

# Brian E. Turung

Partner



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## Practices/Industries

- Patent Prosecution, Drafting & Consultation
- Trademark/Copyright Prosecution & Portfolio Management
- IP Litigation
- Technology Transactions

## Education

University of Houston  
(B.S., *cum laude*, chemical engineering, 1987)  
St. Louis University School of Law  
(J.D., 1990)

## Overview

For more than 30 years, Brian has helped clients secure and protect their intellectual property rights. He focuses his practice on patent and trademark prosecution and enforcement, and has successfully obtained worldwide protection for clients in a number of highly technical fields. He uses his background in chemical engineering and broad experience in intellectual property to help clients leverage their IP rights and achieve their goals. He is particularly skilled at helping clients, both large and small, identify and understand optimal IP strategies in light of their commercial objectives.

Brian's technical knowledge helps him understand the complex needs of his diverse clients. He has special experience providing counsel in inorganic and organic chemistry and biochemistry. He advises clients regarding a wide range of technologies including medical devices, welding fluxes and electrodes, welding equipment, hardbanding, filter systems, catalysts, roofing systems, metal coatings, inflatables, industrial spring systems, industrial spring monitoring systems, hydraulic equipment, food chemistry, and aerospace equipment. He also has experience with copyright prosecution and IP licensing, and provides technical expertise in high stakes IP litigation.

## Experience

- Identifies and advises clients of the advantages of IP ownership, prosecution, and protection strategies.
- Counsels clients as to securement, ownership, licensing, avoidance of infringement, dispute resolution, and enforcement of patents, trademarks, and copyrights.
- Manages large IP portfolios, including extensive patent and trademark portfolios, for domestic and international corporate clients.
- Prepares and facilitates ongoing prosecution of patent applications at the U.S. Patent and Trademark Office (USPTO) in the chemical, mechanical, electrical, and computer science arts, and coordinates the filing and prosecution of Patent Cooperation Treaty (PCT) and foreign national patent applications.
- Prepares and facilitates ongoing prosecution of trademark applications at the USPTO and foreign countries.
- Counsels clients with respect to structuring and managing invention identification and protection programs.
- Counsels clients with respect to marketing strategies, trademark strategies, and branding strategies to maximize protection of clients' products and brands.
- Structures and documents licensing and other transactions for the commercialization of patents and related assets and rights.
- Conducts IP due diligence for mergers, acquisitions, and divestitures.
- Counsels clients with respect to patent portfolio development and management and related research and development activities.

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## Experience (Cont)

- Prepares patent and trademark related legal analyses and opinions, including oral and written patentability, landscape, freedom to practice, infringement/non-infringement, and validity/invalidity opinions.
- Drafts, analyzes, and negotiates intellectual property agreements involving licensing, joint development, supply, consulting, confidentiality, and settlement.
- Has patent litigation experience in federal court, including patent claim construction strategy, Markman proceedings, trademark infringement, and many aspects of discovery including third party discovery, depositions, and expert discovery.
- Has trademark opposition and cancellation experience at the USPTO.

## Involvement

### Professional Affiliations

- American Bar Association
- Cleveland Metropolitan Bar Association
- Intellectual Property Law Association
- Intellectual Property Owners Association

### Community Involvement

- Provided pro bono work for startups, individuals, and environmental organizations such as Great Lakes Biomimicry

## Admissions

- State of Ohio
- U.S. Supreme Court
- U.S. Court of Appeals, Sixth Circuit
- U.S. Court of Appeals, Federal Circuit
- U.S. District Court, Northern District of Ohio
- U.S. Patent & Trademark Office