



Geoffrey L. Oberhaus

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Geof facilitates and protects innovation from the origination of the idea, registration/protection of the innovation, licensing of the innovation, and enforcement of the innovation. This can include patentability opinions, freedom to operate studies, licensing agreements, development agreements, patent applications, trade secret protections, copyright and trademark registrations, distribution agreements, channel-partnering agreements and the like. In addition, Geof has represented major companies for intellectual property due diligence as part of merger and acquisition activities. These include patent scope analysis, freedom to operate studies, reviews of licensing agreements, and onsite due diligence reviews.

Geof's practice focuses on IT licensing, patent protection, litigation, trade secrets, copyrights, trademark, software protection, e-commerce, and licensing. He serves as chair of the Systems Committee and is past chair and member of the firm's Professional Development Committee.

Services

- Entertainment Industry
- Intellectual Property
- Patent Procurement & Management
- International Business
- Intellectual Property Acquisitions
- Intellectual Property Litigation
- Life Sciences Industry
- Health Care Industry
- Life Sciences Intellectual Property

Education

- Rutgers University School of Law, Camden (J.D., 1998)
 - Albert P. Blaustein Memorial Award for the highest standard of legal scholarship published in the Rutgers Law Journal

- University of Detroit (B.S., *cum laude*, 1992)
 - Chemical Engineering

Bar Admissions

- Ohio
- U.S. Patent & Trademark Office

Court Admissions

- U.S. District Court for the Southern District of Ohio

Affiliations/Memberships

- Cincinnati Intellectual Property Law Association (Cincy IP), Board Member
- Intellectual Property Owners Association, IP Licensing Committee
- Intellectual Property Owners Education Foundation, Educate Committee
- Licensing Executives Society

Distinctions

- New Century Community Service Award from United Way of Greater Cincinnati (2010)
- *Who's Who in America*
- *Who's Who in Emerging Leaders*

Experience

Inbound (FDI) Merger and Acquisition Purchases of U.S. Company, Creating Cross Border Equity Joint Ventures

We have represented a number of French and British technology companies with respect to inbound (FDI) merger and acquisition purchases of U.S. company, creating cross border equity joint ventures. Our years of experience and large number of these clients speeds the process and transactions.

Venture Capital Transaction

We represented the owner of cutting-edge combustor technology in the creation of a new company with client intellectual property and patents combined with private equity contribution. We leveraged our unique venture capital and intellectual property experience to streamline the transaction.

Export Control

Our firm has represented numerous technology, e-commerce, engineering and manufacturing clients in the analysis of laws, regulations and classifications to determine Export Control licenses with the U.S. Commerce Department.

OFAC/Embargoed Countries/Denied Parties Licenses and Investigations/Export Control/FCPA

Represent numerous clients in determining the legality of transactions with U.S. embargoed countries / OFAC, FCPA and on Export Controls.

Counseled our Client on Export Control Concerning Multiple Research Projects

We provided advice on export control classifications for over 100 research projects for a large company in the automotive industry. We provided guidance on export control provisions in licensing and technology transfer agreements.

Organization of Multiple Software and Technology Start Ups, Venture Capital and Private Equity

Scores of software and technology start ups organized addressing tax, venture capital and private equity investments, buy-sell issues, phantom equity, stock options, executive compensation, corporate counseling and customer and employment contracts. Our clients have benefitted from the leverage of our experienced technology, intellectual property and employee benefits resources.

Distribution and Channel Partnering Agreements

Our firm prepared distribution and channel partner agreements for Standard Register Company's Digital Pen and Paper System. In addition, we drafted end-user license agreements (EULA) for the Digital Pen and Paper System. Utilizing a combination of strength from our corporate department and intellectual property practice group allowed for quick understanding of the technology and the unique issues that it presented.

IP Licensing/Agreement Experience

Our attorneys have drafted a wide variety of agreements for clients to help them protect their intellectual property. Since 2011, we have drafted more than 575 total agreements, which can be broken down as follows:

Development Agreements (70)

- Independent Contractor Agreements (15)
- Talent Agreements (15)
- Presenter Agreements and Content Provider Agreements (10)
- Joint Ownership Agreements (10)
- Production Agreements (10)
- Employee Invention Policy and Agreements (5)
- Joint Development Agreements (5)

Litigation-related/Dispute Agreements (55)

- Pre-Litigation Settlement Agreements (15)
- Trademark Trial & Appeal Board Settlements (15)
- Co-Existence Agreements (10)
- Litigation Settlement Agreements – Patent Disputes (5)
- Litigation Settlement Agreements – Trademark Disputes (5)

- Joint Defense Agreements (5)

License Agreements (155)

- Software License Agreements (35)
- Patent License Agreements (35)
- Trademark License Agreements (20)
- End User License Agreements (15)
- Subscription Agreements (10)
- Software as a Service (SaaS Agreements (10)
- Channel Partner Agreements (10)
- Pilot Agreements (10)
- Copyright License Agreements (5)
- OEM License Agreements (5)

IT-related Agreements (170)

- Terms of Use and Privacy Policy (35)
- Healthcare-related IT Agreements (30)
- Software IT Agreements (25)
- Hardware IT Agreements (25)
- Master Client/Service Agreements (25)
- Support and Maintenance IT Agreements (15)
- Reseller Agreements (15)

Research Agreements (55)

- Advanced Research Agreements (25)
- Materials Transfer (20)
- Cooperative Research and Development Agreements (10)

Misc. Agreements (55)

- Non-Disclosure Agreements (25)
- Participant Agreements (10)
- Exclusive Sales Representation Agreements (5)

- Termination Agreements (5)
- Domain Purchase Agreements (5)
- Domain Escrow Agreements (5)

NPE Experience

We have defended clients in challenges to their patents from a wide variety of NPEs. Several representative examples of patents we have defended are below:

- **Cascades Publishing Innovation, LLC:** U.S. Patent 8386484
- **Data Speed Technology LLC:** US Patent 5,867,686 – High speed real-time information storage system
- **eTagz:** US Patent 7,503,502 – Computer readable hang tag and product
- **eTagz:** US Patent 7,703,686 – Consumer computer-readable product label apparatus and method
- **eTagz:** US Patent 6,298,332 – CD-Rom product label apparatus and method
- **eWatch:** US Patent 6,970,183 – Multimedia surveillance and monitoring system including network configuration
- **Helfrich Patent Licensing:** Various US Patents related to mobile device technology
- **Honeywell International, Inc.:** Various US Patents related to bar code and QR code technology
- **Infinite Data, LLC:** US Patent 5,790,530 – Message passing multiprocessor system)
- **Innovatio IP Ventures:** Various US Patents related to local area network radio frequencies and multiple channel wireless access
- **Lemolson Foundation:** Various US Patents relating to bar code technologies
- **Lodsys:** US Patent 7,222,078 – Interactive applications (smartphone apps)
- **Mobile Logistics:** Various US Patents related to transportation yard management systems
- **MPHJ (formerly Project Paperless):** Various US Patents related to computer architecture and document management
- **Pragmatus Telecom, LLC:** US Patent 6,322,231 – Method and system for coordinating data and voice communications via customer contract channel changing system using voiceover IP)
- **Round Rock:** Various US Patents related to radio frequency identification
- **TPQ Development LLC:** US Patent 5,412,730 – Encrypted data transmission system employing means for randomly altering the encryption keys)
- **US Ethernet Innovations:** Various US Patents related to Ethernet connections and point of sale

- **Wireless Media:** Various US Patents related to transportation yard management systems
- **You Technology, Inc.:** Various US Patents related to biometric technology

Beneficial Franchise Company v. BankOne, et al.

We were lead counsel for defendants Republic Bank & Trust and River City Bank in patent infringement case involving business method patents purportedly covering systems and software relating to tax refund anticipation loan processing. We successfully settled the case after prevailing with respect to novel contractual third-party claims which we brought against an affiliate of the plaintiff patent owner. *Beneficial Franchise Company v. Bank One, et al.*, Civil No. 00 C 2441 (N.D. Ill. 2001).

IP Portfolio Development; Patent and Licensing Strategy

We worked with our client, a startup software company, to develop cost-effective strategies to optimize protection of core technologies, to analyze competitor patents for clearance and patentability issues, and to approach potential partners for licensing opportunities.

Patent Prosecution

The firm drafted patent applications and license agreements related to a portable breath alcohol detector.

Patent Prosecution and Opinion Drafting

Our firm represented a computer printer and electronics company in the drafting of patents and prosecution of patent applications related to consumer electronic products such as printers (laser, ink jet, etc.), scanners and all-in-one units, ink and print head design.

Research and Licensing Agreements

Our firm represented a large company in the automotive industry in the preparation and prosecution of patent applications related to numerous technologies in its IP portfolio, and in preparing and negotiating research agreements with universities. We assisted in implementing cost-effective procedures for conducting patentability analyses and patent preparation for a stream of invention disclosures.

Social Media

Provided counseling to clients on various trademark, libel and copyright issues related to social networking media.

Worldwide Rebranding

We conducted extensive, worldwide searches and reviews of potential names selected by our client for its rebranding. We then coordinated the filing and prosecution of applications for the new name 15 different countries, including the United States, where we successfully defended the marks against claims of a potential likelihood of confusion with another mark.

Publications

June 4, 2012

Post Grant Review: Is Your Business Prepared?

Intellectual Property Today

