



Sean D. O'Brien

Partner

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iplawtrends.com

“I enable my clients to make pragmatic business decisions based on their business goals and budgetary requirements. I do this by providing candid, thorough information and helping my clients make sense of that information. The ‘sky’s the limit’ approach isn’t usually the best one, so I focus on strategies that would have the most value in the context of the client’s business.”

Sean O’Brien assists clients with obtaining, maintaining, and enforcing patent, trademark, copyright, and trade secret rights in the United States and around the world. This includes preparing patentability, trademark registrability, and infringement opinions. He also negotiates agreements that relate to intellectual property, such as licenses, services agreements including SaaS and professional services agreements, supply agreements, confidentiality agreements, and many other IP-influenced agreements. For cross-border business transactions and IP prosecution, Sean works with a network of legal counsel who can advise on best practices for jurisdictions outside of the United States.

Sean also advises buyers and sellers of intellectual property with due diligence investigations, including verifying the content, scope, and ownership of patents, trademarks, and copyrights as well as developing validity and infringement positions.

In addition, Sean advises and represents clients in opposition and cancellation proceedings before the Trademark Trial and Appeal Board (TTAB), as well as for post grant review and inter partes review patent proceedings before the Patent Trial and Appeal Board (PTAB). He also asserts and defends patent, trademark, copyright, and trade secret matters through litigation and resolves intellectual property disputes outside of litigation.

Before becoming a lawyer, Sean worked as a mechanical design engineer and project engineer at an aerospace company, where he designed, tested, and resolved manufacturing problems for antiskid brake control valves. He also worked in the automotive industry with door seal and wiring harness technologies, which included his first professional exposure to patent law. Sean’s undergraduate degree is in engineering, with a focus on fluid dynamics and thermodynamics.

Drawing on his prior broad experience, he aims to meet his client’s intellectual property goals in a candid, adept manner.

Education

J.D., Loyola Law School, 2005

- Dean’s Honor List
- First Honors Award, Trademark Law
- Chief Production Editor, *Loyola Law Review*

B.S., Case Western Reserve University, fluid and thermal engineering, 1995

- Dean’s Honor List

Bar Admissions

Oregon, 2014
 California, 2005
 U.S. Patent and Trademark Office, 2002

Court Admissions

U.S. District Court, Central District of California
 U.S. District Court, Northern District of California
 U.S. District Court, District of Oregon
 U.S. Court of Appeals, Federal Circuit

Representative Experience

Technology

- Defend software as a service (SaaS) provider in trademark infringement litigation resulting in a successful resolution through mediation.
- Advise manufacturer of video game controllers on patent protection for inventions and trademark protection for brands; clear product and branding ideas; prepare and file patent and trademark applications around the world.
- Develop and implement patenting strategy for medical device maker, including preparing and prosecuting patent applications in the U.S., Europe, and elsewhere.
- Advise developer of storm windows on cost-effective patent strategies within and outside of the United States.

Emerging Business

- Prepare patenting strategy and patent applications for developer of improved brake drums for heavy vehicles.
- Prepare and prosecute patent applications for developer of portable, pressurized beverage containers.

Intellectual Property Agreements

- Counsel multinational, custom-products manufacturer on international license, manufacturing, and distribution agreement, including negotiating and drafting the agreement.

Renewable Energy

- Manage patent portfolio for developer of hydroelectric power generation systems, including due diligence for patents to be acquired for the portfolio and directing U.S. and foreign prosecution of patent applications.

Consumer Products

- Advise supplier of compostable tableware and containers on all aspects of intellectual property protection and enforcement, including worldwide trademark portfolio, international distribution agreements, and risk evaluation related to intellectual property.
- Prepare U.S. and design patent applications and international industrial design registrations for cutlery designer.

Publications

- "Why the Law Encourages Copycats (And What You Can Do about It)," Miller Nash, *IP & Technology Law Trends* (Feb. 2023)
- "U.S. Patent and Trademark Office Issues New Examination Guidelines in View of Booking.com," Miller Nash Graham & Dunn, *IP Law Trends* (Nov. 2020)
- "Enforcing Trademarks in Online Marketplaces," LinkedIn (Nov. 2020)
- "Trademark Infringement Risk for U.S. Goods Manufactured Abroad," Miller Nash Graham & Dunn, *IP Law Trends* (Aug. 2020)
- "Supreme Court Reinforces Position That the Patent Office Has the Final Say on Whether to Initiate an Inter Partes Review," Miller Nash Graham & Dunn, *IP Law Trends* (Apr. 2020)
- "'Secret Sales' of an Invention Continue to Be a Potential Bar to Patent Rights, Even After the America Invents Act," Miller Nash Graham & Dunn, *IP Law Trends* (Jan. 2019)
- "U.S. Trademark Office Now Auditing Affidavits of Use," LinkedIn (Jan. 2018)

Recognition & Honors

- Recognized as a "Notable Practitioner" by *Chambers USA* in Intellectual Property, 2020-present

Personal Activities

Outside of work, Sean enjoys watching his daughter discover the world, skiing, hiking, live music, watching soccer, and learning to play the guitar.