

**James E. Hudson III** *Shareholder*

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## Overview

James E. Hudson III works to protect the products of the mind – inventions, artistic creations, and brands – for individuals and businesses, collectively known as intellectual property or IP. These protections take the form of patents, trade secrets, copyrights, and trademarks, and may include licenses and acquisitions, employee and contractor agreements, non-compete agreements, and internal product reviews. Jim represents clients suing violators for infringement of any of these protections, or defending against the claims of competitors.

## Education

South Texas College of Law, J.D., 1996

Texas A&M University, B.S. in Mechanical Engineering, 1994

## Practice Areas

Intellectual Property

Commercial Litigation

Jim’s experience in IP is the result of setting and accomplishing clearly defined goals, a trait he has carried forward. When pressed in high school to provide a personal statement for his Eagle Scout award, he stated that he wanted to be a Patent Attorney. His father held several patents and Jim enjoyed learning about new technologies. On this path, Jim obtained a bachelors in Mechanical Engineering from Texas A&M University, passed the Patent Agent Exam, and graduated from South Texas College of Law/Houston.

Jim’s knowledge is enhanced by his professional experience. Jim spent eight years practicing at a small firm, ultimately known as Keeling Hudson, before joining Crain Caton & James. As an attorney in a small firm, Jim gained experience in protecting client intellectual property, in preparing and trying cases, and in addressing issues on appeal. Jim prosecuted patents and trademark registrations for his clients and litigated before various Texas trial and appellate courts, the U.S. Fifth Circuit Court of Appeals, and the Texas Supreme Court. Since joining Crain Caton & James, Jim has expanded that representation to federal courts in other states and the U.S. Federal Circuit Court of Appeals.

Clients appreciate Jim’s start-to-finish assessment of IP matters, and finding

## Admissions

State of Texas

United States Patent and Trademark Office

U.S. Courts of Appeals for the Fifth and Federal Circuits

U.S. District Courts for the Northern, Southern, Eastern and Western Districts of Texas

the appropriate solution to the client's problem. His work includes ensuring that appropriate agreements and documents establish the business owns the resulting IP, securing protection for that IP in various countries around the world, and litigating against competitors who copy the IP or overreach on claims of IP ownership.

## Technology Protection

### Technology Transfer and Acquisition

- Represented client in due diligence for sale of domestic producer of products for preventive and remedial waterproofing, soil stabilization and concrete repair to producer of high performance specialty chemical and material supply leader
- Assisted in transfer of patent and trade secret rights from client to another entity
- Represented client in acquisition of patents and trade secret technology

### Patent Issuance and Maintenance

- Obtained and maintains over seventy (70) U.S. patents for clients relating electro-mechanical systems, such as grain milling equipment, medical devices and fitness equipment, chromatography equipment, fuel additive systems, and aircraft transporter systems
- Obtained and maintains, through foreign associates, over one hundred national or regional patents outside the United States, including in: Australia, Belgium, Brazil, Canada, China, European Patent Office, France, Germany, Hong Kong, India, Italy, Japan, Mexico, Netherlands, Korea, Russia, Spain, and Sweden

### Trade Secret Maintenance

- Conducted annual reviews with clients of existing safeguards to ensure confidentiality of proprietary information, including review of handbooks and identification of issues for communications to employee

### Patent Application and Issued Patent Administrative Challenges

- Prepared and filed pre-issuance challenges to published U.S. Patent Applications to notify U.S Patent & Trademark Office of relevant prior art

- Assisted in preparation and filing of post-issuance ex parte re-examinations

### **Technology Rights Actions**

- Represented patent owner in patent suit and obtained dismissal based on standing (ownership) issues
- Represented franchisor in consolidated patent infringement action with 300 other defendants, and served as lead draftsman on a summary judgment motion, ultimately joined by over 100 defendants before obtaining settlement for client
- Represented business in patent infringement action brought by principal competitor together with co-counsel, obtaining stay of litigation and reexamination of patent-in-suit in challenge to patent validity, and pursuing parallel actions to drive matter to acceptable resolution
- Represented trade secret owner in obtaining temporary relief to enjoin former employee from retaining corporate trade secrets, and resolved enforcement action in favor of client
- Assisted in representing trade secret owner in enforcement action against former employee, which resulted in judgment for client against former employee
- Assisted in representing trade secret owner at trial against employees, and argued for client before Fifth Circuit Court of Appeals

### **Licensing**

- Assisted client in obtaining license of patents and trade secrets

## **Brand Protection**

### **Brand Transfer and Acquisition**

- Represented client in due diligence for sale of domestic producer of products for preventive and remedial waterproofing, soil stabilization, and concrete repair to producer of high performance specialty chemical and material supply leader
- Represented client in transfer of secondary trademark family to new entity
- Represented client in transfer of corporate trademarks to holding company
- Represented client in acquisition of internet domain and trademarks associated with underlying business

### **Trademark Registration and Maintenance**

- Obtained and maintains over three hundred (300) U.S. trademark registrations for clients
- Obtained and maintains, through foreign associates, over one hundred thirty (130) trademark registrations outside the United States, including in: Argentina, Aruba, Australia, Barbados, Benelux (Belgium/Netherlands/Luxembourg), Bermuda, Bolivia, Brazil, Canada, Chile, China, Columbia, Costa Rica, Denmark, Ecuador, El Salvador, European Community, Fiji, Germany, Guatemala, Honduras, India, Jamaica, Japan, Mexico, Netherlands, New Zealand, Pakistan, Panama, Peru, Portugal, Spain, Switzerland, Trinidad & Tobago, Turkey, United Kingdom, and Venezuela

### **Trademark Registration Challenges**

- Successfully represented franchisor in oppositions to numerous U.S. trademark applications, resulting in termination of the application, or narrowing of goods/services or use
- Successfully represented chemical manufacturer in opposition to trademark applications outside the United States, through foreign associates, obtaining narrowing or abandonment of application at issue
- Successfully represented manufacturer against challenge to a trademark registration at U.S. Patent and Trademark Office, where cancellation of registration was sought, resulting in dismissal of cancellation proceeding
- Successfully represented service company in challenge to client trademark applications at U.S. Patent and Trademark Office, where opposer sought to prevent registration of client's marks

### **Trademark Enforcement Actions**

- Represented original trademark owner at district court in dispute over trademark ownership arising among family-owned companies wherein ownership and licensing were not reduced to written instruments, including reversal of partial summary judgment against client
- Represented manufacturer at district court in response to claims of trademark and trade dress infringement in components manufactured by former subcontractor, resolved by settlement
- Represented manufacturer at district court against competitor who reproduced client trademarks on website in manner likely to lead to confusion as to source or affiliation. Resolved without filing infringement case
- Represented franchisor against claims at district court by charity of trademark infringement over franchisor's charity drive. Resolved after

filing competing cases in Texas and Washington D.C.

- Represented service company at district court against injunction action brought by large competitor seeking to terminate competition
- Represented client at district court against manufacturing contractor who asserted trademark rights in specialty-order components for client product
- Represented client on appeal trademark action to U.S. Court of Appeals for the Fifth Circuit in New Orleans, including arguing case before appellate panel

### **Licensing**

- Assisted client in licensing trademarks to catalog company for generating additional revenue and expanding the brand.
- Represented client in licensing the trademarks to subsidiaries to maintain quality control across corporate family

### **False advertising issues**

- Represented client against false advertising claims by competitor
- Brought false advertising claim against competitor, persuading changes in advertising at issue.

## **Copyright Protection**

### **Registration and Maintenance of Copyright**

- Registered copyrights for clients in variety of artistic expressions including sculptures, corporate manuals, and computer code
- Prepared and filed corrective documents for copyright registrations

### **Transfer and Acquisition of Copyright**

- Prepared assignments of copyright for asset sale
- Prepared assignments of copyright incident to independent contractor agreements
- Prepared assignments of copyright incident to architectural plan issues
- Prepared employee copyright agreements

### **Transfer and Acquisition of Copyright**

- Successfully represented builder against claims of independent architect, who left job prior to completion of work
- Successfully represented builder against claims of unrelated architect related to home designs
- Successfully represented independent artist against infringing party who knocked off artistic decoration and flooded market
- Successfully represented business against website designer over ownership of website and associated profits

## Professional

- Author: *A Survey of the Texas Unfair-Competition Tort of Common-Law Misappropriation*, 50 Baylor L. Rev. 921, 922-23 (1998) [cited in *Texas Integrated Conveyor Sys., Inc. v. Innovative Conveyor Concepts, Inc.*, 300 S.W.3d 348, 369 (Tex. App. –Dallas 2009, review denied), in *Parker Barber & Beauty Supply, Inc. v. The Wella Corp.*, No. 03-04-00623-CV, 2006 WL 2918571, at \*14 n. 15 (Tex. App. Oct. 11, 2006), and *Los Cucos Mexican Cafe, Inc. v. Sanchez*, No. 13-05-578-CV, 2007 WL 1288820, at \*4 (Tex. App. May 3, 2007)]
- Author: *The U.S.-Japan Agreement for Eighteen Month Publication of U.S. Patent Applications: How Should It Be Implemented?*, 5 J. Int'l L. & Prac. 87 (1996)
- Speaker: CLE Committee - State Bar of Texas. *Advanced Patent Litigation: Strategies and Tactics*; Summer 2006
- Presenter: Crain Caton & James Continuing Legal Education Series. *Intellectual Property for Businesses – Types and Underlying Issues*; June 2008
- Presenter: Houston Association of Legal Professionals Continuing Legal Education Series. *Introduction to Trademarks*; January 2012
- Presenter: Crain Caton & James Continuing Legal Education Series. *Introduction to Trademarks*, March 2013
- Presenter: Crain Caton & James Continuing Legal Education Series. *The Intellectual Property in Your Practice*; July 2014