

Services

Patents

Practice Contacts

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Patent protection is one of the most important ways companies can safeguard their innovations. Patents provide an unequalled head start in the marketplace providing exclusivity that has immeasurable value at least for a period of time. Patent protection prevents your competitors from making, using, selling, offering to sell, or importing your technology in the country or countries in which patent rights are held.

Our team helps our clients obtain patents around the globe in alignment with their business goals. We also help our clients monetize those patent assets through licensing and sales, and help our clients defend their rights at the U.S. Patent and Trademark Office Patent Trial and Appeal Board (PTAB), federal courts and the International Trade Commission when infringed by third parties.

Smart Patent Procurement and Global Portfolio Management

Working in close partnership with our clients, we work to understand their business goals, as well as the industry trends and the competitive environment in which they operate. Our goal is to help build a formidable patent portfolio suited to our clients' needs. Whether the objectives are focused on defensive coverage, creating barriers to entry, or building value for a strategic exit, our patent professionals take an aggressive approach and have proven experience to get the job done.

Our team uses pragmatic drafting techniques designed to provide minimal rejections across multiple jurisdictions. During prosecution, we utilize leading cases and early indicators of patentability to maximize efficiency. In all technical areas, we focus on using Smart Prosecution™ methodologies and Smart Filing Routes™ to produce pragmatic patent prosecution outcomes. The result is smart patent spend management for optimized global portfolio management.

Khaled Shami
Adam C. Sherman
Thomas P. Thrash
Anthony P. Venturino
Aaron M. Williams

Cost-Effective, Comprehensive Global Portfolio Management

We have developed our proprietary PatentlyIntegrated® approach to work with each client's business, legal, marketing and technical staffs to ensure that intellectual property (IP) asset management plans are built on and around evolving business goals. This work entails identifying and prioritizing assets with recommendations to license technologies or sell marginal assets to generate revenue, to donate or even abandon assets to reduce costs, and to identify acquisitions to strengthen or expand an existing IP portfolio. To help serve our clients with assets and needs outside of the U.S., we have nurtured and actively manage a network of highly competent foreign IP counsel who work under similar guiding principles.

PatentlyIntegrated®

In 2017, Vorys launched PatentlyIntegrated®, a unique system designed to help companies efficiently obtain quality patent assets with efficient spend management. Our PatentlyIntegrated® technology uses proprietary algorithms to objectively align business goals with patenting activities. PatentlyIntegrated® incorporates competitive intelligence as well as jurisdictional realities in that strategic alignment. In August 2019, Vorys exclusively licensed PatentlyIntegrated® to Activ8 IP, Inc.

Design Patents and Utility Models

Design patents and utility model patents can often add diversity to IP portfolios, for example, to deter counterfeiters and copycats. Our team helps clients recognize when and how design patents and utility models can be used to enhance the IP strategy for a given product or market. Design patents can be especially helpful tools in combatting bad actors in emarketplaces.

Plant Patents

Plant patents cover new and unique characteristics of plants and can serve as a higher revenue source by preventing competitors from using the plant. We work closely with our clients and inventors to procure plant patents strategically, and are sensitive to spend management to ensure outcome tailored to the client's needs.

Invention Mining

For many of our clients, we facilitate invention mining (also called invention harvesting) sessions to help our clients' innovators conceive of new inventions or identify new inventions already conceived, but not yet articulated or appreciated. We have found that invention harvesting can be leveraged in the context of active development projects to ensure that valuable project-related IP is duly protected.

Patent and Trial Board (PTAB) Proceedings and IP Litigation

PTAB Proceedings: Post-grant *inter partes* review, post-grant review, covered business method review, and reexamination proceedings before the PTAB are an integral part of how Vorys patent attorneys ensure our clients' IP objectives and litigation strategies are met. At Vorys, our substantial trial experience, coupled with our attorneys' technical knowledge and patent experience, allows our team to provide unparalleled coverage and strategic thinking before the PTAB.

Patent Litigation: Our attorneys, many of whom hold advanced degrees in chemical, electrical, mechanical and/or computer arts, develop a unique strategy for each case, always considering both the legal and business perspectives in determining the best course of action. We conduct *Markman* claim construction hearings, try cases to decision, and represent clients before the U.S. Court of Appeals for the Federal Circuit and the International Trade Commission (ITC). We have the ability to scale our team to meet the needs of any situation while maintaining sufficient leverage for cost-efficiency. Our experience in federal courts across the country ensures that we can handle any patent litigation matter for our clients on the plaintiff or defense side. Further, by working with our in-house eDiscovery and litigation technology team, we are able to streamline the discovery process, lowering risk and cost to the client while insuring greater accuracy and efficiency.

Freedom to Operate: We also help clients manage threats brought by Patent Assertion Entities (PAEs) or direct competitors. This includes deploying a suite of options from indemnification to licensing or litigation. Our team uses the latest patent analytics tools to help clients clear products and reduce PAE threats.

Patent Marketplace: We assist clients in efforts to license, sell or acquire patent portfolios. We have engaged in a number campaigns on behalf of patent owners to license and sell their patent assets.

Patent Opinions, Counseling and Monetization

Patentability Opinions: Our attorneys often conduct patentability searches and produce opinions to help our clients decide whether pursuing patent protection makes sense. A patentability search is conducted to identify patents and non-patent literature that may affect the patentability of an invention and/or the advisability of seeking patent coverage.

Clearance Counseling: We help our clients leverage the best position in their respective markets, including advising on industry patent landscapes and their freedom-to-operate. We also regularly conduct portfolio reviews, state-of-the-art studies and patent mapping exercises to help our clients understand the competitive landscape in which they are operating. Through these and other methods, we help our clients navigate competitors' patent assets, for example, before product offerings, and provide non-infringement,

enforceability and invalidity opinions.

We also routinely address design-around issues, licensing potential, IP contract construction and enforcement, export controls, government contract issues, regulatory issues and pre-litigation strategies.

Patent Monetization: We help our clients analyze their patent portfolios to identify and exploit the maximum potential of their patent assets. We review their business goals to understand business opportunities presented by these assets, create plans to generate revenue through licensing or selling the assets (or divesting a business) and then execute those plans. We look to increase the value of our clients' portfolios through additional filings and acquisitions.

News

[News, 3.6.2023](#)

Messinger Quoted in CNN Story on Ford's Recent Patent

[News, 1.10.2023](#)

Experienced IP and Pharmaceutical Patent Litigators Join Vorys as Partners

[News, 11.3.2022](#)

Vorys Receives 69 Tier One Rankings on 2023 *U.S. News – Best Lawyers* "Best Law Firms" List

[News, 8.24.2022](#)

New Episode of Vorys IP Podcast Highlights Technical Agreements

[5.25.2022](#)

New Episode of Vorys IP Podcast Highlights Patent Assertion Entities

[5.11.2022](#)

New Episode of Vorys IP Podcast Highlights Enforcing Property Rights Online

[4.27.2022](#)

New Episode of Vorys IP Podcast Highlights What to Do When a Patent Assertion Entity 'Comes Knocking'

[3.29.2022](#)

Women's History Month Episode of Vorys IP Podcast Features USPTO Texas Regional Director Hope Shimabuku

[3.16.2022](#)

New Episode of the Vorys IP Podcast Focuses on the European Unitary Patent

[News, 12.29.2021](#)

Episode 6 of the Vorys IP Podcast Focuses on International Patents

[News, 12.15.2021](#)

Episode 5 of the Vorys IP Podcast Focuses on Patenting Advice

[News, 12.1.2021](#)

New Episode of the Vorys IP Podcast Focuses on Patents & the Patenting Process

[News, 11.17.2021](#)

New Episode of the Vorys IP Podcast Focuses on Working with U.S. Patent Examiners

[News, 10.20.2021](#)

Introducing the Vorys Intellectual Property Podcast

[News, 9.15.2021](#)

Vorys Adds Experienced Computer and Electrical IP Partners Khaled Shami and Mike Messinger

[News, 8.19.2021](#)

Ten Vorys Attorneys Selected by Their Peers as “Lawyers of the Year”

[News, 6.3.2021](#)

Venturino Heads Team of AIPLA Representatives at Virtual Meeting of Industry Trilateral and Group B+

[News, 3.1.2021](#)

Venturino Represents AIPLA at Virtual IP5 Industry Meetings

[News, 11.6.2020](#)

Venturino Named to American Intellectual Property Law Association Board of Directors

[News, 6.22.2020](#)

Jordan Featured in *Texas Lawyer* Q&A on The Current State of IP During the Pandemic

[News, 5.14.2020](#)

Vorys eControl and Vorys IP Team Release Whitepaper Titled "Patent Strategies to Help Stop Bad Actors on Amazon"

[News, 5.4.2020](#)

Watkins Named to 2020 *IAM Strategy 300* List

[News, 8.22.2019](#)

Vorys Partners with Activ8 IP to Expand Patent Management Technology

[News, 11.29.2018](#)

Vorys' Client Recognized on *Time* List of Best 2018 Inventions

[News, 8.15.2018](#)

More Than 100 Vorys Attorneys Named to 2019 Best Lawyers in America® List

[News, 6.29.2018](#)

Watkins, Jordan Included in IAM Strategy's World's Leading IP/Patent Publications

[News, 6.27.2018](#)

Venturino Represents AIPLA at Industry Trilateral, Industry IP5 and IP5 Patent Office Heads Meetings

News, 11.9.2017

Vorys Patent Group Publishes White Paper Focusing on Changing Patent Landscape and Need for Strategic Approaches to Patent Portfolio Development and Management

News, 9.20.2017

Miller Quoted in SuperLawyers.com Story Titled "Protecting Your Invention"

News, 6.14.2016

Garvin Quoted in *Intellectual Property Law360* Story Titled "Attorneys React To High Court's Patent Damages Ruling"

News, 1.26.2016

Experienced Patent and Trademark Attorney Anthony Venturino Joins Vorys

News, 5.21.2015

Vorys Partners from Ohio and D.C. Included on the *Managing Intellectual Property* 2015 IP Stars List

News, 10.22.2014

Gecovich Included in *Cleveland Plain Dealer* Story Titled "Everykey's Wristband That Replaces Keys and Passwords Takes First Place at ProtoTech Pitch Competition"

News, 7.21.2014

Vorys Continues to Strengthen IP Team with Addition of Two Partners

News, 4.30.2014

Zytcer Featured in *Law360* Story Titled "Lawyers Weigh In On High Court's Patent Rulings"

News, 1.13.2014

Vincent M. DeLuca Joins the Vorys Intellectual Property Group

News, 9.18.2013

Zytcer's Presentation Featured in Korea's *Pharmatoday* Publication

News, 3.1.2012

Vorys Strengthens Technology and Intellectual Property Group

News, *Cincinnati Enquirer*, 7.26.2009

Richardson quoted in *Cincinnati Enquirer* article "Patent litigation lucrative, on rise"

Publications

1.11.2023

2023 Intellectual Property Law Primer: Supreme Court Preview

1.3.2023

2022 Year in Review: Intellectual Property Law and the Supreme Court

[Client alert, 12.5.2022](#)

Sharp Drop in Patent Appeal Pendency Opens New Options for Companies

[Client alert, 6.29.2022](#)

USPTO Issues Guidance on Discretionary Denials by PTAB

[Client alert, 4.14.2022](#)

Judge Albright Swipes Right on Bumble's 'Original Patent' Requirement Defense

[Client alert, 3.30.2022](#)

Did you Know the USPTO Offers Pro Bono Patent Services?

[Client alert, 3.28.2022](#)

USPTO to Offer Pro Bono Services to Qualifying Inventors

[Client alert, 2.1.2022](#)

Patent and Trademark Office Updates You Need to Know

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2021 Year in Review: Intellectual Property Law and the Supreme Court

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If at First you won't Succeed, it may not be "Obvious to Try"

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Patent and Trademark Office Updates You Need to Know

[Client alert, 11.23.2021](#)

New Year, New USPTO: Petitions for Challenging Unused Marks Under TMA Accepted Starting December 27, 2021

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Highlights of USPTO Performances and Initiatives FY 2021-FY 2022

[Client alert, 11.10.2021](#)

Patent and Trademark Office Updates You Need to Know

[Client alert, 10.27.2021](#)

Partnering in Patents Developments

[Client alert, 10.7.2021](#)

Yet another Implementation of *Alice*: Side-Stepping Step One

[Client alert, 10.5.2021](#)

Confessions of a Serial Filer: Abusive Filing Practices Can Limit Patent Challenge Options

[Client alert, 9.7.2021](#)

Patent and Trademark Office Updates You Need to Know

[9.2.2021](#)

Cosmetics Containing CBD—How Regulated Should They Be?

[Client alert, 8.11.2021](#)

Patent Office Updates You Need to Know

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Lack of 'Present' IP Assignment Makes a Rotten Apple

[Client alert, 8.9.2021](#)

The Saga of the Skinny Label Continues

[Client alert, 8.2.2021](#)

Two Wins for AI-Inventorship in South Africa and Australia

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FDA Approves First Interchangeable Biosimilar Product

[Client alert, 7.6.2021](#)

Patent Office Updates You Need to Know

[Client alert, 7.1.2021](#)

The Game of Disclaim: Curious Case of Strategic Prosecution Disclaimer in IPR

[Client alert, 6.30.2021](#)

Supreme Court Trims Sails of Assignor Estoppel Doctrine

[Client alert, 6.21.2021](#)

PTAB Reviews to Continue, but with Additional Oversight

[Client alert, 6.7.2021](#)

Patent Holders Now Have More Reason to “Trimble” at the Thought of Triggering a Declaratory Judgment Action

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Patent Office Updates You Need to Know

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USPTO Announces Fast-Tracking of COVID-Related Appeals

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Have any Patents Issued under the USPTO's COVID-19 Prioritized Patent Examination Program?

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Patent Office Proposal Seeks to Expand Applicability of Terminal Disclaimers in Joint Research Agreement Patent Filings

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IP of the Poisonous Tree: NDA Breach can Result in Surrender of Patent Rights

[Client alert, 12.8.2020](#)

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Intellectual Property Alert: Want to Expedite your COVID-Related Patent or Trademark Application?

[Client alert, 9.21.2020](#)

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Intellectual Property Alert: Notes from the USPTO and Patent Public Advisory Committee Quarterly Meeting Part 7 of 8: Pendency and Quality

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Intellectual Property Alert: Cutting the Line to the Appeal Board: A New Pilot Program to Expedite PTAB Decisions

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Patent Office Updates You Need to Know

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Intellectual Property Alert: Notes from the USPTO and Patent Public Advisory Committee Quarterly Meeting Part 6 of 8: International Update

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COVID-19 Patent & Trademark Office Updates

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USPTO to Grant Further Relief for Certain Patent-Related Fees and Deadlines

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PTAB Sets Out 6 Factors for Determining Whether to Apply IPR Institution Discretion Due to an Earlier Trial Date

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Intellectual Property Alert: Supreme Court Decision Will Have Significant Impact on *Inter Partes* Review Appeals

[Client alert, 4.20.2020](#)

COVID-19 Patent Office Updates

[Client alert, 4.8.2020](#)

Update: Changes to IP Operations Worldwide

[Client alert, 4.1.2020](#)

Patent and Trademark Office Extends Filing and Payment Deadlines for COVID-Related Causes

[Client alert, 3.30.2020](#)

COVID-19 Patent and Trademark Filing Impacts

[Client alert, 1.27.2020](#)

Intellectual Property Alert: 2020 Intellectual Property Primer: Cases to Watch this Year

[Client alert, 12.17.2019](#)

Intellectual Property Alert: Patent Prosecution Highway in India and Brazil

[Client alert, 12.2.2019](#)

Intellectual Property Alert: Amazon Creates a Cost-Effective and Efficient Patent Infringement Remedy for Infringing Products Sold on its Marketplace by Third Parties

[Client alert, 12.4.2018](#)

Intellectual Property Alert: Federal Circuit Finds Computer Security Innovation to be Patent-Eligible

[Client alert, 9.7.2018](#)

Intellectual Property Alert: Prior Case Dismissed Without Prejudice Starts Clock Running For IPR Filing

[Client alert, 8.2.2018](#)

Intellectual Property Alert: Third-Party Funding Of Patent Litigation

[Client alert, 7.13.2018](#)

Intellectual Property Alert: When is a Disclosure Considered a Prior Art "Printed Publication"?

[Client alert, 6.26.2018](#)

Intellectual Property Alert: Patent Owners Can Obtain Damages for Lost Sales in Foreign Jurisdictions

[Client alert, 6.5.2018](#)

Client Alert: USPTO Rejects Patent Applications with Incorrect Inventorship

[Client alert, 5.9.2018](#)

Client Alert: Inter Partes Review is Changing but Questions Remain

[Client alert, 4.4.2018](#)

Client Alert: Ethical Considerations in Outsourcing Patent-Related Tasks

[Authored article, *Texas Lawyer*, 4.3.2018](#)

Intelligently Managing Company Patent Spend

[Authored article, *IP Law360*, 2.22.2018](#)

Tips For Reassessing Company Patent Strategies

[Client alert, 2.13.2018](#)

Client Alert: IPR Institution Decisions are not (Entirely) Immune from Appeal

[Client alert, 2.5.2018](#)

Client Alert: Can Post-Filing Evidence be used to Invalidate a Patent?

[Client alert, 1.11.2018](#)

Client Alert: Companies Can Be Liable for Direct Infringement Through Other's Actions

[Client alert, 1.4.2018](#)

Client Alert: The Impact of Coming Changes in European Union Patent Litigation on U.S. Patent Owners' Enforcement Strategies

[Client alert, 12.19.2017](#)

Client Alert: Be Aware (and Beware) of Patent Outsourcing

[Client alert, 12.7.2017](#)

Client Alert: Final Rule on Patent Agent-Client Privilege

[Authored article, *IP Law360*, 7.7.2017](#)

Effective Utilization Of The Patent Prosecution Highway

[Client alert, 9.10.2015](#)

Client Alert: New Patent Infringement Decision Could Pose Problems for E-Commerce Business

[Client alert, 6.2.2014](#)

Client Alert: Supreme Court Issues Ruling Limiting Liability for Induced Infringement

[Authored article, *Crain's Cleveland Business Health Care Report*, 1.7.2014](#)

For Ohio's Bioscience Industry, Supreme Court's Ruling is a Game-Changer

[Client alert, 1.18.2013](#)

Client Alert: Navigating the Transition from a First-to-Invent to a First-to-File Patent System: Implementation March 16, 2013

Speaking Engagements

[Event, 3.16.2023](#)

IPOwners Spring Summit Panel

[Event, 1.3.2023](#)

Patent Agent and Scientific Advisor Career Deep-Dive Virtual Workshop

[Event, 11.3.2022](#)

Introduction to Intellectual Property Careers Without Having to Go to Law School

Event, 10.28.2022

AIPLA 2022 Annual Meeting

3.22.2022

What IP Litigators Need to Know About Patent Prosecution History

1.26.2022

Invention Harvesting: How to Identify and Capture Patentable Innovation in the Software Space

1.4.2022

Patent Agent and Scientific Advisor Career Deep-Dive Workshop

12.1.2021

Introduction to Careers in Intellectual Property Law: Patent Agents and Scientific Advisors

10.7.2020

Update on Substantive & Procedural Patent Harmonization for 2020 AIPPI World Congress Online

3.13.2020

Akron Inventors' Club

6.26.2018

2018 IP Strategy Summit Series

3.28.2018

Patent Department of the Future: How to Leverage Technology to Work Smarter, Lower Costs

1.31.2018

Year in Review: Our Top IP Developments of 2017

4.4.2014

ABA's 30th Annual Intellectual Property Law Conference

4.22.2013

Nano 2013

The 11th annual conference exploring the global opportunities in nanobiotechnology and related science and engineering fields

12.5.2012

Because That's Where the Money Is: Identifying and Protecting Your Patents, Copyrights, Trade Secrets and Other IP

Presented by TechColumbus

9.21.2009

INTA Trademark Administrators Conference

Presented by the International Trademark Association