

Merchant & Gould Taps Two Partners To Lead Practice Group

By Emily Sides

Law360 (June 23, 2021, 11:54 AM EDT) -- Intellectual property firm Merchant & Gould PC has tapped an Atlanta partner who has engineering experience and a Minneapolis partner who was a patent examiner in the U.S. Patent and Trademark Office to lead its patent design and trade dress group, the firm announced on Monday.

The firm selected Loretta L. Freeman of Atlanta and Ryan C. Smith of Minneapolis as the first leaders of the practice group.

Christopher J. Leonard, the firm's managing director, CEO and chairman of the board, told Law360 Pulse on Tuesday that the firm has increasingly seen more patent design and trade dress protection as clients seek to command a unique spot in the market.

"We've been doing that work all along, but [this group] gave us the opportunity to create a truly interdisciplinary group that would call on the talents of people from each of those groups to come together in a new group if you will, so they can first of all learn from each other, but also teach each other," Leonard said.

Utility patents cover a product's functional aspects, whereas a design patent involves product design aesthetics, and trade dress protects the look and feel of products or businesses, Leonard said.

"As the competitive landscape gets even more competitive, particularly with so much online commerce, the need for our clients to be able to distinguish themselves from the competition has gotten more intense in recent years," Leonard said. "So we see growth in patent design and trade dress side, and that made us realize we need this group."

Leonard said this practice group will support all of the firm's 90 attorneys, including the firm's virtual-for-now office in Los Angeles, which opened last month as its first location on the West Coast.

"I am a big fan of my colleagues and friends here at the firm, so the ability to put a couple of my colleagues into a position like this, to lead us with a new initiative like this, it's very exciting," Leonard said.



Loretta L. Freeman



Ryan C. Smith

Leonard said Merchant & Gould selected Freeman and Smith, because they both have extensive experience in patent design and trade dress. They're also in two different practice groups: Smith is in the chemical and life science practice, and Freeman is in its mechanical group.

Freeman and Smith told Law360 Pulse on Tuesday that they want to gather their group's expertise under one umbrella, which includes teaching and collaborating with their colleagues.

"We're both just very excited about this new role and the ability to bring subject matter experience to our clients, and we look forward to where this is going to go and grow," said Freeman, who was promoted to partner last year.

Smith, who was named partner in 2018, said he and Freeman will lead with their experience in design patent and trade dress. Smith said he's seen an increase in innovators across industries seeking out design patent and trade dress protections.

"Loretta and I are bringing a different type of approach in that we're trying to solidify and draw on all of the expertise of our law firm and put it into a single, unified group," Smith said. "Our goal is to provide both internal information to attorneys, but also to provide our clients with the most holistic, IP approach that we can."

The patent design and trade dress group has 14 attorneys, Freeman said.

"It's wonderful to bring awareness to those [clients] who need help in this space," Freeman said. "Since going live on our website, we've had many inquiries from potential clients, calling us with issues that they face with counterfeiting and seeing their products being sold online, someone's copying their design or their overall packaging."

The group includes other Merchant & Gould practice area leaders, such as Heather J. Kliebenstein, chair of the firm's litigation practice; Julie R. Daulton, co-chair of the firm's mechanical practice; and William D. Schultz, co-chair of its internet, cybersecurity and e-commerce practice.

"We want to focus on making sure that everyone in the firm is up to date on the latest case law and the trends and the prosecution of design patents and trade dress," Freeman said.

Freeman said they plan on attending other practice areas' monthly meetings. Such connections will ensure that the patent design and trade dress group can provide insight for the entire firm, Smith said.

Smith, whose practice includes advising clients on consumer products, said the practice helps clients protect their intellectual property.

"[Loretta and I have] both seen upticks in trends as there's more online sales, and being able to get something protectable faster has become critical," Smith said. "Right now, our ability to be nimble, fast and efficient and do a bang-up great job for our clients is what sets us apart from most other groups."

Freeman said protecting unique product packaging for brands is vital, "because we know that failing to do this allows competitors to imitate it and cause consumer confusion."

She said pursuing design patents can take less time than filing for utility patents.

"There are several advantages to filing design patents and getting that trade dress protection, and our clients are becoming more and more aware of that," Freeman said.

Freeman, who's been at Merchant & Gould for nearly a decade, is also an adjunct professor at the Mitchell Hamline School of Law. Before joining the firm, she was a senior product development engineer at 3M Co. for 11 years.

Smith, who's been with the firm for more than six years, was an attorney at Larkin Hoffman Daly & Lindgren Ltd. before joining Merchant & Gould. Smith was also a patent examiner at the U.S. Patent and Trademark Office, an IP law clerk at American Medical Systems and a biomedical researcher at Creighton University.

--Editing by Brian Baresch.