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# Basic Trademark and Patent Practice for Lawyers and Paralegals



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## Basic Trademark and Patent Practice for Lawyers and Paralegals

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# The Groundwork You Need for Success

Presented by The Intellectual Property Law Section of the State Bar of Michigan in cooperation with The Institute of Continuing Legal Education

This is the perfect on-demand seminar for intellectual property lawyers and paralegals. Learn the nuts and bolts of IP law practice with practical advice from Michigan's top patent and trademark lawyers. Hear experienced practitioners' winning strategies for patent prosecution, patent litigation, trademark prosecution, and trademark litigation.

## You Will Be Able to:

- Improve your application and prosecution before U.S. and foreign patent offices
- Avoid nonsubstantive office actions when you register a trademark
- Identify key issues at the beginning of trademark litigation
- Understand how the America Invents Act impacts your patent practice
- Set realistic expectations about costs and results during litigation
- Think “big picture” to advise clients on patent and trademark prosecution

## SPEAKERS



**Glenn E. Forbis**  
Harness Dickey & Pierce PLC,  
Troy



**Karl T. Ondersma**  
Gardner Linn Burkhardt & Ondersma LLP,  
Grand Rapids



**Hope V. Shovein**  
Brooks Kushman PC,  
Southfield



**Leigh C. Taggart**  
Honigman LLP,  
Bloomfield Hills

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## Schedule

**SESSION DURATIONS:** Each on-demand session runs 60-80 minutes on average.

### Patent Prosecution: Drafting Applications, Patent Prosecution, and the America Invents Act

overview of preparing patent applications and impact of the America Invents Act  
• drafting a claim in view of *Alice* issues • patent prosecution before the United States Patent and Trademark Office (USPTO) and foreign patent offices • pre-filing patent searching • patent licensing issues

Karl T. Ondersma, Gardner Linn Burkhardt & Ondersma LLP, *Grand Rapids*

### Patent Litigation: Practical Advice on Enforcing and Defending Patents

overview of a patent infringement case • initial assessments and client-management techniques • interface with IPR strategies • discovery strategies • developing the infringement or defense position on liability • claim construction and Markman hearing strategies • working with expert witnesses • developing a damage position

Glenn E. Forbis, Harness Dickey & Pierce PLC, *Troy*

### Trademark Prosecution: Analyzing, Registering, and Maintaining Trademarks

understanding the trademark life cycle—prosecution before the USPTO  
• types of trademarks • what to do *before* you file—clearance, strength of mark  
• what you *need* before you file—applicant, mark, basis, goods/services  
• tips to avoid office actions—nonsubstantive and substantive • dealing effectively with trademark examiners • post-registration maintenance

Hope V. Shovein, Brooks Kushman PC, *Southfield*

### Trademark Litigation: Strategies to Advise Your Client Like a Seasoned Pro

analyzing key forum issues—trademark strength, infringement test, preliminary injunctions, and defenses • three things you should know about your judge—trademark case experience, history on summary judgment, which key issues magistrates decide  
• assessing case strengths and weaknesses—will your story resonate with judge and jury?  
• understanding your relief options—and which are realistically available • setting a real budget (plaintiff) and understanding the insurance policy (defendant)

Leigh C. Taggart, Honigman LLP, *Bloomfield Hills*