

## PRACTICE

# Patent Prosecution

Benesch's Patent Prosecution Practice Group helps clients secure, protect and monetize the value of their innovations worldwide. Composed of accomplished attorneys, engineers, former in-house IP counsel, scientists, patent agents and former patent examiners, our team provides comprehensive patent prosecution and portfolio management services to clients ranging from startups to global enterprises.

## What We Do

- Manage global patent portfolios and prosecute patent applications in the United States and around the world, including throughout North America, Europe, Asia and South America
- Conduct patentability, enforceability, freedom-to operate and risk analyses through comprehensive patent searches, including state-of-the-art searches and right-to-use searches
- Represent clients before the U.S. Trial and Appeal Board and foreign patent offices in examinations, appeals and post-grant issues and proceedings, including post-grant reviews, inter partes reviews, reexaminations and oppositions
- Draft and negotiate patent-related agreements, including licenses
- Advise on issues involving patent infringement, validity and enforceability

## Industry Breadth

- Artificial intelligence (AI) and machine learning
- Biology and chemistry
- Computer science
- Manufacturing and energy
- Materials science and metallurgy
- Mechanical and electrical engineering
- Medical devices
- Pharmaceuticals

## Numbers & Recognition

10+

**Dedicated attorneys and patent agents**

## Recognized

**in Intellectual Property**  
by Chambers



## Ranked Nationally

**in Patent Law**  
by Best Law Firms®



## Representative **Matters**

- ▶ Counseling a diversified technology company and Nasdaq 100 member operating market-leading businesses that design and develop vertical software, network software and technology-enabled products for a variety of niche markets on all aspects of patent procurement and enforcement.
- ▶ Counseling a multinational company on developing and managing a global patent portfolio related to water-soluble, sustainable technology and materials.
- ▶ Counseling one of the world's largest integrated energy and chemicals companies on developing and managing its extensive patent portfolio.
- ▶ Managing extensive patent portfolios and prosecution activities in North America and South America for a global multinational elevator company.
- ▶ Conducting complex patent invalidity, infringement, due diligence and freedom-to-operate studies for numerous technology companies, assisting clients in designing around third-party IP and mitigating infringement risks in new product development.
- ▶ Serving as corporate patent council and advising senior leadership regarding patent protection for novel inventive concepts aligned with business goals and objectives.
- ▶ Managing the global patent portfolio for a vehicle manufacturing company, including preparing and prosecuting U.S. and foreign patent applications and drafting opinions regarding patentability, infringement, validity and freedom to use.
- ▶ Prosecuting U.S. patent applications for a global automotive technology company related to automotive suspension, conventional hydraulic gas-pressure shock absorbers, electrically controlled shock absorbers, steel-spring struts and air suspension systems.
- ▶ Preparing and prosecuting patent applications for early-stage and established medical device companies, including cardiovascular stents, medical imaging systems and software, prosthetics and implants, cardiovascular monitoring devices, orthopedic devices, and access devices.
- ▶ Providing patentability assessments, portfolio management and prosecution services for clients in the energy and artificial intelligence sectors, including drafting and prosecuting patent applications for innovative technologies.