

MONTE L. FALCOFF

PRINCIPAL / DETROIT METRO OFFICE

With more than twenty-five years of experience as a patent and trademark lawyer, Monte understands first-hand what drives business decisions. He worked in-house at United Technologies Automotive (UTA), where he was responsible for patent and trademark management and marketing initiatives, and for developing, selling and licensing new technology. An engineer before practicing law, Monte invented many U.S. patents for UTA. These unique “insider” perspectives make Monte a valuable counselor, one who has an extremely pragmatic approach to business and law.

This pragmatism, along with an innovative mindset, manifests itself in many ways. For example, Monte considers whether a company’s invention is fast-to-market and easy to copy, or is still in an early R&D stage or complex to copy, and recommends differing world-wide patent procedures accordingly. Provisional and PCT international applications are often misused when the invention is market-ready, and instead regular utility patent applications should be initially filed with quickly following German utility models and the like. Should a Madrid Protocol international trademark application be filed for a world-wide brand launch or is an incremental direct country-by-country filing approach more cost effective for a small or mid-sized company who adds new market territories over time? Licensing and enforcement strategies for a clothing invention and brand should be handled differently than an automotive invention and brand, versus a laser invention and brand. These are but a few examples of the way Monte analyzes each client’s situation.

His practice is both broad and deep, and ranges from IP portfolio management; to client counseling and opinion drafting; to the preparation and prosecution of patent and trademark applications; to complex and high-stakes plaintiff and defendant patent, trademark, copyright, trade secret and contract lawsuits across the country. He has expertise in many different industries and for many differently sized companies throughout the world, and he often handles patents and trademarks from cradle to grave, having often licensed and litigated patents, trademarks and associated contracts he prepared. Monte prepares and prosecutes patent and trademark applications on a global scale, and is lead counsel on many patent, trademark, copyright, trademark and contract lawsuits in district courts throughout the U.S., and in IPR proceedings before the USPTO. Furthermore, he has considerable expertise in helping European companies protect and enforce their intellectual property, or circumvent and defend themselves against others.

An asset builder, problem solver and end game strategist, Monte represents some of the most prominent organizations driving IP related



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commerce today. His clients range from multi-national corporations, to foreign and domestic privately owned companies, to small U.S. based start-ups. His innate ability to synthesize legal, scientific and technological theory into a practical, legal solution has proven invaluable to his clients when critical market share is at stake.

Exemplary industries and technical areas where Monte has considerable litigation, licensing, patent and trademark expertise include:

- 3D printing
- Lasers
- Electromechanical medical devices, software based diagnosis machines, acetabular and ophthalmic implants, and surgical and dental tools
- Automotive vehicle convertible roofs, sunroofs, electromechanical actuators, switches, interior trim, hybrid-electric powertrains, transaxles, windows, adhesives and mechanical fasteners
- Composite materials in the aerospace, automotive, wind turbine, generator and truck trailer industries
- Clothing, airbags, and other textile products and weaving machines
- Welding, clinching and other metal fastening techniques
- Injection molding and metal stamping machines
- Robotics and automated machinery
- Pharmaceutical and chemical compositions, manufacturing equipment and processing methods
- Cement and asphalt manufacturing equipment and compositions
- Food, beverage and agricultural crop processing, machines and containers
- Conveyors for mail and automotive parts
- Pleasure boats and large ships, including accessories
- Computer software for PDAs, smart phones and manufacturing equipment
- Plumbing including valves, faucets and fluid connectors
- Perfume and cosmetic compositions and containers
- Oil well extraction equipment and processes
- HVAC equipment, building water chillers and machine cooling systems

PRACTICE AREAS

Patents; Trademarks & Service Marks; IP Litigation; IP Transactions; International; PTAB Proceedings

INDUSTRIES

Automotive, Aerospace & Transportation; Chemistry & Materials Science; Clean & Green Technology; Consumer Products; Electrical, Computer & Internet; Energy Production & Delivery; Image Processing, Lasers & Optics; Manufacturing; Mechanical & Electromechanical; Medical Devices

KEY MATTERS

- *Laboratoires Majorelle SAS and Majorelle International SARL v. Apricus Biosciences, Inc., NexMed (U.S.A.), Inc., and Ferring International Center S.A. (dba Ferring Pharmaceuticals)* – SD NY (pharmaceutical patent and trademark license)
- *LD Technology v. Impeto Medical SAS v. LD Technology/A. Maarek* – SD Florida (electromechanical medical device patent, trademark, false advertising)
- *UUSI LLC (dba Nartron) v. Robert Bosch LLC and Brose North Am, Inc.* – ED Mich (anti-pinch window controller patents)
- *UUSI LLC (dba Nartron) v. Webasto Roof Sys., Inc.* – ED Mich (anti-pinch window controller patents)
- *Dental USA, Inc. v. McClellan et al.* – ND Illinois (dental tool design patent, trademark and copyright)
- *LT Overseas North America, Inc. v. New Royal Distributors, Inc.* – CD Cal (food trademark)
- *Jarvis Products Corporation v. Durand International S.A.* – WD Okla (hog slicing machine patent)
- *Specialty Vehicle Acquisition Corporation v. American Sunroof Corporation and Dmitri Chevtsov* – ED Mich (automobile trademarks)
- *Robison's, Inc. v. LoFom, Inc., et al.* – SD Cal (clothing trademark – Marshall seizure)
- *Astar v. Parhelion Technologies, Inc.* – AAA Arbitration (software development contract)
- *Babcock & Wilcox Co. v. Tidelands Oil Production Company, et al.* – CD Cal (oil extraction patent)
- *BDG-TNDR Corp. v. Honeywell and Johnson Controls Inc.* – SD Florida (HVAC patent)
- *Perceptron Inc. and Ford Motor Co. v. FORI Automation Inc.* – ED Mich (laser and software, automobile wheel alignment patent)
- *Olaes Enterprises Inc. v. A.D. Sutton, Robison's Inc. v. Orange County Choppers Ltd.* – ED NY (clothing copyright and trademark license)
- *Intersport Fashions West, Inc. v. Marco Distributing, Inc. (Robison's, Inc.)* – CD Cal (motorcycle jacket patent and false advertising)
- *ASC Inc. v. Dr. Ing. h.c.F. Porsche AG* – ED Mich (automobile convertible roof utility and design patents)
- *Injection Molding Industries v. CITO Products, Inc.* – ED Mich (molding machine manifold, false advertising and trade dress)
- *Interactive Frontiers, Inc. v. Astar and Parhelion Technologies, Inc.* – ED Mich (golf software copyright and trade secret)
- *Extang v. Custom Form* – ED Mich (truck tonneau cover patents)

- *United Technologies Automotive, Inc. v. Pontiac Coil* – ED Mich (solenoid automobile patent)

Exemplary Patents & Trademarks

NEWS/EVENTS

PRESENTATIONS

- Monte was the moderator for a 3D printing and advanced materials panel of technical experts and CEOs at Automation Alley's Integr8™ conference held in Detroit on November 9, 2017. Monte also gave a presentation of patenting trends in 3D printing at the same event. View his presentation on 3D Printing Patent Analytics online.
- Monte was a guest speaker on intellectual property topics to a new product development and marketing class at Walsh College in Troy, Michigan, in 2016 and 2017.

IN THE NEWS

- Monte Falcoff Discusses Risks for Medtech Companies if IPRs are Unconstitutional, *Medtech Insight*, May 8, 2018
- Monte Falcoff Discusses Overcoming Alice Patentable Subject Matter Rejections for Digital Health Innovators
- Harness Dickey Attorneys Interviewed by Law360 on Question of Art-Unit Shopping at the USPTO
- "Asked & Answered: Monte Falcoff on the Bad-Faith Patent Infringement Claims Act," *Oakland County Legal News*, February 1, 2017
- "Anecdotal Evidence Shows Both Success and Failure with AFAs," *Of Counsel*, December, 2016
- "Attorney: 'Brexit' to Impact European IP Rights," *Detroit Legal News*, July 4, 2016

PUBLICATIONS

ARTICLES

- "Combating Counterfeiting of Patents and Trademarks," *Currents Magazine*, Fall 2007

BLOGS

- Harnessing the Innovation of Aerospace & Defense

BACKGROUND

Monte has also served as an Adjunct Professor of various patent and trademark law classes at the Michigan State University College of Law for more than twenty years.

AWARDS & DISTINCTIONS

- *Best Lawyers*, Trademark Law, 2014-2019
- *Best Lawyers*, Patent Law and Litigation - Intellectual Property, 2018-2019
- *DBusiness Magazine*, "Top Lawyer," Intellectual Property and Patent Law, 2018
- *Leading Lawyers*, named a "Leading Lawyer" for Copyright & Trademark, Intellectual Property and Patents, 2014-2019
- *Business Magazine*, "Top Lawyer," Trademark Law, 2014
- Michigan State University College of Engineering, "AES Distinguished Alumni Award," 2008
- *Wayne Law Review*, Note and Comment Editor

MEMBERSHIPS

- Michigan State University College of Engineering, Chairman and Vice Chairman of the Applied Engineering Sciences Alumni Advisory Board, 2002-2013
- Michigan State University College of Engineering Alumni Advisory Board, 2014-present
- Wayne State University College of Engineering, Anderson Engineering Ventures Institute (Facilitating WSU startup businesses, innovation and entrepreneurship) Advisory Board Member, 2015-present

CIVIC & CHARITABLE

- Boy Scouts of America, Troop 1036, Assistant Scoutmaster, 2006-2012

EDUCATION

J.D., Wayne State University, 1992

B.S., Engineering, Michigan State University, 1986

BAR & COURT ADMISSIONS

Michigan

U.S. Court of Appeals for the Federal Circuit

U.S. Court of Appeals for the Sixth Circuit

U.S. Patent and Trademark Office