

# Fisher Broyles

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**Practice Areas:** Intellectual Property; Internet & eCommerce; Technology; Higher Education

**Bar Admissions:** Pennsylvania; USPTO; US Supreme Court

**Education:** Villanova University School of Law, JD, 1997; Villanova University School of Commerce and Finance, MBA, 1997; Bucknell University, BS Mechanical Engineering, 1993

**Experience:** Saul Ewing Arnstein & Lehr LLP; Saul Ewing LLP

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Greg Bernabeo practices intellectual property law with an emphasis on the strategic use of IP as an offensive and defensive tool to help his clients achieve their business objectives. Greg has worked with a broad range of clients spanning Fortune 50, large domestic and multinational corporations, mid-sized and family-owned companies, emerging growth start-ups and entrepreneurs, as well as universities and health systems. His multi-disciplinary educational background includes engineering, law and business degrees, and he enjoys using his diverse client representation experiences to provide sophisticated yet practical advice according to each unique client's needs.

A seasoned IP attorney, Greg's experience spans the full IP life-cycle, including:

- pre-incorporation meetings with innovators to identify strategically-meaningful intellectual property;
- development and implementation of domestic and foreign IP strategies;
- performance of IP clearance studies;
- preparation and prosecution of patent, trademark and copyright applications;
- analysis and counseling prior to licensing or assertion of IP rights; and
- enforcement of IP rights.

## Patents

Greg regularly counsels as to clients' non-infringement of competitors' patent rights, which often entails developing design-around solutions to avoid the patent rights of others. He has experience in patent and product analysis, and development of patentability, infringement, freedom-to-operate, and invalidity opinions. He often conducts corporate IP audits to identify protectable proprietary information, and performs transactional due diligence to assess IP portfolios in the licensing and M&A contexts.

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Page 2 of 4

With a background in mechanical engineering and extensive experience in the “app”/computer hardware/software/internet/e-commerce field, Greg provides patent counsel in the mechanical, electromechanical and computer science arts. He has drafted and prosecuted hundreds of patent applications in diverse technological fields and industries, including Industrial/Cleantech, Medical/Healthcare, Software/Computer Technologies/E-Commerce, Telecommunications and Consumer Products. He is a member of the Association of University Technology Managers (AUTM).

### Trademarks and Copyrights

In addition to his patent practice, Greg regularly counsels clients in selecting and clearing trademarks for use, and in registering and enforcing trademark rights both in the U.S. and abroad. He has managed the entire trademark portfolios for entities ranging from an industry association, to a pharmaceutical company, to an industrial products company, to a web-based company, to an individual. He is attuned to trademark issues in the online context, and has resolved numerous trademark-related disputes. Greg has successfully resolved trademark disputes in the social media context, through tactful negotiating and initiation of proceedings under applicable website policies. He has also registered trademarks with US Customs and Border Patrol, and similar foreign bodies, to impede the flow of counterfeiting products, and has provided copyright registration, counseling and licensing services for a broad range of clients in diverse industries.

### Transactional Work

Greg has been ---involved in a broad range of transactional work, ranging from performing IP due diligence in connection with mergers, asset purchases and divestitures, to preparation of IP policies and procedures, to drafting agreements for domain name sales and transfers, and protection of his clients' interests through confidentiality, manufacturing, licensing, consulting and employment agreements.

### Enforcement

Greg's experience further includes a broad range of IP enforcement experience, including enforcement of patent and trademark rights through assertion letters, administrative proceedings, arbitration and litigation, and is supported by vast experience in a broad range of pre-litigation analysis and counseling. Greg's experience includes inter partes proceedings before the Trademark Trial and Appeal Board of the United States Patent and Trademark Office, and arbitration under the ICANN Uniform Domain Name Dispute Resolution Policy (UDRP).

Greg is admitted to practice before the U.S. Supreme Court.

### Representative Transactions Include

- Pre-incorporation counseling of an inventor of a consumer product, and tandem development of patent and trademark strategies in support of planned business activities; the product is now sold in mass-market retailers in the U.S. and abroad.

- Advising a start-up web business in developing and prosecuting through to issuance a patent portfolio in support of proprietary online trading platform technology; the company has since been acquired by a Fortune 500 enterprise.
- Developing a patent portfolio protecting a small company's cloud-based services technology; the company has since been acquired by a leading PC manufacturer.
- Monitoring ANDA patent litigation for leading brokerage houses and performed substantive patent analysis to advise sell-side analysts as to the litigants' success prospects in support of the preparation of BUY/SELL/HOLD reports.
- Analyzing patent assets for a global pharmaceutical and medical device manufacturer in support of its first acquisition of a Web-based services company.
- Preparing and prosecuting patents for a perennial top-10 U.S. patent recipient in support of the company's \$100MM+ patent licensing program.
- Representing trademark owner in obtaining transfer of domain name from cybersquatters in the firm's first ICANN UDRP engagement.
- Representing a SaaS company in an opposition proceeding before the U.S. Trademark Trial and Appeal Board to oppose a competitor's attempt to register a competing trademark, resulting in express abandonment of the trademark application by the third party.
- Represented a trademark owner in an opposition proceeding before the U.S. Trademark Trial and Appeal Board in opposing the applicant's registration of a similar mark, obtaining settlement resulting in coexistence on defined terms.
- Representing an alcoholic beverage producer in a cancellation proceeding before the U.S. Trademark Trial and Appeal Board to cancel a competitor's pre-existing trademark registration to pave the way for future growth.
- Represented various trademark holders in disputes against social media users, resulting in transfer and/or take down of social media user accounts and pages under social media website policies.
- Represented various trademark holders in disputes with domain name registrants, resulting in transfer of domain names and/or take-down of objectionable websites under the DMCA for copyright violations and/or pursuant to domain name registrar policies.

### Presentations & Teaching Experience

- Presentation at the Central Penn Business Journal's 2017 craft beer conference – The Business of Beer – from Start up to Grown-Up. The presentation focused on legal issues faced by brewers, including start up financing options, trademark enforcement and labor and employment conflicts.
- Presentation at an in-house legal department of a Fortune 50 company.
- Presentation at a worldwide in-house lawyers conference.

### Publications

- Federal Circuit Finds Improvement to Computer Memory Systems is Patent Eligible, and Not an "Abstract Idea" Under Alice, reversing District Court
- Opinions are Critical to Mitigating Patent Damages Post-Halo

- Federal Circuit Avoids Abstract Idea Definition, Finds Computer Networking Patents Not Patent-Ineligible Despite Components Appearing “Generic at First Blush”
- Patent Owner Asserts 101 Ineligibility Is Not a Defense That Can Be Raised in Litigation
- Federal Circuit Determines Lip-Sync Animation Software is Patent Eligible, and Not An “Abstract Idea”
- States Are Popping the Cap on ‘High Alcohol Beer’: Ohio Lawmakers Authorize Brewers to Increase Alcohol by Volume
- Brewers’ Voluntary Disclosure Initiative Introduced
- Pennsylvania Revisits its Age-Old Liquor Laws
- Federal Circuit Says Content-Filtering Claims are Not Invalid Under Alice, Provides Guidance on Considering Patent Eligibility Based on “Ordered Combination of Limitations”
- Federal Circuit Limits Applicability of “Abstract Idea” to Claims Directed to “Improvement to Computer Functionality Itself”
- The America Invents Act: Virtual Patent Marking
- Medical diagnostic testing alive and well after Bilski
- U.S. Supreme Court accepts review of patent ownership dispute in *Stanford v. Roche*; university rights under Bayh-Dole at risk
- Coming Soon: New Domain Names
- Are “fluid trademarks” on solid ground?
- Defending Your Trademarks in the Social Media World