



Intellectual Property & Technology

Protecting your IP rights is our priority

Managing and aggressively protecting intellectual property and technology assets is at the center of business today. At Masuda Funai, we work with domestic and international companies of all sizes on the development, protection, sale, transfer and licensing of IP, inventions and information technology, proprietary information and business method processes — across the country and around the world.

Our attorneys identify and protect trade secrets, proprietary processes and practices, patents, trademarks, copyrights and Internet domain assets. We conduct audits of intangible assets, as well as draft and enforce IP rights, trade secrets and privacy policies and procedures. We provide training for management and employees on trade secret protection including confidentiality, non-disclosure, works-for-hire and non-competition issues. In addition, we prosecute trademark applications and execute patent, trademark, trade name, corporate name and registration searches, as well as represent clients before the U.S. Patent and Trademark Office (USPTO) and the Trademark Trial and Appeal Board (TTAB).

Regarding electronic commerce, we identify and advise on emerging legal issues such as privacy, allocation of territorial rights for cyberspace sales and risk management of tax and legal action in remote jurisdictions. We prepare website terms of use, privacy and security policies and other clickwrap agreements, as well as advise on e-mail practices, metatags, framing, linking, cybersquatting and contracting for web development and hosting services.

We are well-versed in the technologies that support business and drive commerce. Our attorneys negotiate development, integration, implementation and maintenance agreements for ERP, CRM, database, website and other types of information systems for clients that develop and market such technologies or services including hardware, software and consulting. We negotiate and form strategic partnerships and technology joint ventures with particular skill in heavy industry and manufacturing. We also advise on all aspects of investments in technology start-ups, joint ventures, research collaborations and strategic alliances, particularly where the partners are of different nationalities and cultures. In addition, we counsel clients in connection with universities and private research foundations regarding licensing policies, procedures and ownership.

Our litigators vigorously defend each client's IP and technology rights, from the initial cease and desist phase through and including injunction proceedings, trial, mediation and/or favorable settlement. We resolve disputes involving unfair competition, patent/trademark/copyright infringement, trade dress, trade secret misappropriation, counterfeiting, trademark dilution, domain name and comparative advertising claims. We also prosecute cases against departing employees who improperly use sensitive, hard-earned customer IP and proprietary data, and counterfeiting by unauthorized product sellers.

Range of Services

IP Litigation

Intellectual property is an essential asset and component of practically every business today. In the event an IP dispute arises, companies of all sizes require effective solutions that not only protect IP assets, but also mitigate potential loss or maximize their recovery of resulting damages. Masuda Funai litigators understand the absolute need to safeguard IP and rigorously defend or assert each client's rights across the U.S. and beyond.

We are acutely focused on the distinct commercial objectives surrounding our clients' IP assets and portfolios. We are skilled in litigating IP disputes in state, federal and appellate courts, in alternative dispute resolution forums, and in advocating our clients' positions before the U.S. Patent and Trademark Office (PTO), Trademark Trial and Appeal Board (TTAB) and International Trade Commission (ITC)

Our attorneys represent clients in the enforcement of their rights and defense of claims of others, from the initial pre-suit investigations through to conclusion — whether by settlement, mediation or litigation. Our experience includes the resolution of disputes pertaining to patents, copyrights, trademarks, trade dress, trade secrets, domain names, counterfeiting, comparative advertising, technology transfers, licensing, franchising, false advertising, unfair competition, non-compete and non-solicitation clauses, as well as antitrust litigation with an IP component. We also provide pre-litigation counseling and opinions of counsel in support of litigation or anticipated litigation.

Our firm is experienced in asserting our clients' patent rights and defending our clients against the patent rights of others through all phases of patent disputes including preliminary injunction proceedings, Markman hearings, jury and nonjury trials and appeals. Our experience includes "bet-the-company" type patent litigation against competitors, defense against patent claims brought by non-practicing entities ("patent trolls") and ITC actions, as well as representation before the PTO in post grant proceedings, including inter parte reviews. We also deliver a business-oriented perspective to complex trademark disputes, and understand all facets of the Lanham Act and related federal and state laws.

Our litigators defend each client's valuable trade secrets. We have successfully litigated claims pertaining to misappropriation, breach of nondisclosure, confidentiality and noncompetition agreements, as well as idea/invention theft, unfair competition claims and related insurance actions. We aggressively defend clients against competitors who have stolen, hijacked or pirated client domain names and IP on the internet by responding quickly to restore the misappropriated asset and rectify the wrongdoing. In addition, we advocate our client's rights in domain name disputes under ICANN's Uniform Domain Name Dispute Resolution Policy.

Intellectual Property Licensing & Transactions

Intellectual property has increasingly become the primary asset in many corporate and transactional matters. Regardless of the technology or product, Masuda Funai provides both the practical legal and business experience needed to negotiate and close IP intensive deals in competitive and sophisticated markets. We work closely with our clients to understand their specific commercial drivers and the IP components involved in

each deal, successfully closing valuable transactions and licensing agreements across a broad range of industries and jurisdictions.

Our attorneys assist clients in establishing corporate structures, formulating strategic and commercial transactions and assisting in the sale and acquisition of companies or defined assets which are key to achieving our client's goals. We have been involved in executing technology development transactions, acquisitions and divestitures, strategic alliances, joint ventures and partnerships. This experience includes due diligence in connection with acquisitions, sales and contract negotiations involving the transfer or apportionment of IP rights in mergers and acquisitions, distribution and sales arrangements and technology procurement.

We negotiate licenses to, and assignments of, trade secrets, know-how, patents, trademarks, copyrights, software and other intangible assets. We advise our clients regarding territories, exclusivity, fees and royalties, technical assistance and support, enhancements, infringement indemnifications and escrows, with a particular understanding of the nuances of obtaining or granting exclusive rights for cross-border territories. We are also involved in executing and enforcing commercial contracts such as co-promotion, outsourcing, manufacturing and supply agreements. Our attorneys have proven time and again that they know how to leverage a myriad of transaction structures involving proprietary brand, media, technology, data, content and other intangible assets.

In addition, our firm advises on even the most complicated international agreements, which can involve a higher degree of difficulty. We not only understand the law and challenges associated with cross-border agreements, but also the often unique business environments of both clients and their constituents alike.

Trademarks & Service Marks

Because every business is unique, Masuda Funai delivers the requisite knowledge and flexibility to protect each client's valuable trademarks and service marks. In advising on new marks, we analyze such factors as the maturity of the mark, anticipated investment, and the duration of use of the mark within our client's IP portfolio. We conduct availability searches and advise on comprehensive trademark analysis. We prepare trademark and service mark applications filed with the United States Patent and Trademark Office (USPTO), and closely monitor applications to ensure all actions or other requests are immediately responded to and addressed.

In addition, we render trademark validity and infringement opinions, negotiate and draft trademark licenses and franchise agreements, as well as protect such assets in mergers, acquisitions, investments and due diligence endeavors. We also counsel our clients on using their marks correctly by identifying possible problems before a conflict can arise, as well as by searching, clearing, filing and registering trademarks, service marks and domain names in the U.S. and abroad.

Our firm has developed a strong and deep network of foreign associates around the world that can assist us in protecting our client's IP assets. We have adopted a seamless process with our foreign associates in order to safeguard our client's IP assets internationally.

Notably, our attorneys file and defend trademark and service mark Oppositions and Cancellations before the Trademark Trial and Appeal Board (TTAB), as well as defend our client's trademarks and service marks in civil actions, Uniform Domain-Name Dispute-Resolution Policy (UDRP) domain proceedings, and before other global administrative bodies. We aggressively fend off cybersquatters, typosquatters and metataggers, as well as litigate disputes involving trade dress, trade names, unfair competition and comparative advertising.

Patent Counseling

Masuda Funai is dedicated to assisting our clients in monetizing their patent portfolios. Our attorneys advise on owning, managing and leveraging patents and large patent portfolios both in the U.S. and abroad. Our experience includes patent portfolio management and development, rendering opinions and due diligence evaluations, and negotiating and closing complex domestic and cross border transactions involving valuable patented assets. We advise domestic and international businesses ranging from start-up ventures whose entire existence depends upon a patent, to international enterprises with extensive IP portfolios doing business in the U.S. and on a global scale.

Our attorneys analyze the patentability of new products and inventions. Our legal counsel includes creating practical patent, patent portfolio and infringement strategies and patent-related appeals, petitions and protests. We vigorously advocate our client's position in reexaminations, reissues and post-grant proceedings, as well as prosecute and defend litigation claims involving patents in state and federal courts.

Our bigger picture view of patents and patent law is driven by our commitment to understanding each client's target market, industry and long- and short-term business objectives. We are sensitive to our client's specific goals regarding ROI, and work diligently within their budgetary requirements to realize financial goals while safeguarding their patents at every turn. Our clients appreciate that we serve as collaborators who provide pragmatic solutions to complex patent issues, outstanding work product and responsiveness to their specific needs.

Brand Protection, Management & Enforcement (portfolio management/brand management)

Masuda Funai appreciates that a company's brand is its most important asset. As a result, we take the concerns and interests of each client seriously, and believe that the right approach to protecting and managing their IP portfolio requires a multi-step, collaborative effort that balances legal issues and commercial objectives.

So that our clients can properly manage and leverage their brand, our attorneys advise on promotional strategies, the selection of strong patents, trademarks and service marks, providing clearance opinions, and executing effective methods for IP use on a global scale. We continuously monitor each client's IP in order to prevent infringement of their valuable rights, including enforcement against infringers of their patents, trademarks, service marks, domain names, copyrights, trade secrets and other confidential or proprietary

information. We have established a strong track record of cease and desist actions and work with clients to determine if litigation is necessary to protect their interests.

Our firm offers a deep understanding and substantial experience in negotiating and drafting complex, multi-level IP agreements that support brand development. We have drafted, negotiated and executed licensing transactions and supplemental agreements in multiple industries and jurisdictions, representing some of the largest companies in the world in their licensing efforts. In addition, we are involved in IP due diligence in connection with mergers, acquisitions and other corporate transactions, as well as provide opinions with respect to the risks of a target company's IP portfolio.

In the ever-changing world of social media, we advise on disparagement, online infringement of IP, the use of our client's IP on social media, privacy, waivers, releases and publicity matters, contests and sweepstakes, and the sale of products and services online. We develop and help our client's to execute comprehensive IP and social media policies, and prepare up-to-date privacy policies and website terms and conditions that are compliant with the latest federal and state laws for this area.

Data Privacy & Security

Companies of all sizes continue to develop and utilize new technologies and data to expand their market share and increase their profitability. In this interconnected and global economy, businesses are more reliant than ever before on technology and data. As a result, company owners and managers must be resilient, diligent, agile, flexible and responsive when identifying, managing and responding to cyber commerce issues and safeguarding themselves from the pitfalls associated with data privacy protection and security.

Masuda Funai advises on a broad range of privacy and data protection matters. Our firm is dedicated to helping clients take advantage of converging technologies and industry by analyzing the threats and leveraging the opportunities digital media offers. Our clients range from domestic and international businesses from a multitude of industries; to advertisers and marketers; to content developers, distributors and owners; to investors in digital media both in the U.S. and abroad.

Our attorneys are involved in the development and ongoing management of website privacy policies, information handling, security breaches and global compliance endeavors. We advise on cross-border data transfers, training and compliance programs, privacy and security audits, and privacy policies and procedures. In addition, we advise on the privacy and security issues that permeate commercial transactions, as well as negotiate and close such deals. We also counsel our clients on data use development, strategy and compliance in advertising, marketing and other commercial initiatives.

Because the potential for the misuse of sensitive and personal information has the attention of lawmakers around the world, as well as and plaintiff class action counsel in the U.S., we work tirelessly with each client to apply existing and emerging regulations and guidelines to the privacy and data security challenges associated with consumer communication and digital media. We are dedicated to helping our clients legally and efficiently transfer customer, employee, financial and other information around the globe by analyzing and minimizing the risks of electronic commerce.

Trade Secret Protection

Trade secrets are valuable assets and include information, processes or devices that have monetary or commercial value and should be considered confidential. In addition to business plans, trade secrets can also include contracts, formulas and clients lists. At Masuda Funai, we know, from decades of identifying, advising on and defending trade secrets, that new and emerging technologies, expanding employee mobility and globalization have created an atmosphere of accelerated risk regarding trade secrets.

Our firm understands the critical nature of trade secrets and the sensitivities involved in claims against employees. Our attorneys provide both the skill and experience needed to represent businesses in proactive counseling measures, dispute resolution and litigation involving the protection of proprietary information against unauthorized commercial use by others. Unlike patents, copyrights and trademarks, businesses cannot register and therefore safeguard trade secrets with the government. Because a trade secret is only considered proprietary information if it is protected from disclosure, our lawyers work diligently with businesses to keep such information private and confidential — and away from competitors and the public eye.

We represent businesses from across the nation and around the world in asserting and defending claims of trade secret misappropriation, unfair competition and employee theft before federal and state courts and public agencies. We assist our clients in creating, implementing and managing trade secret policies and procedures under the federal Defend Trade Secrets Act (DTSA), Uniform Trade Secrets Act (UTSA) and other state laws. We work with our clients to evaluate and identify options for implementing a comprehensive trade secrets strategy that reaches beyond state and country lines and into e-commerce and online media. In addition, we advise on internal actions that mitigate the potential for trade secret theft and litigation.

Copyright & Digital Media

Online media, e-commerce and technology have made the registration and continuous protection of copyrighted material an essential component of maintaining and expanding a successful brand. Masuda Funai understands all facets of copyright law, registration and protection, and our attorneys have been involved in guiding businesses through the challenges and obstacles associated with new frontiers and laws that regulate digital media.

Our experience includes the identification, registration and application of copyrightable items including materials, ideas and methods. We counsel our clients on authorship, copyright notice and ownership, including work-for-hire arrangements and derivative work analysis. We also advise on copyright-related terms, conditions and materials in the public domain that are scheduled to expire or have already expired, as well as regarding fair use assessments. Moreover, we render legal counsel regarding all aspects of the Digital Millennium Copyright Act (DMCA), online copyright use and infringement.

As most transactions today involve some form of IP, our firm is frequently involved in negotiating and closing deals and agreements that include copyrighted content, licenses and assignments, as well as agency,

exhibition, publishing and royalty matters. We have negotiated technology and content-driven transactions such as digital content licensing, distribution and supplier agreements, as well as agreements pertaining to integrated marketing, entertainment and Internet/wireless technologies. We also advise on privacy protection in emerging media channels and new and fast-growth market segments.

Our firm works with domestic and international clients to understand and leverage the benefits of registering copyrights with the U.S. Copyright Office, which is not a legal requirement but presents advantages for our clients.