



Gregory M. Stone

PARTNER

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BIOGRAPHY

Co-Chair of the firm's Intellectual Property and Technology Practice Group, Mr. Stone has over 25 years of experience in the patent and general intellectual property fields, including his tenure as a United States Patent Examiner in the general mechanical and biomedical device arts. He has significant substantive depth and experience advising clients ranging in size from startups to Fortune 500 companies.

A degreed mechanical engineer, Mr. Stone focuses his practice on client counseling, substantive litigation support on high-value intellectual property infringement disputes in Federal Courts and administrative agencies, domestic patent and trademark prosecution and foreign patent and trademark prosecution, global strategic intellectual property portfolio development, intellectual property due diligence in complex merger and acquisition and other transactions, and licensing and other intellectual property transactions. The intellectual property matters he has managed for clients have involved diverse technologies, including medical devices and processes, computer software and general information technology, manufacturing equipment and processes, cyber security, clean energy, consumer products, construction materials and processes, communications

PRACTICES & INDUSTRIES

Intellectual Property & Technology

Advertising and Promotion Law

Computer Software & Hardware

Intellectual Property Litigation

Copyrights

International Intellectual Property

Internet and E-Commerce

Licensing & Technology Transfer

Patents

Technology Start-ups

Trade Secrets

Trademarks, Domain Names and Other Brand Protection

Transactional Intellectual Property

Product Design, Manufacturing and Distribution

International

Clean Energy Technology

EDUCATION

University of Baltimore School of Law, 1996, J.D., cum laude

University of Maryland, 1992, B.S., Mechanical Engineering

ADMISSIONS

Maryland

District of Columbia

U.S. Court of Appeals: Federal Circuit

U.S. Patent and Trademark Office

U.S. Supreme Court

technologies, electronics and electromechanics, fluid mechanics, materials sciences, chemistry, and general mechanics. He is licensed to practice before the United States Patent and Trademark Office.

Recognized by *Best Lawyers in America* as “Lawyer of the Year” in Baltimore in Patent Law, Patent Litigation and Intellectual Property Litigation, Mr. Stone has helped lead the firm’s Intellectual Property and Technology Practice Group to recognition by *U.S. News & World Report* as one of only 24 firms nationwide in the top tier for Technology.

RECOGNITIONS

- Named "Lawyer of the Year" by *Best Lawyers* for: Patent Litigation, Baltimore (2020); Intellectual Property Litigation, Baltimore (2018); Patent Law, Baltimore (2017); Intellectual Property Litigation, Baltimore (2016); Patent Litigation, Baltimore (2014)
- Recognized in *Chambers USA: America's Leading Lawyers for Business*: 2017
- Listed in *Maryland Super Lawyers*: 2012 – present

MEMBERSHIPS & ACTIVITIES

- Board Member: Maryland Tech Council
- Member: Intellectual Property Owners Association and Corporate Intellectual Property Management Committee
- Member: American Society of Mechanical Engineers
- Member: Maryland State Bar Association
- Member: American Bar Association; Intellectual Property Law Section
- Member: American Intellectual Property Law Association

INTELLECTUAL PROPERTY & TECHNOLOGY

- Advising clients on all aspects of their business relating to their technology and intellectual property issues
- Counseling clients on the development and deployment of strategic, company-wide intellectual property management strategies, including monetization, enforcement, licensing, and litigation strategies
- Prepare formal legal opinions on patentability, validity and invalidity, infringement and non-infringement, and unenforceability

PATENTS

- Counsel clients on the development and deployment of internal invention policies and procedures
- Counsel clients on the development and deployment of global patent filing and prosecution strategies
- Prepare, file, and prosecute patent applications, reissue patent applications, and reexaminations before the U.S. Patent and Trademark Office; conduct examiner interviews; file and manage appeals to the Board of Patent Appeals and Interferences
- Conduct and manage U.S. and international patent prosecution for multiple clients

COPYRIGHTS

- Representation of individual artists in procuring copyright protection
- Assisting clients with the development of internal copyright use and protection policies

TRADEMARKS, DOMAIN NAMES AND OTHER BRAND PROTECTION

- Counsel clients on the development of trademark usage policies and procedures
- Prepare, file, and prosecute applications for trademark registration before the U.S. Patent and Trademark Office

TRADE SECRETS

- Counsel clients on the development and deployment of internal trade secret recordation and maintenance policies
- Develop and provide counsel on confidentiality / non-disclosure agreements and employee invention agreements and policies

INTELLECTUAL PROPERTY LITIGATION

- Representation of clients before Federal Courts and administrative agencies in

patent and trademark infringement matters, including varied U.S. District Courts, the U.S. Court of Appeals for the Federal Circuit, the International Trade Commission, and the U.S. Patent and Trademark Office

- Conduct pre-litigation infringement investigations; work with technical experts in complex patent litigation; development of case strategy and substantive briefing on key infringement and validity issues
- Representation of clients in patent interference proceedings
- Preparation and issuance of cease and desist letters
- Drafting and negotiation of settlement agreements

TRANSACTIONAL INTELLECTUAL PROPERTY

- Manage intellectual property due diligence in complex merger and acquisition and other commercial transactions
- Prepare and negotiate transactional intellectual property agreements, including license agreements, development agreements, joint venture agreements, purchase and supply agreements, confidentiality and non-disclosure agreements, and employment and termination agreements

LICENSING & TECHNOLOGY TRANSFER

- Representation of major university technology transfer offices in patent prosecution matters
- Representation of clients in technology monetization through strategic licensing

INTERNATIONAL PRACTICE

- Representation of domestic clients ranging in size and technology in the development of global intellectual property portfolios
- Serving as special U.S. counsel for foreign clients seeking intellectual property protection in the U.S.

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TECHNOLOGY START-UPS

- Work with early stage companies in the development of low cost intellectual property protection strategies to ensure key protection is secured prior to public use or disclosure of the technology
- Assist entrepreneurs in the development of their own knowledge base of key issues relating to the protection and commercial exploitation of their intellectual property

PRODUCT DESIGN, MANUFACTURING AND DISTRIBUTION

- Representation of clients in the strategic development of patent and trademark portfolios
- Representation of clients in the preparation and negotiation of manufacturing, distribution, joint development, and other agreements

ADVERTISING AND PROMOTION LAW

- Assisting clients with the development of policies and procedures for trademark usage
- Assisting clients with avoidance of claims of “greenwashing” for products having alleged environmental benefits

COMPUTER SOFTWARE & HARDWARE

- Representation of clients in the development of global patent protection for computer implemented inventions
- Representation of clients in the preparation and negotiation of software development and license agreements

INTERNET AND E-COMMERCE

- Assisting clients with the development of website policies, including privacy policies, terms of use, and conducting website audits.

CYBER SECURITY, DATA MANAGEMENT & PRIVACY

- Assist clients in the development of intellectual property protection strategies for new technologies in the fields of secure data communications, secure networking, and secure data management

CLEAN ENERGY TECHNOLOGY

- Assist clients in the development of intellectual property protection strategies for new technologies in the fields of clean energy technology, including solar power systems and devices, wind-powered devices, wave energy devices, hybrid automotive transmissions, and biodegradable products

GREEN BUILDING AND SUSTAINABILITY

- Representation of clients developing high efficiency environmental control systems

PRESENTATIONS & PUBLICATIONS

Co-Presenter: *American Intellectual Property Law Association Webinar*, "Proper Combination of References for Obviousness (KSR v. Teleflex Progeny)?"

Presenter: *National Manufacturing Week 2007*, Chicago, IL

Presenter: *E-nnovations 2007 Mid-Atlantic Entrepreneurship Conference*, Anne Arundel County, MD

Guest Lecturer: University of Maryland, Baltimore County Graduate Business Program

Guest Lecturer: Loyola College, Fellows MBA Program, Joseph A. Sellinger, S.J., School of Business & Management

Guest Lecturer: TechCenter at the University of Maryland, Baltimore County

Guest Lecturer: Silver Spring Innovation Center

Guest Lecturer: The Maryland Technology Development Center