

As Seen In

Long Island
BusinessNEWS

Sept. 23-29, 2005

WHO's WHO in Intellectual Property Law

Paul Esatto Jr.

Scully Scott Murphy & Presser

Paul Esatto Jr. is a senior partner at Scully Scott Murphy & Presser (SSM&P) of Garden City. Founded in 1973, SSM&P is a full service intellectual property law firm representing Fortune 100 and start-up companies in the U.S. and around the world. The firm litigates patents, trademarks, trade secrets and copyrights in a range of technology and business environments. Other key areas of its practice include providing precise and reliable opinions, and preparing and prosecuting trademarks and copyrights.

Esatto has years of experience in patent, trademark, copyright and unfair trade practices litigation in the federal and state courts. His area of practice also includes trademark opposition and cancellation practice; licensing of intellectual property; portfolio management and counseling; patent procurement with technical expertise in computers, communications, semiconductors, networking, software, circuits, electronic devices, Internet technology, business methods and nanotechnology.

Esatto recommends that companies establish a patent committee that sets goals and works closely with patent attorneys to be sure intellectual property goals are met.

"Institute a corporate patent policy



requiring engineers/research scientists to submit inventions disclosures to the patent committee on a monthly basis, with a cash award for disclosures that are converted into patent applications," he said.

Whether it's a company or individual with a new product, Esatto advises them to file a patent application before offering the invention or product containing the invention for sale. "Do not disclose

the invention to anyone without an NDA, before filing a patent application," he noted.

In addition to guiding parties through patents procedures, IP attorneys provide services in other areas, Esatto noted. Some areas that individuals and businesses should be aware of include trademarks (names for products or services), product design; package design; trade secrets (business information including customer lists and manufacturing methods), copyrights and domain (Web site) name usage.

Esatto received his bachelor's of engineering, electrical, from City College of New York and his juris doctor from St. John's University School of Law. He was admitted to the NYS Bar in 1984; the U.S. Court of Appeals, Federal Circuit; and the U.S. District Court, southern and eastern districts of New York. He is registered to practice before the U.S. Patent and Trademark Office.

Esatto is a member of many organizations including the NYIPLA; AIPLA, IP Practice in Japan committee; INTA; LES; Suffolk County Bar Association; IEEE, Long Island Association; LIFT; and LISTnet, business & technology law committee.