



Tony Barkume

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Tony represents clients of all sizes, from individual inventors and start-ups to multi-national corporations, and understands the value of IP from the business perspective. Tony has expertise in mobile and wireless technologies, computer hardware and software, network and Internet-based inventions, security systems including alarm and access control systems, sensor technologies, e-commerce, reward/loyalty systems, financial instruments, radio frequency and antenna technologies, and bar code systems and methodologies.

Areas of Concentration

- Focus on preparation, prosecution and acquisition of patents in the United States and abroad (written/prosecuted over 250 issued patents); management and strategies for large patent portfolios
- All phases of prosecution before the U.S. Patent and Trademark Office, including Examiner interviews, appeals, strategic use of continuation practice, offensive and defensive patent reexaminations
- Successful prosecution in overcoming 101/Alice rejections, including Supplemental Examination procedures
- Proceedings before the Patent Trial and Appeal Board (PTAB) including Appeals and Covered Business Method proceedings
- European Patent Office proceedings at The Hague and Munich including Oral Proceedings in prosecution and opposition phases for European patents.
- Analysis of third party patent portfolios for freedom of use opinions, development of non-infringement/ invalidity positions, risk analysis, counseling in product design-around for liability avoidance, claim charts and analysis for litigation support
- Review of third party products and services, determination of infringement of client's patents with recommendations for litigation or licensing

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- Extensive experience in developing progressive licensing strategies from both the licensor and licensee perspectives, brainstorming sessions and invention mining within business groups, presentation of in-house patent seminars, and development of a corporate patent-centric approach
- Intellectual property audits and analysis, support of mergers and acquisitions and other corporate transactions through due diligence reviews, portfolio analysis, risk assessment

Member

- American Intellectual Property Law Association
- New York State Bar Association

Admitted to Practice

- New York State
- U.S. District Courts for the Southern District of NY and Eastern District of NY
- United States Patent and Trademark Office
- United States Court of Appeals for the Federal Circuit

Education

- St. John's University School of Law, J.D. *magna cum laude* 1991; Law Review
- Stony Brook University, B.E. in Electrical Engineering 1980-1982
- Columbia University, School of Engineering & Applied Science 1977-1979

Experience

Legal

- Greenberg Traurig LLP, New York, NY: Partner, Co-Head of Patent Prosecution for IP National Practice Group
- Symbol Technologies, Inc., Holtsville, NY: In-House Patent Counsel
- White & Case, New York, NY: Associate
- Hedman, Gibson & Costigan, P.C., New York, NY: Patent Attorney

Engineering

- Hazeltine Corp., Greenlawn, NY: Senior Design Engineer
- AIL Corp., Deer Park, NY: Electrical Engineer