



Industries

Universities, Research Institutions & Hospitals

Amster, Rothstein & Ebenstein LLP has a vibrant and extensive practice representing and advising universities, hospitals and research institutions that develop and license technology applicable to diverse industries.

For many of these institutions, intellectual property is a cornerstone of their fundraising program and a metric for research progress and innovation, and requires expertise and experience in its procurement and curation. Maximizing quality patent filings and effective licensing of patent IP, as well identifying and protecting less traditional IP such as software, algorithms and data sets, is vitally important.

In addition, Sponsored Research Agreements and Research Services Agreements have become an increasingly important source of funds to these institutions, and we all well-versed in the concerns and needs of non-profit institutions in the transactional arena. Many of our attorneys have Ph.D.s or master's degrees in technical disciplines, and some bring the insight of having been researchers themselves.

Our attorneys have lectured and published widely on matters as diverse as Bayh-Dole updates, the public use bar, and university data ownership and policies, and are actively involved with organizations such as AUTM and LES.

Our universities, hospitals and research institutions practice is wide-ranging and runs the gamut from establishing institutional IP and data policies, assisting with innovation disclosure forms and workflows, support and scrutiny throughout the whole innovation cycle, patent filing and procurement in diverse subject areas, and establishing and monitoring cost-effective and robust patent portfolio and licensing strategies.

Where necessary, we represent non-profit clients in litigation to enforce their intellectual property rights and in inventorship disputes and leverage our long history of corporate IP litigation. Our trademark and copyright practices are long-established and we are attuned to helping hospitals leverage this soft IP. We recognize that packages of IP rights, going beyond



patents to include datasets, algorithms, TMs and copyrights are increasingly important to institutions to protect or monetize.

Amster, Rothstein & Ebenstein LLP has been involved in precedent-setting actions that have helped to shape the contours of the legal landscape across which university and research institutions must navigate. For example, we represented Yeshiva University in the landmark New York State case that established the principle that scientific researchers at academic institutions have an implied obligation to assign their inventions to their university employers, even absent a written agreement.

We have assisted universities and research institutions to obtain intellectual property coverage worldwide. Our attorneys have worked closely with European counsel to successfully assert patent infringement claims in Europe relating to implantable medical devices and methods for activating viruses in blood products and plasma. We have represented clients in opposition proceedings before the European Patent Office, the German Federal Patent Court as co-counsel, and in infringement and other proceedings throughout Europe, including Germany, Switzerland, Austria, Belgium, France, and the Netherlands. Working for European, Japanese and Korean law firms, we also prosecute US patent applications owned by foreign research institutions in Europe, Japan and Korea, and support their worldwide licensing.

With decades of industry experience, the technical know-how to understand sophisticated technologies, and deep expertise in licensing and portfolio management, Amster Rothstein & Ebenstein LLP is a valuable strategic partner to our university, research institution and hospital clients.

Related Practice Areas

- Alternative Dispute
- Anti-Counterfeiting
- Copyright
- False Advertising
- International Protection
- Intellectual Property Litigation
- International Trade Commission
- Patents
- Patent Prosecution, PTAB and Ex Parte Appeals
- Strategic Counseling
- Trade Dress
- Trade Secret
- Trademark
- Unfair Competition

Professionals



Scientific Advisors

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- Brian Amos, Ph.D.
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- Kenneth P. George
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- Charles R. Macedo
- Douglas A. Miro
- Holly Pekowsky
- Chester Rothstein

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