



Eric C. Osterberg

Director

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Eric is a Director of the firm and chair of the Intellectual Property Practice Group in the firm's Boston office. He represents copyright, trademark, and patent owners and users in traditional and emerging industries. His clients include software and video game companies; music, motion picture, and television companies; book publishers; composers and authors; advertising agencies; and clothing designers.

Eric's transactional experience includes negotiating and drafting trademark and copyright licenses; software licenses, including for SaaS; and vendor agreements, particularly with respect to software development. His practice includes preparation of trademark and copyright applications, trademark prosecution, opposition and cancellation in the USPTO, IP clearance and due diligence, evaluating IP, product liability, and advertising risks with respect to the launch of new products, and website terms of use and privacy policies.

An experienced trial lawyer, Eric litigates cases in courts across the country on issues of concern to intellectual property owners and users, including cases concerning trademark and trade dress infringement; international and domestic copyright infringement; patent and design patent infringement; trade secret disputes; breaches of licensing and entertainment industry contracts; counterfeiting; and false advertising. His commercial litigation experience includes representing businesses in contract disputes and representing vendors and purchasers in cases involving failed computer systems.

Eric began his career in New York 30 years ago, practicing at a boutique IP firm alongside his father, with whom he coauthored the copyright treatise [Substantial Similarity in Copyright Law](#). He went on to practice at two large firms. He joined Preti Flaherty after running his own IP boutique in Boston and Stamford, Connecticut.

Services

- [Intellectual Property & Technology](#)

Admissions

- Connecticut
- Massachusetts
- New York
- U.S. Court of Appeals, First Circuit
- U.S. Court of Appeals, Second Circuit
- U.S. Court of Appeals, Third Circuit
- U.S. Court of Appeals, Eighth Circuit
- U.S. Court of Appeals, Federal Circuit

- U.S. District Court, District of Connecticut
- U.S. District Court, District of Massachusetts
- U.S. District Court, Eastern District of New York
- U.S. District Court, Southern District of New York

Education

- Emory University School of Law (J.D., 1992)
 - Emory Law Journal, Board of Editors
- Northwestern University (B.A., 1988)
 - History

Professional Activities

- Copyright Society of the U.S.A., Website and Media Library Committee
- International Trademark Association
 - Copyright Committee, 2022-Present
 - Leadership Development Committee, 2020-2021
 - Lefkowitz Moot Court Committee Brief Judge, 2011-2012
 - Courts & Tribunals Subcommittee, 2008-2009
 - Anti-Counterfeiting and Enforcement North America Subcommittee, 2006-2007
- *AIPLA Quarterly Journal*, Editorial Board 2012-2014

Civic and Charitable Activities

- Boston Volunteer Lawyers for the Arts, 2015-Present
- Northwestern University Alumni Admission Council, 2006-Present
- Town of Wilton, Connecticut
 - Water Pollution Control Authority, 2013-2014
 - Planning and Zoning Commission, 2007-2010
 - Committee on Elderly Tax Relief, 2007

Honors & Recognition

- Martindale-Hubbell, AV Rating
- *Emory Law Journal*, Top Lawyer for 2010, Fairfield County, Litigation and Intellectual Property

Speaking Engagements

Eric's speaking engagements include appearances before the USPTO Global Intellectual Property Academy, The Copyright Society of the U.S.A., The Copyright Society of the South, the Licensing Executives Society, the Boston Patent Law Association, the Westchester/Southern Connecticut Chapter of the Association of Corporate Counsel, the New York State Bar Association, and the Fairfield County Bar Association.

News

October 23, 2023

Representative Matters

- Copyright and trademark counsel to Fortune 500 electrical manufacturer
- Outside intellectual property and licensing counsel to U.S. affiliate of European conglomerate offering a wide range of innovative software solutions. Negotiated and drafted SOW, SaaS, and other software licensing agreements.
- Helped Swedish technology developer and manufacturer address product liability, advertising laws, and other legal issues pertaining to its expansion into the United States
- Negotiating and preparing copyright and trademark licensing and sponsorship agreements
- Clearing trademarks and prosecuting trademark applications for a variety of businesses
- Represent collective licensing society in copyright litigation against infringers
- Obtained large settlement for music publisher in connection with unauthorized international use of musical composition by one of the world's largest motor companies
- Served as lead trial counsel supervising team of four defending publisher and conference organizer in litigation involving alleged false advertising and defamation based on Website and social media posts
- Tried trade secret misappropriation and breach of non-compete agreement claims with team of four lawyers and two paralegals on behalf of office equipment provider
- Served as lead counsel with team of four lawyers and paralegal representing business method patent owner in patent infringement litigation involving credit cards

Writings

- [*Substantial Similarity in Copyright Law*](#) with Robert Osterberg, treatise with annual updates published by the Practising Law Institute, 2003-Present
- *Copyright Infringement: Analyzing Substantial Similarity*, Practical Law Company, 2013-Present
- "[Copyright Litigation: Substantial Similarity](#)," *Practical Law The Journal*, July, 2024
- *AIPLA Model Patent Jury Instructions*, 2015
- "Copyright and Contract Law on the Internet," *Connecticut Law Tribune*, April 20, 2015
- "Copyright Fair Use Uncertainty Continues, Should Copyright Litigants Be Forum Shopping?," *Connecticut Law Tribune*, October 20, 2014
- "Injunctions, Sunset Royalties and Future Royalty Rates," *Connecticut Law Tribune*, October 5, 2012
- *ABA Model Jury Instructions: Copyright, Trademark and Trade Dress Litigation*, 2008
- "Potential New Hazards for Patent Licensors," *Connecticut Law Tribune Intellectual Property Supplement*, April 2007
- "Should Sound Recordings Really Be Treated Differently Than Other Copyrighted Works? The Illogic of *Bridgeport v. Dimension Films*," 53 J. Copyright Soc'y U.S.A. 619, Spring 2006-Summer 2006
- "Secondary Liability after *MGM v. Grokster*," *Metropolitan Corporate Counsel*, Vol. 13, No. 9, Sept. 2005
- "How to Evaluate Copyright Infringement Claims Involving Computer Programs: An

Explanation of the Abstraction/Filtration/Comparison Test," *Journal of Internet Law*, Vol. 8 No. 4, Oct. 2004

- "A Primer on IP Insurance Options," *The Intellectual Property Strategist*, Vol. 10 No. 9, June 2004
- "Copyright Infringement of Computer Programs," *IP Litigation Quarterly*, June 2004
- "A Primer on Intellectual Property Risk Management and Insurance," published in *Les Nouvelles*, June 2003; republished in *The Licensing Journal*, Vol. 23, No. 10, November/December 2003.
- "What Napster Means for Copyright Infringement Litigation," originally published in *ABA IPL Newsletter*, Spring 2001; republished in *The Best Articles Published by the ABA*, March 2002
- "Insurance and Management of Intellectual Property Risks," with Melvin Simensky, 16 *Entertainment and Sports Lawyer* No. 2 at 3, Summer 1998; republished in 17 *Cardozo Arts & Entertainment Law Journal* No. 2 at 321, Spring 1999
- "Insurance and Management of Intellectual Property Risks," with Melvin Simensky, chapter in *Intellectual Property in the Global Marketplace*, John Wiley & Sons, Inc., 1999
- "The Management of Intellectual Property Risks," with Melvin Simensky, chapter in *Handbook of Business Strategy*, Faulkner & Gray, 1999