



Joseph R. Falcon, III

Partner

Office: Malvern, PA

Email: jfalcon@barley.com

Tel: Tel: (610) 889-3697

OVERVIEW:

Joe Falcon is an [intellectual property lawyer](#) with deep knowledge in patent, trademark, trade secret and copyright law. As a registered U.S. Patent and Trademark Office patent attorney, Joe is recognized for his comprehensive understanding of intellectual property rights and his ability to provide strategic legal counsel to clients in diverse industries.

With an unwavering passion for the intersection of law and innovation, Joe focuses on all aspects of patent and trademark law, including prosecution, licensing, litigation, validity and infringement studies, and IP-related business counseling. He is a valued member of the Intellectual Property and Litigation practice groups, leveraging his skills and knowledge to assist clients at every stage of their intellectual property journey.

Joe's clientele ranges from early-stage startups to established companies, and he is known for developing and commercializing patent portfolios tailored to meet the specific business needs of his clients. He works closely with his clients, understanding their goals and helping them navigate the complexities of intellectual property law to protect their innovations and maximize their market advantage.

Throughout his career, Joe has consistently demonstrated his ability to handle a wide range of complex intellectual property cases. He brings a meticulous approach to protecting the intellectual property rights of his clients. Some notable examples of his work include:

- **Asserting Patent Rights Against Willful Infringers:** Joe has built a strong reputation for vigorously asserting patent rights on behalf of his clients in highly competitive marketplaces. He has successfully navigated intricate legal landscapes to hold those accountable who willfully infringe on his clients' patents. Joe's strategic and assertive approach ensures that his clients' innovations are safeguarded and receive the recognition and compensation that they deserve.
- **Expert Counsel for Startups:** Recognizing the unique challenges faced by startups, Joe provides invaluable guidance on ownership and procurement of patent and trademark rights. His deep understanding of intellectual property law and extensive experience allows him to advise startups on how to strategically

protect their innovations while considering budgetary constraints. Joe's insightful counsel helps startups establish a strong foundation for growth and navigate the complex landscape of intellectual property.

- **Crafting Research and Development Agreements:** Joe is able to craft comprehensive research and development agreements that address the intricate issues of IP ownership. He works closely with clients to ensure that their rights are protected, both during the collaborative research process and in the subsequent commercialization of innovations. By drafting well-defined agreements, Joe helps his clients avoid disputes and maintain control over their intellectual property assets.
- **Patent Due Diligence in International Acquisitions:** In the context of large-scale international acquisitions, Joe's expertise in conducting thorough patent due diligence is an invaluable resource to clients. He meticulously examines the intellectual property portfolios of target companies, assessing the strength and scope of their patents. By identifying any potential risks or opportunities, Joe provides his clients with the information needed to make informed decisions during the acquisition process, mitigating future legal challenges and maximizing the value of the transaction.
- **Developing Robust IP Portfolios:** Understanding the importance of proactively protecting clients' intellectual property, Joe specializes in developing robust IP portfolios. He works closely with clients to identify and capture innovative ideas, strategically filing patents and trademarks to ensure comprehensive coverage. By actively monitoring the competitive landscape, Joe helps his clients stay ahead of potential design-arounds, effectively safeguarding their intellectual property assets and maintaining a competitive edge.
- **Trademark Enforcement:** Joe has successfully represented clients in protecting their trademark rights against domestic and foreign entities in the United States and abroad through a network of foreign associates.
- **Post-Grant Proceedings:** Joe is well-versed in post-grant proceedings, which provide an avenue for challenging the validity or scope of existing patents. Whether it involves defending the validity of a patent, challenging the validity of a competitor's patent, or seeking to correct and enhance the scope of an existing patent, Joe's unique perspective ensures that clients receive comprehensive representation and guidance throughout the post-grant proceeding process.
- **Copyright:** Whether it's registering copyrights, addressing ownership and licensing matters, handling infringement cases, or advising on fair use and compliance, Joe's in-depth knowledge and strategic counsel allow clients to navigate the complexities of copyright law with confidence. With his guidance, clients can protect their creative works, monetize their intellectual property assets, and effectively enforce their rights in the dynamic landscape of the digital age.

Joe's performance in the field of intellectual property law have earned him the respect of clients and peers alike. His commitment to delivering exceptional legal counsel, combined with his comprehensive understanding of the intricacies of intellectual property rights, make him an invaluable asset to any individual or organization seeking to protect and leverage their innovations in today's dynamic business landscape.

Beyond his professional achievements, Joe cherishes his family life. Originally from Pittsburgh, he currently resides in Newtown Square, Pennsylvania, with his wife Laurie, their three daughters, two dogs, and two cats. In his leisure time, Joe is an avid golfer who enjoys hitting the links, and during the winter months, he can be found snowboarding down

the slopes, embracing his adventurous spirit.

EDUCATION:

- Duquesne University School of Law, J.D.
- Penn State University, B.S. Material Science and Engineering

ADMISSIONS:

- Pennsylvania
- U.S. Patent and Trademark Office

PRACTICE AREAS:

- Intellectual Property
- Cybersecurity
- Alternative Dispute Resolution (ADR)
- Intellectual Property Litigation

COMMUNITY INVOLVEMENT:

American Bar Association, Intellectual Property Law Section

Vice Chair of International Patent Law Committee, Member of Section Nominating Committee, Section 101 Patent Eligibility Task Force, and Section Liaison

Newtown Township Trails and Greenways

Committee Member

Leadership Chester County

2013 graduate

American Bar Association, Intellectual Property Law Section

Past Chair Patent Litigation Committee and Patent Legislation Committee

Newtown Square Presbyterian Church

Former board of trustees member

Newtown Square Petticoat League

Former board president

Habitat for Humanity Delaware County

Former board member

RECOGNITIONS:

- Leadership Recognition, American Bar Association
- Pennsylvania Rising Stars (2010, 2014, 2015, 2016, 2017, 2018)

MEMBERSHIPS:

- Chester County Bar Association
- American Bar Association Section of Intellectual Property Law (ABA-IPL):
 - Patent Section 101 Task Force, Member
 - Patent Litigation Committee, Chair, Former vice chair
 - America Invents Act (AIA) Task Force, Member
 - Patent Legislation Committee, Former Member

PUBLICATION:

- "Managing Intellectual Property Rights: The Cost of Innovation," Duquesne Business Law Journal, Spring 2004, 6 Duq. Bus.L.Rev., No.2.

PRESENTATIONS:

- "Legal Tech Talk for Your 21st Century Business", BIG U 2018 (May 2018)
- Common Legal Issues You Need to Know, PA Treasury's Small Business Initiative at York College (October 2016)
- Legal Issues Involved in Growing your Business , PA Treasury's Small Business Initiative at York College (October 2016)
- Common Legal Issues for New Businesses, PA Treasury's Small Business Initiative at York College (October 2016)

- "Outside the Box Innovations v. Travel Caddy: Can Minor Infractions be Inequitable Conduct?" Joint Patent Practice Continuing Legal Education" (April 2013)
- "Managing Intellectual Property Rights: The Cost of Innovation," Duquesne Business Law Journal, Spring 2004, 6 Duq. Bus.L.Rev., No.2.

RELATED NEWS:

- Barley Snyder Partner, IP Attorney Joseph Falcon Appointed to Various Bar Committees with the American Bar Association
July 28, 2023
- Barley Snyder Partner, IP Attorney Joseph Falcon Appointed to Various Bar Committees
October 26, 2022
- Barley Snyder Partner Falcon Receives Leadership Recognition
October 20, 2021
- Barley Snyder Partner Falcon Named Chair of IP Committee
September 23, 2021
- Barley Snyder Partner Falcon Named to Trails Committee
September 8, 2021
- Barley Snyder Attorney Falcon Named Chair of ABA-IPL Committee
July 9, 2020
- Managing Intellectual Property in a Crisis (Part 3)
April 1, 2020
- Managing Intellectual Property in a Crisis (Part 2)
March 31, 2020
- Managing Intellectual Property in a Crisis (Part 1)
March 30, 2020
- Barley Snyder Partner Falcon Named to ABA-IPL Board
August 7, 2019
- USPTO Takes Significant Step to Ease Patenting of Software-based Inventions
January 9, 2019
- Some Invention-Services Companies Remain Under Fire for Deceptive Practices
December 18, 2018
- Falcon Named Vice-Chair of National Patent Group
September 14, 2018
- Whats In a Beer Name? A Trademark Infringement
September 5, 2018

- **Whats In a Beer Name? A Possible Trademark Infringement**
August 30, 2018
- **Nine Barley Snyder Attorneys Named to Super Lawyers Lists**
May 18, 2018
- **USPTO Doesnt Believe Anyone Will Celebrate Draï Day**
May 14, 2018
- **Trumps Proposed Tariffs Aim to Increase Enforcement of American IP in China**
March 29, 2018
- **The Business of Trademarks: Part 2**
September 11, 2017
- **The Business of Trademarks: Part 1**
August 21, 2017
- **Intellectual Property and Business: Part 4**
August 9, 2017
- **Intellectual Property and Business: Part 3**
August 4, 2017
- **Intellectual Property and Business: Part 2**
July 26, 2017
- **Intellectual Property and Business: Part 1**
July 19, 2017
- **Supreme Court Strikes Down Law Banning Offensive Trademark Registrations**
June 20, 2017
- **Seven Barley Snyder Attorneys Garner Super Lawyers Distinction**
May 16, 2017
- **What Can Go Wrong When You Offer Public Internet Access**
August 5, 2016
- **President Barack Obama Signed the Defend Trade Secrets Act**
June 6, 2016
- **Eight Barley Snyder Attorneys Selected to the 2015 Pennsylvania Super Lawyers and 2015 Pennsylvania Rising Stars Lists**
May 15, 2015
- **Attorney Joe Falcon Elected to Newtown Square Petticoat League Board**
January 27, 2015
- **Barley Snyder Attorneys Named to the Lists of 2014 Pennsylvania Super Lawyers and Pennsylvania Rising Stars**
May 27, 2014
- **America Invents Act First Inventor to File Transition**
March 12, 2013

- Automatic Petitions With Instant Decisions Now Offered by the US Patent Office
October 24, 2011