

BSTZ Profile

In 1975, Roger Blakely, Stanley Sokoloff, Edwin Taylor, and Norman Zafman launched a new partnership in an effort to provide high-quality intellectual property-related services at a reasonable price. Since then, Blakely Sokoloff Taylor & Zafman LLP ("BSTZ") has grown 20-fold and is consistently ranked as one of the top intellectual property law firms nationwide. In fact, BSTZ now represents many of the top 100 technology companies in the United States, as well as several of the most successful companies throughout the world. Despite its growth, BSTZ has managed to maintain a personable relationship with its clients and still provide high-quality services at a reasonable price.

In an effort to better serve its expanded client base, BSTZ has six offices throughout the western United States: Los Angeles, Sunnyvale, and Costa Mesa, California; Beaverton, Oregon; Denver, Colorado; and Seattle, Washington.

The attorneys at BSTZ have quite diverse backgrounds and are uniquely qualified to meet the varying needs of its clients. In addition to their legal degrees and qualifications, a vast majority of BSTZ attorneys hold engineering or science degrees while others have worked as patent examiners or trademark examining attorneys at the United States Patent and Trademark Office. Many attorneys were also employed in industry before starting their legal careers. As such, BSTZ attorneys have valuable expertise in a variety of fields, including but not limited to electronics, software, computer architecture, networking, semiconductor and material processing, navigation systems, mechanical devices, biological sciences, chemistry, manufacturing processes and biomedical equipment.

BSTZ attorneys skillfully prepare and prosecute patent and trademark applications in the United States to obtain international protection. The work has paid off. In recent nationwide surveys rating the quality of patents, BSTZ has ranked at or near the top in the following areas: chemical, computer software, mechanical, electrical and medical. BSTZ also consistently ranks in the top ten firms nationwide for obtaining trademark registrations.

In addition, BSTZ provides specialized intellectual property support for corporate and general practice law firms, which includes high technology litigation, due diligence investigations, opinions of counsel, cancellation and opposition of trademark or service mark registrations, and preparation of high technology licensing agreements.

BSTZ also represents clients in lawsuits in a variety of areas, including patent rights, trademarks, copyrights, misappropriation of trade secrets, unfair competition, right of privacy and United States Customs enforcement matters.

Intellectual property law is now more international in scope than ever before. Such factors as the emergence of the European Union and the Pacific Rim as major economic forces have changed the way the world does business, demanding a global perspective and capability. In view of this rapidly changing environment, BSTZ's practice has become increasingly international in scope, as the number of multinational corporations and foreign-based companies that BSTZ represents continues to grow. BSTZ meets the needs of these clients with a worldwide filing capability and established contacts with foreign associates handling intellectual property matters in more than 100 countries around the world.

From its inception, BSTZ has played a major role in helping clients develop new ideas and bring them to market. BSTZ continues to protect the fruits of its clients' imagination by providing excellence in legal counsel and successfully meeting the diverse needs of its clients in the 21st century.

Patent Law

Blakely Sokoloff Taylor & Zafman LLP ("BSTZ") enjoys a premier reputation and well-established practice in all areas of patent law, including the preparation and prosecution of applications for patents, patent licensing and patent infringement litigation (at both the trial court and appellate levels).

BSTZ offers technical expertise in a broad range of technologies, including computer software and hardware, workstations, microprocessors and related semiconductor devices, and in an assortment of analog and digital electronics outside of the computer field. In addition, our Firm's members, consisting mostly of attorneys and patent agents who have passed the patent bar, are also educated and experienced in most of the other technical arts, including mechanical, electro-mechanical, biotechnical and chemical.

During the prosecution stage, our Firm's members rely upon their skill and experience in the procedural course mandated by the Patent Office. In addition to their understanding of Patent Office procedures, our Firm's members bring a thorough knowledge of the substantive Patent Law to bear when responding to Office Actions, filing petitions to the Commissioner of Patents & Trademarks, provoking an interference, filing for reissue or re-examination of a patent, appealing cases to the Board of Patent Appeals, and, if necessary, taking an appeal to the courts. Survey after survey rates patents drafted by BSTZ at or near the top in terms of patent quality, specifically in the following areas: chemical, mechanical, electrical, medical and computer software patents.*

BSTZ also has long-established relationships with foreign patent firms spanning the world. These foreign associates assist in the international filings of patent applications on behalf of our clients. Applications for foreign patents are filed under the Patent Cooperative Treaty, as well as directly in numerous industrialized nations abroad. Conversely, BSTZ has a large foreign clientele on whose behalf we file applications for United States patents claiming inventions made in other countries.

After obtaining a patent, BSTZ provides counsel to its clients in all facets of enforcing and exploiting the issued patent. For example, BSTZ may represent a patentee in an infringement suit to enforce its patent rights, or engage in negotiations with qualified manufacturers for licensing the right to make, use and sell a patented invention. BSTZ also defends clients accused of patent infringement. In such matters, the Firm's members are skilled in the adjudication of such issues as the validity of the patent in suit, claim construction and whether the accused product or process infringes the patent being enforced.

BSTZ also conducts patent-related searches such as (i) broad searches to explore the state of the art in a particular field; (ii) patentability searches to determine the likelihood of obtaining a patent on a particular invention; (iii) infringement searches to determine whether the claims of any patents might be infringed by the manufacture, use or sale of a client's product; and (iv) validity searches to uncover prior art patents that might be cited to support an argument that a particular patent is invalid. The results of the above-described searches are analyzed and opinions are then rendered based upon such analysis. Such searches are both domestic and international in scope, and usually include searches for pertinent literature in the field as well as patents.

In addition, BSTZ offers clients other specialized patent-related services. For example, if a client is acquiring a technology-based company, BSTZ reviews and evaluates the patent portfolio as part of a "due diligence" process. The records of the Patent Office are also researched to confirm a clear chain of title, and prior art searches are conducted to verify validity. Every effort is made to ensure that the client's interests are protected.

* See, for example, *IP Law & Business*, "The Q Factor," March 2004.

Trademark Law

Blakely Sokoloff Taylor & Zafman LLP ("BSTZ") offers a comprehensive trademark practice, counseling its clients in connection with all aspects of trademark clearance, prosecution, oppositions and cancellations, maintenance of registrations, licensing, co-existence agreements, enforcement, and trademark due diligence in connection with corporate transactions. BSTZ maintains a network of select international associates, with which it works closely in connection with non-U.S. trademark matters.

Clearance and Prosecution - Prior to filing an application for federal registration, BSTZ recommends conducting a trademark availability search to determine whether the proposed mark is available for the client's use and registration. The availability search includes a search of the Federal Register, state trademark registries, common law and trade name databases, domain names, and the Internet. BSTZ attorneys analyze the results and provide the client with an opinion as to availability. If a mark is determined to be available, preparation and filing of an application for federal registration typically follow. BSTZ attorneys monitor Office Actions and prepare responses and, upon registration, docket deadlines for filing of use affidavits and renewals. Most importantly, BSTZ attorneys work with clients to develop trademark protection strategies, manage trademark portfolios, and maintain registrations. Reports on the status of the client's registered and pending marks before the various trademark offices throughout the world are regularly reviewed and periodically forwarded to the client.

International - The U.S. accession to the Madrid Protocol presents a unique opportunity for clients to seek international registration of their marks through the Madrid systems. BSTZ attorneys are well versed with Madrid procedures and the various considerations a trademark owner must contemplate prior to determining whether to file a Madrid Protocol application, a foreign national application, or an application to register a mark in the European Union (CTM). BSTZ works with a solid network of international associates, who handle national and CTM trademark filings, oppositions, cancellations, and litigation and anti-counterfeiting activities outside the U.S.

Policing and Enforcement - BSTZ offers multiple services to protect a client's mark. Of utmost importance is policing against infringement of a client's trademarks by third parties. A client may request a watching service, which continually searches for identical or similar marks worldwide and submits regular reports to BSTZ. Should the watching service uncover a potentially infringing mark, BSTZ advises the client and provides counsel as to the course of action to be undertaken to abate such infringement, including preparing cease and desist letters where appropriate and pursuing all legal remedies, if necessary.

Internet Domain Names - With the importance of the Internet in today's business environment, a significant part of BSTZ's trademark practice is dedicated to the acquisition and protection of domain names. BSTZ attorneys are experienced in representing clients in domain name and cybersquatting disputes including through ICANN's arbitration procedures.

Transactional - BSTZ attorneys regularly handle a variety of agreements concerning Intellectual Property including license agreements and co-existence agreements, and are experienced in conducting trademark due diligence in connection with acquisitions or other corporate transactions.

Litigation

Blakely Sokoloff Taylor & Zafman LLP (“BSTZ”) has played a successful and active role in enforcing its clients' patents, copyrights and trademarks, and in defending clients in cases involving the same. The subject matter varies from Apple Computer's windowing and Sony's video editing equipment, to WET Enterprises' water ejection device used at the Bellagio Hotel in Las Vegas, Nevada. BSTZ is staffed with veteran litigators experienced in prosecuting and defending cases involving trademark infringement, trademark dilution and unfair competition. BSTZ's expertise extends to clients in many industries, in defense and prosecution of claims involving grey market goods, monopolization, price fixing, price discrimination, tying and exclusive dealing arrangements.

Because BSTZ believes in counseling its clients in preventive law, our attorneys carefully review all types of transactions in an effort to minimize their exposure to expensive litigation. However, if litigation ensues, the Firm will zealously protect and enforce its clients' interests.

BSTZ also has expertise in counseling its clients on protecting their intellectual property rights in Asia and in the European Community. In this connection, we have initiated litigation in foreign countries, including Hong Kong, Taiwan and Korea. Our Firm's attorneys also frequently interact with U.S. Customs to assure that our clients' goods bearing registered trademarks or covered by copyrights or patents are protected from infringement.

Copyright Law

Blakely Sokoloff Taylor & Zafman LLP (“BSTZ”) maintains a substantial practice in the field of copyright law, protecting a variety of copyrightable works ranging from computer software and mask works to literary and artistic works including books and songs. BSTZ is set up to provide clients with complete copyright service, including the preparation of copyright applications, assignment of copyright interests, and licensing and enforcing copyrighted works.

BSTZ has a long history of providing expertise in the area of copyrights. As co-counsel, our Firm successfully represented one of its major clients, Apple Computer, Inc., in a copyright infringement case relating to Apple's “windowing” (*Apple Computer, Inc. v. Franklin Computer Corporation*, 714 F.2d 1240 (3d Cir. 1983), cert. denied, 464 U.S. 103 (1984)). Throughout the years, BSTZ has continued to stay on the leading edge of changes in copyright law. For example, BST&Z recently achieved a successful result for a client in a case involving the recently enacted Digital Millennium Copyright Act.

To support its copyright practice, BSTZ utilizes in-house copyright databases to conduct copyright searches. When necessary, full title and assignment searches are recommended, particularly in the entertainment field.

Agreements/Licensing

Blakely Sokoloff Taylor & Zafman LLP (“BSTZ”) has extensive experience in negotiating and drafting all types of agreements relating to intellectual property. The most common is assigning or licensing intellectual property rights.

Assignments and Licenses typically involve the exchange of certain rights, including the rights to use (i) certain technologies or devices (protected by patents and trade secrets law), (ii) computer software, musical scores or cartoon characters (protected by copyrights), and (iii) trademarks or service marks. BSTZ also helps franchisers and franchisees acquire or grant certain rights, which is a particular species of licensing. Licensing today has grown into a multi-billion dollar industry in the United States, and BSTZ has the expertise to assist clients every step of the way.

BSTZ also has broad experience with (i) agreements between companies to jointly develop new technology and products; (ii) agreements between companies where one company agrees to test and evaluate the new technology and products of another company; (iii) agreements with experts for a variety of consulting services; and (iv) confidential disclosure agreements, which enable inventions, inventive concepts and other types of confidential information to be disclosed by one party to another. BSTZ also assists clients with buying or selling intellectual property assets, and determining the value of such assets.

International Filing Department

The International Filing Department of Blakely Sokoloff Taylor & Zafman LLP works with an extensive global network of foreign associates able to file in all offices, countries and regions throughout the world, including the EPO (European Patent Office) and countries that are part of the CTM (Community Trade Mark), the MDP (Madrid Protocol) and the PCT (Patent Cooperation Treaty). Over the past 25 years BSTZ has developed and maintained strong relationships with our foreign associates to create a dependable and high-quality network to service our clients' international patent and trademark needs.

BSTZ understands and appreciates the importance and value of quality international patent and trademark protection. The scope of desirable international patent and trademark protection depends upon assessment of the potential market for the patented invention or the level of importance of the mark to the client. Under treaty provisions, applications for registrations in all participating countries may be based on the U.S. application for registration and be accorded the filing date of the U.S. application, provided that the foreign applications are filed within one year (for utility patents) or six months (for trademarks and design patents) of the U.S. filing date.

Our principal associates in Asia are

Shinsung International Patent & Law Firm (Korea)
You Me Patent & Law Firm (Korea)
Koreana Patent & Law Firm (Korea)
Nakamura & Partners (Japan)
Yamakawa International Patent Office (Japan)
China Patent Agent (H.K.) Ltd. (Hong Kong)
Runping & Partners (China)
Lee and Li (Taiwan)

Our principal associates in Europe are

Jeffrey Parker & Co. (CTM and UK)
W. P. Thompson & Co. (UK and EPO)
Harrison Goddard Foote (UK and EPO)
Samson & Partner (Germany and EPO)
Zenz, Helber & Hosbach (Germany and EPO)
Fumero - Studio Consulenza Brevetti (Italy)
Cabinet Regimbeau (France)
Elzaburu (Spain)

Our principal associates in North America are

Riches, Mckenzie & Herbert LLP (Canada)
Clarke, Modet & Cía. de México (Mexico)
Noriega Y Escobedo (Mexico)

Other associates include

Dannemann, Siemsen, Bigler & Ipanema Moreira (Brazil)
Davies Collison Cave (Australia)
A J Park & Son (New Zealand)
Don Hopkins and Associates (New Zealand)
Sena & Berton Moreno (Argentina)
Alban Tay Mahtani & De Silva (Singapore)
Drew & Napier (Malaysia)

Offices

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*A Limited Liability Partnership including Law Corporations
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Partnership Including Law Corporations

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