and international patent applications that are related to various technologies including electrical, mechanical, software and business methodologies. Our attorneys also have significant experience counseling our clients on infringement matters, including preparing written opinions on the infringement and validity of patents owned by our clients or their competitors. Our attorneys are well versed in responding to examiners rejections and objections, appealing to the Board of Patent Appeals and Interferences or the Court of Appeals for the Federal Circuit and representing our clients in reissue and reexamination proceedings.

## COPYRIGHT COUNSELING & REGISTRATION

Copyrightable material is incredibly diverse, including: works of art, such as paintings, drawings, sculptures and architecture; literary works, such as books, publications and technical manuals; computer software code and Web site pages; entertainment works, such as toys, television, radio, musical compositions, advertisements and recordings—and much more. Although copyright laws can provide powerful protection for copyright owners, owners must first identify and protect their works. Neal Gerber Eisenberg's Intellectual Property Practice Group has assisted its clients—from individual writers and musicians to software companies and Fortune 100 companies—in identifying and protecting their valuable works of authorship. This includes registering the works, using proper notice, and, when necessary, prosecuting copyright infringement cases in federal courts. Because our attorneys are also experienced copyright litigators, we bring insight to counseling clients about their copyrights, either before or after a problem arises.

## TRADE SECRET PROTECTION PROGRAMS

Our attorneys help clients protect valuable assets, including trade secrets and sensitive business information. We are particularly skilled in counseling clients in connection with protecting and maintaining their trade secrets and other proprietary information from theft by existing employees or competitors. This includes conducting trade secret audits, preparing confidentiality agreements and employee agreements and providing strategies for implementing appropriate internal protection measures. Our lawyers also counsel clients with respect to the relative advantages of maintaining proprietary assets as a trade secret or other form of intellectual property protection. In addition, we prosecute trade secret misappropriation cases and aggressively protect our clients' valuable assets by obtaining or defending against temporary restraining orders, preliminary injunctions and other court-sanctioned relief.



“ A talented team that can call in the support of colleagues in other departments to offer expertise across a broad array of areas. ”  
- Chambers USA 2010

## TECHNOLOGY TRANSACTIONS & SERVICES

Our attorneys have negotiated some of the largest technology deals of their respective types ever concluded in the U.S. and abroad. Our practice is composed of talented lawyers with backgrounds in business and technology. This well-rounded experience and industry insight allows us to offer innovative solutions to technology-related contracting and legal compliance needs that are within our clients' budgets and timetables. We serve clients in many different industries and geographic locations. On their behalf, we have negotiated the full gamut of transactions.

We serve as a bridge between the technical and business sides of our clients' organizations. Relying on their technology acumen, our attorneys quickly comprehend our clients' technology strategy and then translate the complex legal and business implications of that strategy to decision makers across an organization.

### Outsourcing

We represent both customers and vendors in outsourcing transactions that are often international in scope. Our work ranges from counseling on the outsourcing of entire IT operations and related facilities management processes of major corporations to the selective outsourcing of specific IT functional areas, business processes or particular software applications.

### Enterprise Resource Planning (ERP) System Implementations

The firm's technology transactions attorneys frequently negotiate the terms of the agreements for its clients under which ERP software or systems are licensed, as well as those pursuant to which ERP systems are implemented.

### Security, Confidentiality, Privacy & Data Protection Issues

We counsel clients on issues and concerns relating to security, confidentiality, privacy and data protection. We assist clients in many industries to address and resolve applicable regulatory requirements, including those of HIPAA regulations for health care concerns, the Gramm-Leach-Bliley Act for financial institutions, the European Union's Directive on Data Protection and the U.S. Export Administration regulations for companies with international operations.

### Health Care Technology

Health care technology contracting is a regular component of our technology transactions practice. We represent both health care customers and health care vendors in various technology-related matters. These matters include the licensing of health information systems and other software; consulting services agreements; software-as-a-services (SaaS) or application service provider (ASP) arrangements; and agreements associated with the structuring and operation of regional health information organizations (RHIOs).

### Internet & E-Commerce Related Transactions

Internet and e-commerce related transactions encompass many types of transactions related to the Internet and its use. We represent all sizes and types of customers and vendors in this space and in almost every type of Internet-related transaction.

## REPRESENTATIVE EXPERIENCE

### Patent Litigation

**Philips Electronics North America v. Universal Electronics Inc. (U.S. Dist. Court, Del.).**

Following an eight-day trial, obtained a judgment of non-infringement for Universal.

**Kanzaki v. Sauer Sundstrand and Hydro Gear Limited Partnership (U.S. Dist. Court, Del.).**

Successfully defended Hydro Gear in a patent infringement lawsuit, which was favorably settled the day before trial.

**Universal Electronics Inc. v. Gemstar Development Corp. (U.S. Dist. Court, N.D. Ohio).**

Obtained a favorable settlement for Universal in a patent infringement suit against Gemstar based on a remote control patent.

**Universal Electronics v. U.S. Electronics (Ohio and Illinois).**

Prosecuted two patent infringement lawsuits filed for Universal resulting in very favorable settlements, including a license of its patent.

**Mirada Controls, Inc. v. Amcast Industrial Corporation (U.S. Dist. Court, Minn.).**

Successfully defended a manufacturer of industrial gas valves in patent ownership and infringement dispute.

**Zenith Electronics v. Universal Electronics Inc., (U.S. Dist. Court, N.D. Ill.).**

Obtained summary judgment for Universal with respect to non-infringement of a patent, which was affirmed by the Federal Circuit Court of Appeals. Successfully defended a related action brought before the International Trade Commission.

**Zenith Electronics v. PDI Communications, Inc. (U.S. Dist. Court, N.D. Ill.).**

Represented Zenith in enforcement of patents related to television control systems for use in health care industry. Obtained favorable settlement and license agreement.

**Highway Equipment Company v. Cives Corporation and Monroe Truck Equipment (U.S. Dist. Court, N.D. Iowa).**

Represented Highway Equipment in successful defense of patent infringement. Obtained favorable settlement after filing key dispositive motion attacking Cives' damages positions.

**TransAuction LLC v. Bidz.com, Inc.; eBay, Inc.; Overstock.com, Inc.; uBid.com Holdings, Inc. and Wine commune.com, LLC (U.S. Dist. Court, E.D. Texas).**

Represented uBid.com in defending against "patent troll" lawsuit and obtaining favorable settlement and license agreement.

**Reber v. Sony-Ericsson Mobile Communications (USA) et al. (N.D. Ill.).**

Represented defendant in patent infringement action that was favorably settled.

**Deere and Company v. Tigercat Industries (N.D. New York).**

Represented Deere in patent infringement case and counterclaims that were favorably settled.

**Zenith Electronics v. PDI Communication Systems (N.D. Ill. and Federal Circuit).**

Represented Zenith in patent infringement action that was favorably settled following a decision by the Federal Circuit.

### Trademark Litigation

**Adam's Apple Distributing, L.P. and Phillip Morris, Inc., v. Panaria, Inc. (U.S. Dist. Court, S.D.N.Y.).**

Represented plaintiffs in counterfeit seizure action focusing on original art work owned by Adam's Apple and the Marlboro cigarette box trade dress owned by Phillip Morris.

**Alcar, Inc. v. Corporate Performance Systems, Inc. (U.S. Dist. Court, N.D. Ill.).**

Prosecuted a trademark infringement action on behalf of a financial instruments software developed against a former distributor turned cyber squatter to reclaim an internet domain name comprised of Alcar's registered trademark.

**AOL Inc. v. Advertise.com, Inc. (U.S. Dist. Court, E.D. Va and C.D. Cal.)**

Obtained a preliminary injunction on behalf of AOL based on significant confusion affecting one of the client's leading brands.

**Blackmer Division of Dover Manufacturing v. Sampi SPA, et al. (Florida).**

Represented Dover's Blackmer division in obtaining an emergency order restraining an Italian company from displaying a rotary vane petroleum pump similar in appearance to Blackmer's pump at a trade show in Orlando. The case was settled quickly and favorably to our client.

**World Impressions, Inc. v. Disney Enterprises, Inc. and McDonald's (Illinois).**

Prevailed on summary judgment in this case involving unfair competition, dilution, anti-cybersquatting and related state claims.

**Fruit of the Loom v. Carnation (U.S. Dist. Court, S.D. Cal.).**

Successfully prosecuted trademark infringement suit on behalf of Fruit of the Loom centering on the manufacture and sale of garments bearing the mark FRUITZ.

**GTE Corporation v. Pacific Bell Corporation (U.S. Dist. Court, N.D. Cal.).**

Prosecuted trademark infringement action on behalf of publisher of Yellow Pages and Community Information Directory centering on the registered trademark for the publication.

**Hard Rock Café v. Planet Hollywood (U.S. Dist. Court, N.D. Ill.).**

Defended Planet Hollywood's right to use its famous PLANET HOLLYWOOD mark and trade dress in connection with restaurants and nightclubs in a trade dress infringement dispute centering on the decor and interior design of the venues.

**Keebler Company v. Nabisco Brands (U.S. Dist. Court, N.D. Ill.).**

Represented Keebler in a trade dress infringement action. After a five-day evidentiary hearing, a preliminary injunction was granted to our client against Nabisco's proposed cookie package.

**McDonald's Corporation v. Friedman (U.S. Dist. Court, N.D. Ill.).**

Obtained a Temporary Restraining Order and, ultimately, a permanent injunction and damages in a trademark infringement case for McDonald's Corporation.

**McDonald's Corporation v. Jayasingh, et al. (U.S. Dist. Court, C.D. Cal.).**

Represented McDonald's in obtaining an injunction against the use of a simulation of the "Arches" mark by a medical facility in Los Angeles.

**McDonald's Corporation v. Moses Samuel, d/b/a McFleishig's Express (U.S. Dist. Court, S.D.N.Y.).**

Obtained preliminary injunction and consent judgment in a trademark infringement case.

**Planet Hollywood v. Hollywood Casino (U.S. Dist. Court, N.D. Ill.).**

Prosecuted a declaratory judgment action to defend Planet Hollywood's right to use its famous PLANET HOLLYWOOD mark and trade dress in connection with casino services.

**The Scotch Whisky Association v. U.S. Distilled Products (Illinois).**

Prosecuted a trademark infringement case for The Scotch Whisky Association of Edinburgh, Scotland, which quickly and favorably settled by the defendant by it agreeing to cease use of the mark.

**Sears, Roebuck and Co. v. Great Neck (U.S. Dist. Court, N.D. Ill.).**

Prosecuted trade dress infringement action for Sears centering on products embodying the well known CRAFTSMAN screwdriver handle trade dress.

2010/2011  
RANKINGS

RANKED IN  
CHAMBERS  
USA  
2011

Intellectual Property ■  
Information Technology ■ IT  
Transactions & Services

USNEWS  
Best Lawyers  
BEST  
LAW FIRMS  
2010

Intellectual Property ■  
Information Technology ■ IP  
Litigation & Enforcement ■ IT  
Transactions & Services

**Taylor Made Golf Company, Inc. (various courts)**

Filed and prosecuted over thirty cases asserting infringement of trade dress, patent and trademark rights against defendants in district courts throughout the United States. Obtained temporary restraining, ex parte, seizure and inspection orders, and preliminary and permanent injunctions and damages in several cases. Worked with the U.S. Customs Service to prevent importation of counterfeit goods.

**Times Mirror Magazine v. Lavin (U.S. Dist. Court, S.D.N.Y.).**

Prosecuted a trademark infringement and breach of contract action on behalf of Times Mirror centering on the FIELD & STREAM trademark and the evolving doctrine of inevitable confusion.

**Fair Isaac Corporation and myFICO Consumer Services v. Experian Information Solutions Inc.; Trans Union LLC and VantageScore Solutions, LLC (Minnesota)**

Represented Defendant Trans Union in trademark infringement and antitrust case. After 3 ½ weeks of trial, jury found no infringement and that FICO's trademark was invalid and procured by fraud.

## Copyright Litigation

**Adam's Apple Distributing, L.P. v. Peoples Choice (U.S. Dist. Court, Oregon).**

Successfully tried copyright infringement action, involving affirmative defenses of equitable estoppel and implied license, focusing on original art work owned by Adam's Apple.

**Alvin Goldfarb Jewelers, Inc. v. McDonald's Corporation (Washington).**

Negotiated a settlement in this copyright infringement matter.

**Gang Prevention v. City of Elgin (Illinois).**

Defended the City and negotiated a settlement in a copyright infringement action.

**National Counseling Compensation Insurance v. Insurance Data Resources, Inc. (U.S. Dist. Court, S.D. Fla.).**

Defended a start up business in copyright infringement lawsuit centering on the validity and infringement of copyrights in codes, formulas and related manuals used by licensed workers' compensation rating organizations. The court dismissed the case with prejudice on motion to dismiss holding that plaintiff's alleged copyrights were not infringed, not subject to protection under the Copyright Act, and had entered the public domain. The decision is on appeal in the Eleventh Circuit Court of Appeals.

**Russell v. McDonald's Corporation (Illinois).**

Represented McDonald's Corporation in a copyright infringement case.

**Universal v. U.S. Electronics (Ohio and Illinois).**

Two copyright infringement lawsuits filed by our client, Universal, resulted in very favorable settlements, including a license for its database.

**Alexander Global Products v. McDonald's Corporation, et al. (Pennsylvania)**

Successfully defended McDonald's in a copyright infringement case, including denial of Request for Temporary Restraining Order.

**Pivot Point International v. Charlene Products, et al. (N.D. Illinois and Seventh Circuit)**

Represented Pivot Point in decision that confirmed on appeal the copyrightability of its three dimensional mannequin head sculpture.

## Trade Secret, Unfair Competition and Related Litigation

**CSTV v. Production Group (U.S. Dist. Court, N.D. Ill.).**

Prosecuted a trade secret misappropriation case for a television production company based on the protection of customer list and related information.

**American Bank Card Corporation v. Peachtree Corporation (U.S. Dist. Court, N.D. Ill.).**

Defended false advertising suit brought under Section 43(a) of the Lanham Act relating to advertisement of credit card processing services.

**900 Service Corporation v. Bernard (Cir. Court, DuPage County, Ill.).**

Represented closely held 900 telephone number service provider in action against shareholders and prior counsel seeking return of stock.

**Alcar, Inc. v. Corporate Performance Systems, Inc. (U.S. Dist. Court, N.D. Ill.).**

Prosecuting a breach of a distributorship agreement on behalf of a financial instruments software developed against a former distributor.

**JBA International v. Ballet Makers, Inc. (New Jersey Superior Court).**

Successfully defended a breach of contract action relating to a software license customization and maintenance agreement.

**Kronos Central Products v. Miami Subs Corporation (U.S. Dist. Court, N.D. Ill.).**

Represented well known local distributor of restaurant supplies and food products in breach of equipment loan agreement.

**Laramore v. Chicago White Sox (U.S. Dist. Court, N.D. Ill.).**

Represented Chicago White Sox in defense of a race discrimination claim brought against it, the City of Chicago and the Illinois Sports Facilities Authority in a race discrimination claim brought under § 1983. (See 1996 U.S. Dist. Lexis 3964).

**O&K Trojan, Inc. v. Muratore (U.S. Dist. Court, S.D.N.Y.).**

Represented manufacturer of large construction equipment in a RICO action centering on the use of fictitious escrow agreements to fraudulently misdirect payments on multimillion dollar contracts with the City of New York. (See 751 F. Supp. 431).

**TEAC Corporations v. DZU Technologies (U.S. Dist. Court, N.D. Cal).**

Successfully prosecuted breach of contract and bankruptcy actions on behalf of TEAC Corporation to capture sole interest in previously, jointly owned patents relating to hot swappable disk drives.

## Intellectual Property Counseling

Regularly advise **The Nielsen Company** regarding the control and licensing of its rating estimates through the internet and traditional media.

Regularly advise **Polaroid** concerning its extensive licensing portfolio and its licensing strategies.

For **General Growth Properties**, monitored the registration of domain names comprised of the names of its over 150 shopping malls, and successfully initiated ICANN proceedings when necessary to retrieve the domain name.

Advised **Sears** regarding the scope of its rights in its famous DIEHARD, CRAFTSMAN and KENMORE marks, and then designed an effective strategy to identify infringing uses of these marks in the web and in domain names. This involved prioritizing the level of infringing conduct and taking appropriate action through demand letters, infringement actions and ICANN proceedings to prevent the erosion of Sears' rights in its marks.

Regularly advise **McDonald's** regarding policing its trademark rights in its marks.

Regularly advise **McDonald's** regarding patent, trade secret, and copyright matters involving their point of sale systems and other technologies.

Regularly advise **Walgreen Co.** regarding patent protection involving their pharmacy systems, distribution systems, and other technologies.

Manage and regularly advise **TransUnion LLC** regarding all of its intellectual property matters.

Represented national dental insurance program in all matters relating to the use and exploitation of its service marks, including establishing its licensing procedures.

Represented well known electronics company in licensing a patent portfolio relating to CD recorders and players.

Represented **TEAC Corporation** in licensing a patent portfolio relating to hot-swappable disk drives and other electronics products.

Regularly represents clients on issues relating to disseminating intellectual property and conducting promotional activity over the Internet.

Represented well known electronics company in negotiating resolution of trade secret misappropriation issues focusing on conduct of its former technical representative.

Represented prominent fashion retailer in negotiating the termination of several distributorship agreements conveying exclusive distribution rights for signature perfumes.

Represented a large security business in negotiations for the division and sale of its trademarks for \$10 million dollars.

“*Methodical and thorough —  
is always a step or two ahead.*”

- Chambers USA 2010

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