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Collected Writings of Banner & Witcoff in 2014



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5 Tips For Saving Patents From The PTAB's Ax

By **Ryan Davis**

Law360, New York (August 15, 2014, 8:33 PM ET) -- Most of the patents reviewed by the Patent Trial and Appeal Board to date have been invalidated, but a handful have survived what has become a harrowing process for patent owners.

Here, attorneys who have successfully defended patents before the board share their strategies for keeping patents alive:

Put Your Best Foot Forward in the Preliminary Response

Once an accused infringer or other challenger files a petition seeking to invalidate a patent, the patent owner has the option of filing a preliminary response before the board decides whether to institute a review. In just about every case, the patent owner should take advantage of the opportunity to make the case early for the patent's validity.

In the best-case scenario, the preliminary response can persuade the board not to review the patent at all, said Jon Wright of Sterne Kessler Goldstein & Fox PLLC.

"If you've got a knockout punch because of glaring weakness in the petitioner's case, and you can convince the board not to initiate a trial, that's a huge win," he said.

If a review is instituted, the patent owner's preliminary response can convince the board to only consider some of the arguments raised by the petition, said Christopher McKee of Banner & Witcoff Ltd. That can make it easier to defend the patent and plays into the board's desire to focus on key issues so that the review can be completed within the one-year time limit mandated by Congress.

"If you don't avoid it entirely, you might be able to narrow the trial," he said. "The board has said that they find the preliminary response very useful, and they have every interest in narrowing the scope of the proceeding to keep it streamlined."

The preliminary response lets the patent owner see the board's reaction to its arguments, and if a trial is instituted, "you have an opportunity to put together a full response to address any points where the board didn't go your way and maybe turn the board around," said McKee, who represented Mentor Graphics Corp. in a case where the board affirmed the validity of most challenged claims of the company's patent.

Hold the Petitioner's Feet to the Fire

Both in the preliminary response and after the board has decided to review a patent, the patent owner's goal should be to zero in on the weaknesses in the petitioner's case and aim to convince the board that the high burden of proving the patent invalid has not been met.

That requires a different mindset for attorneys who are used to representing patent applicants during examinations, where they must argue against the examiner's own opinion about why the application should be rejected, said Scott Smiley of the Concept Law Group PA.

According to Smiley, who represented Automated Creel Systems Inc. in a review where the board invalidated some claims of the company's patent but affirmed the patentability of others, the attorney's job is somewhat easier during inter partes review proceedings.

"There, you are arguing to the board why the petitioner's opinion is incorrect," he said. "The petitioner must prove their case by a preponderance of the evidence, and patent owners should constantly hold them to it."

Wright, who represented in ContentGuard Holdings in a review where the board issued a final decision affirming the validity of all the challenged claims of the company's patent, said that the patent owner's goal should be to latch on to any area where the petitioners' invalidity arguments fail to meet the legal burden.

"You're always looking for places where the petitioner has dropped the ball," he said.

For instance, he said that if the petitioner is arguing the patent is obvious, the patent owner should look carefully at the factors for proving obviousness articulated by the U.S. Supreme Court and point out ways the petitioner failed to meet them.

Expert Testimony Is Critical

The PTAB has put strict page limits on filings in inter partes reviews, with the petition, patent owner's preliminary response and the patent owner's response after a trial has been instituted capped at 60 pages.

One way patent owners can get all their strongest arguments before the board is to enlist an expert witness who can submit a declaration with no page limits that expounds on the positions taken in the actual filings, said Charles Wieland of Buchanan Ingersoll & Rooney PC.

"The arguments have to appear in 60 pages, so you want to back them up with an extensive, authoritative expert declaration," said Wieland, who represented Network-1 Security Solutions Inc. in a case where the board affirmed the validity of all of the challenged claims of the company's patent.

Expert declarations are not allowed in the patent owner's preliminary response, only in filings after the trial has been instituted, but attorneys said patent owners should consult with experts early in the case and work closely with them to ensure they are on board with every position the patent owner is taking.

Since the expert will be deposed by the petitioner's counsel, it's not enough for the attorneys to come up with an argument and rely on the expert to expound upon it, said Edward Schlatter of Knobbe Martens Olson & Bear LLP. Instead, the expert must be deeply involved in crafting the positions being taken.

"The expert's position is going to be aggressively attacked, and you need to be confident that they are ready to weather the storm," said Schlatter, who represented Star Envirotech Inc. in a case where the board affirmed the validity of the company's patent. "That is most effective when the expert has a role in developing the case in the first instance."

Call In Reinforcements

If the patent at issue in an America Invents Act review has previously survived invalidity challenges in litigation, the attorneys who worked on the earlier cases can be a valuable resource, Wieland said.

The litigation counsel have lived with the patent for years and fended off invalidity arguments by smart lawyers, so they have a good sense of what the patent does and does not cover, he said. To the extent possible, counsel for the patent owner in an AIA review should enlist their help in defending the patent.

"Bringing in litigation counsel on battle-tested patents is essential to success," Wieland said.

Get Ready to Get Technical

The judges on the PTAB are experts in patent law and technology, so persuading them to uphold a patent's validity necessarily requires the patent owner to make arguments steeped in technical details.

It is often easy to come up with ways in which the invention claimed in a patent is different from the prior art references the petitioner says renders the patent invalid, but those differences will do nothing at all to save the patent if they are not rooted in the language of the patent's claims, Wright said.

"You can find all the differences you want, but if there is not a claimed feature in the patent that cuts to that difference, it's a meaningless distinction, and the patent judges are going to be hyper-focused on that," he said.

While talking in general terms about how the patent differs from the prior art without getting into the specifics of the claim language "might be persuasive in front of a jury or an unsophisticated judge, it's not going to work with the board," he said.

The patent owner should focus closely on the technology involved and lay out a story about, for instance, why it would not be obvious to combine the two prior art references cited by the petitioner, Schlatter said.

"It can't be a surface-level discussion of the references. You need to get into the nuts and bolts," he said.

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Managing Intellectual Property

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SCOTUS WARY OF UNINTENDED CONSEQUENCES IN LIMELIGHT V AKAMAI

08 May 2014 | Alli Pyrah, New York

The Supreme Court has to weigh up tough issues in *Limelight Networks v Akamai Technologies* because ruling in favour of Akamai on the issue of induced infringement could lead to a barrage of lawsuits

In oral arguments in *Limelight Networks v Akamai Technologies* on April 30, the Supreme Court seemed hesitant to create a precedent that one justice worried could lead to "vast numbers of consumers" being sued for patent infringement.

The case concerns the issue of joint infringement - whether two parties can be held liable for violating a patent if they each perform different steps of it.

In this case, Akamai claims that Limelight induced its customers to infringe. Although courts have previously found that induced infringement has occurred when one party has control over other, Limelight does not directly control its customers.

While the justices seemed sympathetic to Akamai's predicament, they expressed concerns that ruling in its favour could create a precedent with unintended consequences. For example, so-called patent trolls have recently begun targeting end-users. Individuals and small businesses tend to have fewer resources to devote to expensive litigation, so they have more of an incentive to settle irrespective of the merits of the case against them.

The case is on appeal from the Federal Circuit, which originally found in a panel hearing that Limelight did not directly infringe the patent. When rehearing the case en banc in August 2012, the Federal Circuit did not reconsider the issue of direct infringement but ruled that Limelight was liable for induced infringement.

Aaron Panner, arguing for Limelight, said that under Section 271(b), a defendant cannot be held liable for induced infringement unless the defendant has deliberately brought about actionable direct infringement under Section 271(a).

Panner said that if the law is to be changed in response to "supposed unfairness in a particular case", that change should be made by Congress, not the courts.

But Chief Justice Roberts seemed sceptical. "Your position makes it pretty easy to get around patent protection, doesn't it?" he asked Panner.

"All you've got to do is find one step in the process and essentially outsource it or make it attractive for someone else to perform that particular step and you've essentially invalidated the patent."

The Supreme Court is not presently considering the issue of direct infringement. During the oral arguments, some of the justices discussed the possibility of doing so next term.

"There was certainly recognition that simply affirming or reversing the Federal Circuit decision might not really address the issue," said Wayne Porter, a senior shareholder of Banner & Witcoff.

"It's an issue that certainly needs some clarification regardless of which side of the issue you are on."

Ramifications for many industries

Michael Huget, a partner of Honigman Miller Schwartz & Cohn, said the internet has brought about more opportunities for joint infringement. But he said it is also an issue that occurs in the pharmaceutical, medical device and automotive industries.



"My take is that they are inclined to reverse the Federal Circuit because I don't think they were comfortable with the Federal Circuit's ultimate ruling that you can have induced infringement without direct infringement."

How a ruling in Akamai's favour might translate to other industries was an issue that seemed to concern the justices during oral arguments.

Justice Stephen Breyer said he had "no idea" whether Limelight should be liable for patent infringement.

"It sounds simple when you take the invention that you gave, but it doesn't sound simple to me when I start thinking about this one, because this one does seem to me a variation on a very old theme," he said.

Breyer cited the example of a supplier who makes customised materials, some of which use standardised parts, which can be shipped from anywhere in the country, and some of which have to be made by specialists in crowded cities. He said that in such a system, the customer might phone up the standardised parts makers and the customised parts makers.

"And there are not just two steps. There are 87 steps, and many of them involve very innocent things like taking a truck and driving it from one place to another."

Under such a system, there would be various states of knowledge, said Breyer.

"I become very nervous about writing a rule that suddenly might lead millions of people to start suing each other," he said.

To add to the complications, internet commerce also creates potential for joint infringement theories concerning two parties in different countries. "That could be a big issue down the road," said Hugué.

Ramifications for consumers

Justice McLeod Kennedy expressed concerns that "vast numbers of consumers" could be sued if the court upheld the Federal Circuit's standard.

In response, Seth Waxman, arguing for Akamai, claimed consumers are not sued by patent owners.

"Consumers aren't sued under patent law for infringement, whether there's a single user or multiple users," he said.

"Yet, until we issue the case in your favour," replied Justice Kennedy.

"No, no, not at all," said Waxman. "Quite to the contrary. The consumer - first of all, consumers aren't sued, because under the patent law, under like - under - unlike copyright law, there are no liquidated damages. No-one sues individual consumers."

The Electronic Frontier Foundation (EFF) later took issue with this claim, describing it in a [blog entry](#) as a "bald, and totally false, statement".

"Not only are consumers sued for patent infringement, but recent years have seen an explosion in suits against end-users of technology products," wrote EFF staff attorney Daniel Nazer. "Patent trolls have sued or threatened to sue tens of thousands of end-users."

Nazer cited a [paper](#) by Edward Reines of Weil Gotshal & Manges and Colleen Chien, a Santa Clara University School of Law Associate professor who was appointed by the White House in September to serve as senior advisor for intellectual property in the Office of Science and Technology Policy.

The paper concluded that "mass suits against technology customers have become too common, involving building block technologies like wi-fi, scanning, email and website technologies."

A ruling on the case is expected this summer.

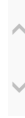
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Nature Biotechnology

Patenting natural products just got harder

The US Patent and Trademark Office (USPTO) on March 4 issued new guidelines with far-reaching consequences for the biotech industry. Following publication of the *Guidance for Determining Subject Matter Eligibility of Claims Reciting or Involving Laws of Nature, Natural Phenomena, & Natural Products*, it is now a lot harder than before for companies to patent natural products, such as antibiotics and therapeutically useful toxins, nucleic acids, peptides and proteins. “Many legal practitioners have raised a concern that the guidelines impose a new test for patent eligibility that is stricter than is required by law,” says Kirsten Grüneberg, attorney at law and partner at Oblon Spivak in Alexandria, Virginia.

The new guidelines draw on two high-profile Supreme Court decisions: *The Association for Molecular Pathology versus Myriad*, which determined that isolated and purified DNA could not be patented (*Nat. Biotechnol.* 31, 663–665, 2013) and *Mayo versus Prometheus*, which ruled that methods of determining optimal drug doses, based on levels of a naturally occurring metabolite were not patent eligible (*Nat. Biotechnol.* 30, 373–374, 2012).

In issuing the new guidance (<http://www.uspto.gov/patents/announce/myriad-mayo.jsp>), the patent office aims to provide clarification for its examiners in light of those

rulings. The new requirement is for a patent claim to show a ‘marked difference’ from a known natural law, material or phenomenon. To illustrate this, the document provides examples of hypothetical patent applications—as a cancer-combating compound isolated from a tropical plant, bacteria with energy-generating plasmids, a method for DNA sequence amplification using specific primers and a diagnostic for neurodegenerative disease based on detecting misfolded protein, and whether or not certain claims directed to these inventions might be patent eligible. The guidance adds the caveat that there are “no bright line rules” to patent eligibility and includes factors that weigh in favor of or against patent eligibility, such as whether or not the invention is “markedly different” from naturally occurring products.

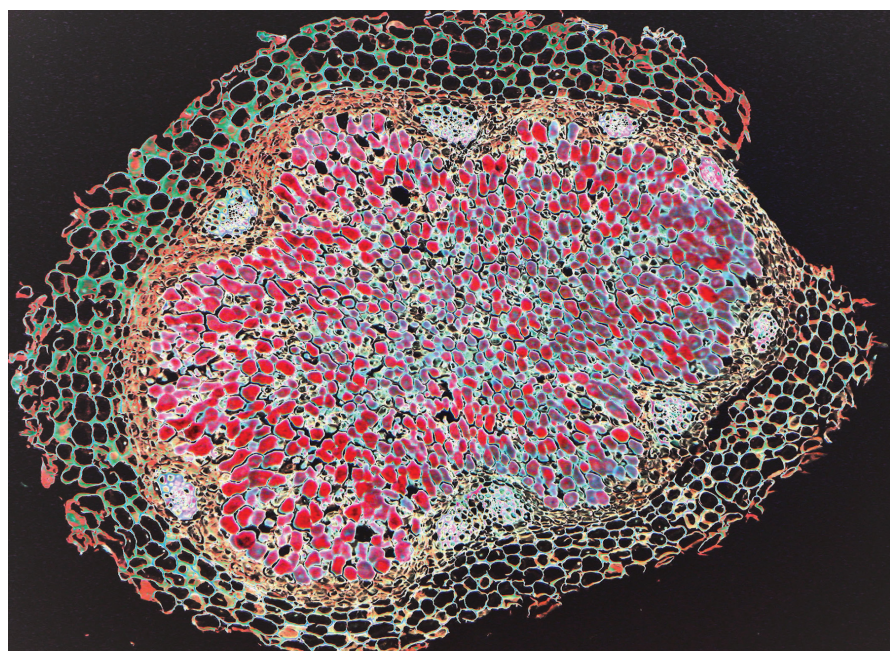
But the breadth of the new patent evaluation is worrying, as it oversteps the Supreme Court rulings. The changes will make it more difficult for patentees to show eligibility and could prove a bonus to those challenging the validity of patents. “[The guidelines] will have a much larger negative impact on the biotechnology and pharmaceutical fields than the Supreme Court contemplated in its recent *Myriad* and *Prometheus* decisions,” says Courtenay Brinckerhoff, a partner at **Foley & Lardner, Washington, DC. “Getting a patent that claims a natural product or**

IN brief

Better than breakthrough scheme snags

The UK will allow compassionate use of unlicensed drugs under a new program launched in April by the Medicines and Healthcare products Regulatory Agency. The Early Access to Medicines Scheme is similar to the US breakthrough therapy designation in that it is intended to help fast-track drugs for life-threatening or seriously debilitating diseases with no adequate treatment options. But the UK scheme goes one step further than its US counterpart, by allowing doctors to prescribe drugs still in phase 2 or 3 testing if the agency believes there is a positive benefit-risk balance. One major concern over this scheme is lack of funding. With no government support to provide drugs to patients in the National Health Service (NHS) for free, companies will have to make an upfront investment to participate. “Without centrally funded reimbursement the early access scheme risks being underutilized,” says Steve Bates, CEO of the UK BioIndustry Association. A similar program exists in France, the cohort Authorized Temporary Use program. But the French government pays for compounds used in the program. The UK’s scheme begins with companies submitting an application for a Promising Innovative Medicine designation. Once such a designation is obtained, products will be channeled through a new, collaborative appraisal by the National Institute of Health and Care Excellence (NICE) and a new commissioning scheme in the NHS. For small companies, manufacturing the novel drug and meeting demand may be problematic. Early access programs are also risky because a drug might be killed if it is not effective in seriously ill patients or causes serious side effects. But Bates points out that these schemes are aimed at drug developers already operating in challenging areas, such as rare diseases and gene therapy. “I wouldn’t expect everyone to be interested.” A few days before the UK scheme was announced, the European Medicines Agency launched a pilot project designed to give early approval to products still in development that address an unmet need in restricted patient groups. The principle behind this adaptive licensing pilot is that early phases of data gathering would eventually allow the license to be expanded to different categories of patients. “Adaptive licensing is part of the [early access scheme] mix,” says Bates. “It goes with the grain of thinking that as you accumulate evidence you get a license to do more trials.”

Nuala Moran, London



M T (Spike) Walker / Alamy

Rhizobium bacteria form a nodule in broad bean root. A 1948 decision rejecting the patentability of *Rhizobium* bacteria mixes for nitrogen fixing has made its way into the recent guidance.

Box 1 What is still patentable?

Patentees will now need to review their patent portfolios and, together with their patent counsel, assess whether issued or pending claims survive the new patent eligibility guidelines. Some key steps to navigating the guidelines, compiled from our interviewees, follow.

- Ensure that the structure of your invention is sufficiently different from what occurs in nature, for example, by including modifications such as chemical substituents, side chains, point mutations and so on. Ensure that these variations are described in the patent application.
- Consider whether commercial products based on your invention are likely to include components that are not naturally occurring, such as synthetic carriers or adjuvants. Include descriptions of those components in the patent application.
- Work closely with your patent examiner to reach allowable subject matter. Once the initial application has been filed, prepare and file continuations that seek broader subject matter.
- If patent applications have been filed already, be prepared for rejections. Challenge rejected claims through judicial procedures.
- Consider raising the problematic fallout of the guidelines with US Congressional representatives, who might be able to overrule them legislatively.

The points in this box do not constitute legal advice.

includes a natural process will now be more difficult,” says John Iwanicki, a patent attorney at Banner & Witcoff, Boston. “Applicants will probably amend their claims to comply with the guidelines, which could mean that the scope of the invention will shrink,” he adds.

Of particular irk is that the *Myriad* decision centered solely and narrowly on isolated DNA, whereas the guidelines broadly extend to any invention that could include a natural product, compound or material. “This goes way beyond the ruling in *Myriad* and is a total game changer with respect to companies that seek patent protection on isolated natural products,” says Iwanicki. Indeed, Gregory Verdine, founder of Warp Drive Bio, which specializes in natural product drug discovery, is well aware of the new guidelines. “They do not come as a surprise following the *Myriad* decision, but they affect our intellectual property strategy fundamentally,” he says. Of note, carrying out laboratory steps such as isolation, purification or synthetic or recombinant production of a product—even if these steps involve a lot of effort on the part of the scientist—probably won’t boost the chances of patent eligibility, as such steps will not fundamentally distinguish the laboratory product from the natural one.

Some biologics, such as fully human antibodies that match the antibody naturally found in serum, may not pass the new patent eligibility hurdle, but in most cases, a

biologic is structurally different from the naturally occurring product. As a result, the impact of the guidelines on natural product patenting might not be too dramatic. “The vast majority of innovative companies are not in the business of identifying or claiming merely isolated compounds—either DNA or any other molecules,” says Grüneberg. It is also important to remember that a patent that has been issued is presumed valid, and a party that wishes to overturn a granted patent has an uphill struggle. “Invalidity must be demonstrated by a high standard of clear and convincing evidence,” says Iwanicki.

As well as encompassing the *Myriad* and *Prometheus* decisions, the guidelines bring in other Supreme Court cases that also ruled on patent eligibility. These include *Diamond versus Chakrabarty* (from 1980; which held that genetically modified organisms can be patented) and *Funk Brothers versus Kalo Inoculant* (from 1948; which held that a mixture of nitrogen-fixing bacteria is not patent eligible). In a statement to *Nature Biotechnology*, the USPTO notes that “One reason for treating the cases together in the guidance was because both the *Myriad* and *Prometheus* cases relied on precedent set in earlier Supreme Court decisions, including the *Chakrabarty* case, [regarding] whether natural products or naturally occurring things were eligible for patenting.”

But these inclusions widen the scope of the guidelines, raising concerns for biotech

and pharma companies. Drugs described in patent claims as a ‘composition’ of two or more chemicals, that is, a therapeutic compound in a pharmaceutically acceptable carrier would not have raised patent eligibility issues before the new guidelines were issued. Grüneberg points out that by including the *Funk Brothers* case, where a non-naturally manufactured mixture of nitrogen-fixing bacteria was still ineligible for patenting, the USPTO may now apply a similar analysis to pharmaceutical composition claims.

One way of mitigating this potential fallout, says Brinckerhoff, is to claim that at least one component of the pharmaceutical composition is structurally different from that found in nature. “These could include compounds modified with substituents, side chains, point mutations and so on,” she says. “Determining what makes the invention ‘markedly different’ from what occurs in nature will be where the majority of disagreements between applicants and the USPTO will lie, says Grüneberg.

Here it is important to remember that these guidelines are exactly that—guidelines. “They are not law, they have no legal effect and they are not regulations,” says Iwanicki. “Only courts of law can sort out whether patent examiners correctly reject claims using the guidelines.” But he adds that getting the patent is the ultimate goal, and so one needs to fully understand the guidelines when working with the patent examiners to determine what they are willing to allow.

For companies applying for patents, foresight will be critical (Box 1). Obtaining a patent is already a lengthy process, and the guidelines could add to the delay—a problem particularly for small to medium-sized enterprises for which patents are the main asset and a source of confidence for investors.

In practice, what can or cannot be patented is hard to predict. What is certain is that examiner decisions will be challenged both at the patent office and through the courts. This will be costly and time consuming, but ultimately, it is the only way to determine the real effect of the guidelines. “It will take many court decisions to thrash out what the law is on patent eligibility of claims directed to peptides, proteins, naturally sourced antibiotics and nucleic acids,” says Daniel Becker, a patent attorney at Dechert in Mountain View, California. For now, it is wait and see. “The implications of these new guidelines are really unclear at this time,” says Grüneberg.

Charlotte Harrison *Canterbury, UK*



Nature Reviews Drug Discovery

PATENT WATCH

Patentee bears burden of proof when licence agreements are questioned

The licensing of patents in return for a fee or royalties has a key role in drug discovery. Now, the US Supreme Court has ruled in a case that could alter the balance of power between patentee and licensee if a patent licence agreement is disputed or uncertain.

In some situations, such as when the licensee brings out a new product, it may be unclear whether they need to pay royalty fees to the patentee for that product. In such situations, the licensee can file a so-called 'declaratory judgement' action, asking a court to say what the outcome would be if the patent holder were to sue them for infringement. The issue at the centre of the current case was which party — the patentee or the licensee — was required to prove whether or not a patent covers the licensee's products. The Supreme Court decided that it was down to the patent owner to prove that their patents cover the licensee's products.

"The Supreme Court's decision appears to offer a substantial advantage to patent

licensees," says Aaron Bowling, a patent Attorney at Banner and Witcoff, Chicago, Illinois, USA. "Now, because the patent owner bears the burden of proof, patent licensees may now force the patent owner to prove that the already licensed patent does indeed cover the licensee's products, and may do so by filing a declaratory judgement action at a time and venue of their choosing."

The choice of venue where the parties will resolve a dispute is important, because courts in some locations are considered less patentee-friendly than others.

The case was between the medical device company Medtronic and a group called Mirowski Family Ventures that owns patents related to implantable heart stimulators. The companies have a licensing agreement that permits Medtronic to use certain patents in exchange for royalty payments; however, they disputed whether the licence of two patents was needed for Medtronic to make new cardiac resynchronization

devices. Mirowski accused Medtronic of infringement, so Medtronic sought a declaratory judgement action.

When the case was heard by a US appeals court, it ruled that it was up to the licensee to show that the patent did not cover its products. But the Supreme Court reversed this decision and placed the burden of proof on the patentee. This reversal, it reasoned, was strongly supported by accepted legal propositions. For example, in other litigations (namely, patent infringement cases) it is the patentee who normally has to prove that infringement has occurred. To shift the burden of proof depending on the type of action — that is, declaratory judgement or infringement — could result in a situation where neither party could prevail, and so it would be undecided whether a certain product infringes on a certain patent even after several court cases.

Given that this judgement could favour the licensee, what steps might patent owners now take?

Jim Singer, a patent attorney at Fox Rothschild Pittsburgh, Pennsylvania, USA, explains that a patent holder typically has two legal options when they believe that a licensee isn't paying all royalties that are due. These are to accuse the licensee of breach of contract or to accuse the licensee of patent infringement. (Mirowski followed the latter option.) "This case indicates that a patent holder may want to think twice before making a patent infringement accusation, as the licensee can now file a declaratory judgement and require the patentee to prove that accusation in court," he highlights.

The dispute between Medtronic and Mirowski has been sent back to the appeals court for a decision in line with the Supreme Court's ruling.

Medtronic versus Mirowski: http://www.supremecourt.gov/opinions/13pdf/12-1128_h315.pdf

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World Intellectual Property Review



US Supreme Court hears Limelight v Akamai arguments

01-05-2014

The US Supreme Court has heard [arguments](#) on the *Limelight v Akamai* case, which is expected to shed light on whether a defendant can be held liable for patent infringement if multiple parties have performed different steps of the infringement.

The case concerns an Akamai patent that covers a method for delivering content on a web page. According to a court brief, every day one billion people rely on Akamai's services, which support the workings of sites including iTunes, Amazon and eBay.

The court will decide whether the Court of Appeals for the Federal Circuit erred in determining that Limelight may be held liable for inducing patent infringement even though no one party had committed direct infringement.

In an *en banc* decision handed down in 2012, the Federal Circuit upheld a trial court decision that found Limelight was not liable for direct infringement (under 35 USC §271(a)). However, it held that it could be liable for induced infringement (under §271(b)), even though no one party was found liable for direct infringement.

Both Limelight and Akamai filed petitions for *certiorari* to the Supreme Court; Akamai's is still pending.

In March, a group of companies including Google, eBay and Facebook sent a joint *amicus* brief in favour of Limelight, arguing that the Federal Circuit's decision conflicts with the patent statute and prior decisions of the Supreme Court.

Wayne Porter, an attorney from Banner & Witcoff Ltd in Washington DC, said that under the law of "divided infringement", which deals with direct infringement, "there is no liability for direct

infringement of a method claim when an accused infringer performs some claim steps and another performs the other steps, unless that other party is the agent of the accused infringer or acting under the accused infringer's direction or control."

After attending the oral arguments yesterday, Porter told *WIPR* that at least some of the justices "seemed to have trouble" with the Federal Circuit decision: "Justice [Antonin] Scalia made a comment suggesting he might believe the Federal Circuit's decision [on induced infringement] is contrary to the language of the statute."

On the other hand, some of those justices' comments suggested that they thought the issues run deeper, he added.

"For example, Justice Scalia seemed sceptical of Limelight's argument that perceived problems can be avoided by claim drafting. In the same comment where she noted the strength of an argument against the Federal Circuit decision, Justice [Elena] Kagan also pointed out that the decision was an attempt to avoid what the Federal Circuit thought to be an end-run around the patent laws."

He said it is notable that Justice Samuel Alito asked several times if there is any policy reason supporting a finding of no infringement on the facts of the case.

The issue will ultimately come down to whether the court feels that it must address §271(a), he said.

"If the court believes that §271(a) must be addressed, I think it might well grant Akamai's petition, receive further briefing and hear additional argument next term before deciding."

He added: "If the court does not think that it must address §271(a), I think the court would be willing to simply reverse or affirm and indicate that it is up to Congress to fix any perceived problems or gaps in the law."

ABOUT THE AUTHORS



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Attorney

Katie Becker enjoys practicing in many areas of intellectual property law. Katie currently concentrates on patent prosecution and counseling in chemical matters, in addition to design patent and trademark matters. She is part of a team representing one of the world's largest food and beverage companies.

Katie earned a Bachelor's of Science degree in Food Science and a certificate in business at the University of Wisconsin-Madison. As an undergraduate, Katie performed research in food bacteriology. She evaluated the capabilities of bacteria contamination testing methodologies. The results of her research were published in the *Journal of Food Protection* and the *Journal of Food Safety*.

Katie was awarded her J.D. degree and a certificate in intellectual property law from Chicago-Kent College of Law. There, she was an associate editor for the Chicago-Kent Journal of Intellectual Property. She was involved as well with the Intellectual Property Law Society, the Chicago Bar Association, the American Bar Association, and the Institute of Food Technologists.

During her time at Chicago-Kent, Katie was a law clerk at PepsiCo, Inc., assisting in-house counsel on intellectual property-related matters. Additionally, she participated in the Chicago-Kent IP-Patent Clinic and received a grant from the Department of Energy for her research on the effects of incidence and impacts of nanotechnology patents.

In 2014, Katie was named an Illinois Super Lawyers' Rising Star in intellectual property. The Super Lawyers lists represent the top 5 percent of attorneys in each state.

Katie is registered to practice before the USPTO.

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Industries

Chemistry & Chemical Engineering



JORDAN N. BODNER

Attorney

Jordan Bodner has extensive experience in all phases of writing and prosecuting complex patent applications in a variety of technical fields including telecommunications, e-commerce, internet-related technology, semiconductors, signal processing, and electro-mechanical devices. Mr. Bodner also regularly provides counseling regarding patent infringement risks and how to reduce such risks, and has represented clients in patent litigation including actions before the International Trade Commission. He presently works with a spectrum of clients ranging from large corporations to individual inventors.

In his previous career, Mr. Bodner worked as an electrical and systems engineer for IBM, Loral Corporation, and Lockheed-Martin Corporation. He has substantial experience in designing and installing large computer systems and networks for customers such as the United States Air Force.

Mr. Bodner has a Bachelor of Science degree in Electrical Engineering from Washington University, a Master of Science degree in Electrical Engineering from the University of Colorado, and a Juris Doctor from George Mason University.

He is admitted to the bars of the District of Columbia, the Commonwealth of Virginia, and the State of North Carolina. Mr. Bodner is also registered to practice before the U.S. Patent and Trademark Office. He is a member of the American Bar Association as well as the American Intellectual Property Law Association.

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Court Admissions

U.S. Patent and Trademark Office

Practice Areas

Counseling, Opinions & Licensing
Litigation
Patent Prosecution

Industries

Electrical & Computer Technologies
Internet, E-Commerce & Business
Methods



AARON BOWLING

Attorney

Aaron Bowling focuses his practice on intellectual property litigation, assisting clients in a variety of industries including biotechnology, sporting goods, and digital music. Aaron provides strategic advice on matters involving utility patents, design patents, trademarks, trade dress, copyrights, and antitrust.

Prior to joining Banner & Witcoff, Aaron served in the Chambers of the Honorable Jimmie V. Reyna at the United States Court of Appeals for the Federal Circuit; which has exclusive jurisdiction over patent-related appeals, and whose decisions are binding precedent throughout the United States. Previously, Aaron worked as an international product owner in the Cellular Therapies and Biosurgery groups of Baxter International, ensuring the safety and efficacy of biotechnological products in compliance with international regulations; and earlier served as a protein engineer at the United States Department of Energy's Argonne National Laboratories.

Aaron earned his Juris Doctor from the George Washington University Law School, where he earned honors as a Thurgood Marshall Scholar and served as an editorial staff member of the American Intellectual Property Law Association (AIPLA) Quarterly Journal. Aaron authored a note in the Summer 2013 Edition of the AIPLA Quarterly Journal entitled "*Just About Equivalent: A Comparative Analysis of the Doctrines of Equivalents in the United States and International Jurisdictions Shows that the Varying Doctrines Are Strikingly Similar*," and also recently contributed as an author in: *Is This License Comparable? Issues Facing Damages Experts When Determining Reasonable Royalties*, published by the University of Texas School of Law, CLE; and *Patent Litigation Strategies Textbook, Third Edition, 2013 Supplement*, published by the American Bar Association.

Aaron earned his Bachelor of Science degree in Molecular and Cellular Biology from the University of Illinois Champaign-Urbana in 2007, and his Master of Science degree in Bioengineering and Biotechnology from Northwestern University in 2008. Aaron is registered to practice before the United States Patent and Trademark Office.

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Practice Areas

Appellate Litigation
Copyright
Design Patents
Litigation
Trade Dress
Trademarks

Industries

Life Sciences & Pharmaceuticals
Medical Devices



ERIN E. BRYAN

Attorney

Erin Bryan concentrates her practice in patent prosecution and litigation, copyright registrations, and trademark registrations. Her patent practice focuses on the biochemical, chemical engineering, and mechanical engineering arts.

Ms. Bryan also has experience with European Patent Law, and in particular, European opposition proceedings, having interned in Germany.

Prior to attending law school Ms. Bryan worked as a lab technician at a start-up biotechnology company where she conducted her master's thesis research on class I histone deacetylases. She also conducted research on capillary electrophoresis of low explosives while attending Worcester Polytechnic Institute.

At Suffolk University Law School, Ms. Bryan was a member of the Journal of High Technology. While a member of the Journal, Ms. Bryan authored and published an article entitled "Gene Protection: How Much is Too Much? Comparing the Scope of Patent Protection for Gene Sequences Between the United States and Germany." Ms. Bryan was also a 2008-2009 Lead Articles Editor.

Ms. Bryan is an active member in the New Lawyers committee of the Women's Bar Association and the Biotechnology committee of the Boston Patent Law Association. She is also an active member of AIPLA and the ABA.

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Court Admissions

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Practice Areas

Appellate Litigation
Copyright
Litigation
Patent Prosecution
Trademarks

Industries

Chemistry & Chemical Engineering
Life Sciences & Pharmaceuticals



STEVE S. CHANG

Attorney

Steve Chang's practice focuses on assisting clients with managing their domestic and foreign utility and design patent portfolios. He works with clients to encourage (e.g., via developing inventor incentive programs), collect and cultivate invention disclosures from busy inventors, to help identify core concepts for patentability, and to guide the preparation and prosecution of the corresponding patents with an eye towards compact prosecution and broad patent scope. In addition to patent prosecution, he is experienced in evaluating the strengths and weaknesses of patents for litigation and/or licensing, and his litigation work includes district court trial and appeals to both the U.S. Court of Appeals and the United States Supreme Court.

Steve has handled utility patents in a wide-range of computer and electrical technologies, including Internet services, video games, content delivery networks, user interfaces, wired (e.g., DOCSIS, MoCA, etc.) and wireless (e.g., cellular, wi-fi) communication systems, and many others.

He has also handled hundreds of design patent applications to help his clients protect the novel ornamental appearances of their physical hardware and software user interfaces. Sample representations include work to protect operating system user interfaces, computing hardware and user input devices used by millions of people today.

Outside of work for clients, Steve is an Adjunct Professor at Georgetown University Law School, teaching their course on IP Pretrial Litigation Skills. Steve has also given speeches and presentations for a variety of organizations, such as the IEEE, ABA, Triangle Game Conference and U.S. Navy OGC, and has authored various articles and book chapters in the intellectual property field.

In his spare time, Steve enjoys entertaining his kids, and organizes a weekly pickup game of Ultimate.

Steve received his Bachelor of Science degree in Electrical Engineering from The Ohio State University in 1995, and has been with Banner & Witcoff since receiving his Juris Doctor from the Temple University School of Law in 1998.

Steve is a member of the District of Columbia Bar, and is admitted to practice before the United States Patent and Trademark Office, the United States Court of Appeals for the Federal Circuit, the U.S. District Court for the District of Maryland, and the United States Supreme Court.

Mr. Chang practices in the Washington, D.C. office of Banner & Witcoff, Ltd.



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Court Admissions

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U.S. Supreme Court

Practice Areas

Appellate Litigation
Copyright
Jury Trials
Litigation
Patent Prosecution

Industries

Electrical & Computer Technologies
Internet, E-Commerce & Business
Methods

MARC S. COOPERMAN

Attorney

Marc Cooperman's practice focuses on intellectual property litigation. He has successfully tried many patent, trademark and copyright cases in courts around the country, and handled many proceedings at the Trademark Trial and Appeal Board. Marc has also assisted clients with resolving disputes through various forms of alternative dispute resolution. He has recently been involved in cases in the consumer products, toy, textile and paper, medical products, and transportation industries. Some examples of published decisions from cases on which Marc has worked include:



- *McAirlaids, Inc. v. Kimberly-Clark Corp.*, 2014 WL 904717 (W.D.Va 2014)
- *Kimberly-Clark Worldwide v. First Quality Baby Products*, 2013 WL 3397871 (M.D.Pa 2013)
- *Kimberly-Clark Worldwide. v. First Quality Baby Products*, 2011 WL 2161072 (Fed. Cir. 2011)
- *Synventive Molding Solutions, Inc. v. Husky Injection Molding Systems*, 2009 WL 3172740 (D.Vt. Oct. 1, 2009)
- *First Quality Baby Prods., LLC v. Kimberly-Clark Worldwide, Inc.*, No. 09-0354, 2009 WL 1675088 (M.D. Pa. June 15, 2009)
- *Arquest, Inc. v. Kimberly-Clark Worldwide, Inc.*, 89 USPQ2D 1751 (S.D.N.Y. 2008)
- *Greenstreak Group, Inc. v. PNA Construction Technologies, Inc.*, 251 F.R.D. 390 (E.D. Mo. 2008)
- *Tyco Healthcare Retail Services AG v. Kimberly-Clark Corp.*, 480 F.Supp.2d 810 (E.D.Pa. 2007)
- *Kimberly-Clark Corp. v. Tyco Healthcare Retail Group*, 456 F.Supp.2d 998 (E.D.Wis. 2006)
- *Outside Box Innovations, LLC v. Travel Caddy, Inc.*, 455 F.Supp.2d 1374 (N.D. Ga. 2006)
- *P.N.A. Const. Technologies, Inc. v. McTech Group, Inc.*, 414 F.Supp.2d 1228 (N.D.Ga. 2006)
- *Peaceable Planet Inc. v. Ty Inc.*, 362 F.3d 986 (7th Cir. 2004)
- *National Steel Car, Ltd. v. Canadian Pacific Railway, Ltd.*, 357 F.3d 1319 (Fed.Cir. 2004)
- *Shen Wei (USA) Inc. v. Kimberly-Clark Corp.*, 64 USPQ2d 1528 (DC NIII 2002)
- *Allied Tube v. John Maneely Co.*, 57 USPQ2d 1329 (D. Ariz 2000)
- *Aero Industries v. John Donovan Enterprises*, 53 USPQ2d 1547 (S.D.Ind.1999)
- *Imperial Toy Corp. v. Ty, Inc.*, 48 USPQ2d 1299 (N.D.III. 1998)
- *Nike, Inc. v. Wal-Mart Stores*, 46 USPQ2d 1001 (Fed.Cir.1998)

Marc frequently speaks and writes about intellectual property litigation. He is an adjunct professor at Northwestern Law School in Chicago and at Georgetown University Law School in Washington, D.C., where he teaches courses on patent and trademark litigation. Marc is a contributing author to the book, "Intellectual Property Law & Interactive Media," published by Peter Lang Publishing Inc. in 2009. Marc has been a contributing editor to the *Federal Circuit Bar Journal*. He has also written a regular column on intellectual property issues affecting the toy industry for *Playthings* magazine. Marc is a past National Chair of the Saul Lefkowitz Moot Court Competition, put on by the International Trademark Association. He also has participated as a facilitator for the Illinois Supreme Court Committee on Professionalism law school program. He is admitted to practice in numerous Federal Courts and the Patent and Trademark Office.

Marc has a Bachelor of Science in Mechanical Engineering (1986) and a Juris Doctor (1989), both from the University of Illinois.

Marc has been featured in several magazines, including a *Chicago Daily Law Bulletin* article when he became managing partner of the firm at age 34. Marc was featured as a "Notable Practitioner" in the Intellectual Property – Illinois section of *Chambers & Partners USA 2014*. Marc was named an IP Star by *Managing Intellectual Property* in 2014 and is also listed in Euromoney's "Guide to the World's Leading Patent Law Practitioners."

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U.S. Patent and Trademark Office
U.S. Supreme Court

Practice Areas

Appellate Litigation
Copyright
Counterfeit Goods Seizure
Jury Trials
Litigation
Trade Dress
Trademarks

Industries

Medical Devices



MICHAEL S. CUVIELLO

Attorney

Michael CuvIELLO concentrates in patent counseling and the preparation and prosecution of patent applications. He assists a wide range of clients manage and grow their patent portfolios, and he understands the varying challenges and needs of different businesses ranging from small startups to global corporations. Mr. CuvIELLO is also experienced in international prosecution, taking into account the nuances of obtaining patent rights in different jurisdictions.

Having years of experience in a broad spectrum of industries, Mr. CuvIELLO is able to provide effective strategies to secure the broadest protection possible for his client's ideas. His technical areas of expertise include semiconductor devices including digital, analog, power, and RF microcircuits; electromechanical devices; renewable energy technologies; computer software applications with concentrations in user interfaces (UIs), and embedded firmware; Internet technologies; and wireless communications.

Prior to joining the firm, Mr. CuvIELLO spent fifteen years working as an engineer for various government agencies, in the private sector, and in academia. Working with NASA and the Department of Defense on both classified and unclassified programs, he developed a wide range of satellite and Space Shuttle electronics, including pyrotechnic ignition systems, full custom flight computers, multi-chip-module devices, and ASICs. In the private sector, he worked for a small startup company developing custom low-power deep sub-micron microelectronic circuits including custom embedded memories for PDAs and cell phones. In academia, during his graduate career, Mr. CuvIELLO was awarded the Microelectronics Innovation and Computer Research Opportunities (MICRO) Fellowship to support his research into digital and mixed signal ASIC semiconductor technology, advance generation wireless/cellular systems such as CDMA, GSM, and other military spread spectrum systems, re-configurable computing, adaptive signal processing, and image processing. Mr. CuvIELLO further developed syllabus and lecturer material for undergraduate and graduate courses in ASIC design. Mr. CuvIELLO is an active member of the IEEE, where he maintains his connection to the engineering and science communities

Mr. CuvIELLO earned a Bachelor of Science degree in Electrical Engineering from the University of Maryland, College Park, and a Masters of Science degree in Electrical and Computer Engineering from the University of California, San Diego. He earned his Juris Doctor from Georgetown University Law Center.

Mr. CuvIELLO practices in the firm's Washington, D.C. office.

Admitted to practice before the United States Patent & Trademark Office and the State of Maryland. Practice in the District of Columbia is limited to matters and proceedings before federal courts and agencies.



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Court Admissions

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Practice Areas

Patent Post-Issuance Proceedings

Industries



ROSS A. DANNENBERG

Attorney

Ross Dannenberg handles a wide-range of intellectual property issues, with experience in Internet, video game, telecommunications, and computer software-related issues. With a background in computer science, Ross has prepared and prosecuted hundreds of patent applications in a variety of technical fields, and has been involved in numerous patent, copyright, and trademark enforcement lawsuits. He has considerable experience with intellectual property protection of video games, including patent, trademark and copyright protection, copyright clearance, licensing, and enforcement of intellectual property rights.

Mr. Dannenberg earned his Bachelor of Science degree in Computer Science from the Georgia Institute of Technology in 1994, and earned his private pilot's license in 1999. Between his undergraduate studies and law school, Mr. Dannenberg was an Information Systems Manager for Carnival Cruise Lines, where he was responsible for all facets of computer and network use, training, and administration aboard a cruise ship. He earned his Juris Doctor from The George Washington University Law School in 2000, where he was a member of The Environmental Lawyer legal journal.

Mr. Dannenberg is a founding member of the Video Game Bar Association, and was the founding Chair of the American Bar Association's (ABA) IP Section Committee on Computer Games and Virtual Worlds. Mr. Dannenberg is the Editor-in-Chief of the Patent Arcade website, is the editor and an author of The American Bar Association's Legal Guide to Video Game Production, published by the ABA in 2011, and is an executive editor of Computer Games and Virtual Worlds: A New Frontier in Intellectual Property Law, published by the ABA IP Section in 2010. Mr. Dannenberg is a Lifetime Fellow of the American Bar Foundation, and is an adjunct copyrights professor at George Mason University School of Law.

Mr. Dannenberg was named to Washington D.C. Super Lawyers in 2013 and 2014, and *Managing Intellectual Property's* IP Stars in 2013.

Mr. Dannenberg's representative clients include multinational software, networking, and telecommunications companies, multiple video game companies having user bases of over 20 million users, video game developers and publishers of various sizes, and emerging technology companies.

Mr. Dannenberg practices in the firm's Washington, D.C. office.



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Practice Areas

Copyright
Design Patents
Litigation
Patent Prosecution
Trademarks

Industries

Electrical & Computer Technologies
Internet, E-Commerce & Business
Methods



JOHN M. FLEMING

Attorney

John Fleming concentrates on preparing and prosecuting utility and design patent applications in a variety of technical fields while participating in litigation matters, client counseling, and a wide variety of opinion work. Mr. Fleming's technical areas include telecommunications, Internet-related and private network technology, semiconductors, e-commerce, digital/electronic handwriting, color management, graphical user interface systems, financial security and authentication, application programming interfaces, and computer-relation technologies involving hardware, software, and firmware. In addition, Mr. Fleming has an extensive amount of design prosecution experience and development, including various hardware in addition to computer interfaces and icons. Mr. Fleming has filed and prosecuted hundreds of design applications from initial prototypes to commercially available products. With a practical based background in electrical engineering, Mr. Fleming has experience in all phases of writing and prosecuting complex patent applications in a variety of technical fields.

Mr. Fleming's engineering accomplishments are based in part on his applied experience as an electrical engineer for Schlumberger Industries, RMS. As both an application and product engineer, his activities included design, implementation, and maintenance of various power measurement systems and structures utilizing a variety of telecommunication and power measurement technologies. Mr. Fleming also gave instruction and training on use and operation of product and software packages, and handled on-site restoration and maintenance of system and component failures, including a project at the launch of deregulation of the electric utility market.

Mr. Fleming serves as Associate Professorial Lecturer in the Mechanical and Aerospace Engineering Department (MAE) at The George Washington University teaching Patent Law for Engineers. Taught to undergraduate and graduate level science-based students, this course covers all major aspects of intellectual property including patents, trademarks, copyrights and related matters and is one of three courses that together comprise a Patent Law Option offered through The George Washington University's School of Engineering and Applied Sciences (SEAS), the first of its kind in the country. Mr. Fleming, along with other faculty at The George Washington University, co-created the Patent Law Option and began offering courses in this program in early 2006.

Mr. Fleming earned his Bachelor of Science degree in Electrical Engineering from Clemson University with concentrations in circuit design and configurations and fiber optic technologies. He earned his Juris Doctor from The Catholic University of America Columbus School of Law in 2002.

Mr. Fleming is admitted to the bars of the District of Columbia and the Commonwealth of Virginia, and is registered to practice before the U.S. Patent and Trademark Office. He is also a contributor to the American Bar Association Section of Intellectual Property Law's Patent Litigation Strategies Handbook.

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Court Admissions

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Practice Areas

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Design Patents
Litigation
Patent Prosecution

Industries

Electrical & Computer Technologies
Internet, E-Commerce & Business
Methods



SHAWN P. GORMAN

Attorney

Shawn Gorman has experience in a range of intellectual property issues, primarily in complex patent matters.

Mr. Gorman prepares and prosecutes patent applications in a wide variety of technology areas, including the electronic arts, business methods, mechanics and biotechnology. Specifically, he has prepared and prosecuted applications relating to graphical user interfaces, cellular technologies, integrated business systems and models, video gaming systems, online gaming systems, as well as interleukins, medical diagnostics and laboratory devices.

Mr. Gorman often works directly with the firm's clients to combine multiple forms of intellectual property protection. In this regard, he obtains domestic and international patent rights to protect the client's core technology and business methods, trademark protection, and enforcement of those rights through licensing and purchasing agreements. Shawn works closely with foreign attorneys throughout the world to determine the best strategies for multiple jurisdictions. He has assisted in the training of foreign attorneys in U.S. patent laws and continually uses this experience to further his knowledge of international laws and best practices.

When litigation has become necessary, Shawn has handled the various aspects of patent litigation. He is presently a member of a trial team for a Fortune 500 medical device company as well as member of a trial team defending a leading manufacturer of VoIP telephony devices.

Before joining Banner & Witcoff, Mr. Gorman was with the patent division of CIBA Vision. He also served as an extern for Wyeth Pharmaceuticals. Mr. Gorman earned his graduate degree from the University of Florida College of Veterinary Medicine, where he was awarded the Phi Zeta Excellence in Master's Studies Scholarship for his work investigating an experimental patent-pending product. The results of his graduate worked were utilized to satisfy the best mode requirement of U.S. patent laws.

Mr. Gorman is a contributing author for *The American Bar Association's Legal Guide to Video Game Production*, published by the ABA in 2011. Mr. Gorman has also written articles in such publications as the *Journal of the American Veterinary Medical Association*, *Theriogenology*, and the *Pierce Law Review*.

Mr. Gorman earned his Juris Doctor degree from the Franklin Pierce Law Center, where he was Senior Staff Editor of the *Pierce Law Review*, successfully contended in the Jessup International Law Moot Court and was honored to receive the Rapee Intellectual Property Scholarship. He is admitted before the United States Patent and Trademark Office.

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Bar Admissions

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Court Admissions

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Practice Areas

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Patent Prosecution
Trademarks

Industries

Chemistry & Chemical Engineering
Electrical & Computer Technologies
Internet, E-Commerce & Business
Methods
Life Sciences & Pharmaceuticals
Medical Devices



R. GREGORY ISRAELSEN

Attorney

Greg Israelsen focuses on intellectual-property litigation, representing clients in patent disputes related to electrical, computer-hardware, computer-software, and mechanical arts. He also represents clients in copyright- and trademark-infringement actions.

During law school, Mr. Israelsen worked as a summer associate at the firm. He also clerked for a patent boutique, where he drafted and prosecuted patent applications for a Fortune 50 client and was part of a litigation team in a trademark-infringement action for a nationwide food franchise.

Before law school, Mr. Israelsen formed his own company and developed smartphone apps for mobile platforms. Several of his apps won awards from a well-known smartphone manufacturer and were featured on a top technology website.

Mr. Israelsen studied Electrical Engineering at the University of Illinois at Urbana-Champaign and at Brigham Young University. He earned a Bachelor of Science, *with University Honors*, from Brigham Young University. He earned a Juris Doctor, *cum laude*, from the J. Reuben Clark Law School at Brigham Young University. In law school, he served as Vice President of the Student Intellectual Property Law Association, Vice President of the Student Bar Association, Senior Editor on the *Brigham Young University Law Review*, and Managing Articles Editor on the *BYU Journal of Public Law*. He was a member of the IP Moot Court, Vis International Commercial Arbitration, and Moot Court teams. He also won the local Giles S. Rich IP Moot Court competition two years in a row, going on to represent his school at the regional competition in California. And he received the Faculty Award for Meritorious Achievement and Distinguished Service and the John S. Welch Award for Outstanding Legal Writing.

Mr. Israelsen has extensive international experience. He lived for several years in Hong Kong and Caracas, Venezuela, and has traveled all over the world. He is fluent in spoken Cantonese and conversant in Spanish.

Mr. Israelsen practices in the Washington, DC office of Banner & Witcoff, Ltd.



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Court Admissions

Supreme Court of Illinois
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Memberships

American Bar Association (ABA)

Practice Areas

Appellate Litigation
Copyright
Counseling, Opinions & Licensing
Counterfeit Goods Seizure
Jury Trials
Litigation
Patent Prosecution
Trade Dress
Trade Secrets
Trademarks

Industries

Electrical & Computer Technologies
Internet, E-Commerce & Business
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JOHN P. IWANICKI

Attorney

John P. Iwanicki is a registered patent attorney with 25+ years of experience analyzing intricate legal issues from a cutting edge perspective in procuring and enforcing intellectual property rights in the chemical, life sciences and biotechnology industries. Start-ups and established companies alike rely on John to understand their business objectives when designing strategies to achieve market exclusivity and freedom to operate.

John is the rare combination of a patent litigator and patent prosecutor. Possessing both skill sets, John brings a perspective unique in the industry to obtaining and enforcing patents. John works hand-in-hand with clients to develop and manage pragmatic patent portfolios and to advise clients on the patent portfolios of others when making licensing or investment decisions. Recognizing that a patent can be both a sword and a shield, John has both enforced patents and defended allegations of patent infringement in federal court.

A conference organizer and presenter in China, John has lectured to Chinese scientists, business executives, representatives of SIPO and students in Beijing, Shenzhen and Shanghai on issues of United States patent law practice and procedure. John is also a member of the American Chemical Society.

John has been named a Massachusetts Super Lawyer annually since 2004 and was named a Life Sciences Star by LMG Life Sciences for 2012-2013. John has also been named an IP Star by Managing Intellectual Property for 2013 and has been named by Intellectual Asset Management 1000 as one of "The World's Leading Patent Practitioners" for 2013.

John practices in the Boston office of Banner & Witcoff, Ltd.

A frequent lecturer, teacher and author on intellectual property, John's recent speaking engagements and publications are below:

Speaking Engagements

Speaker, Gene Patenting Pre- and Post-Myriad, Haut Conseil des Biotechnologies, Paris, France, April 29, 2014.

Speaker, Obviousness Post Myriad and Prometheus: A Practical Approach to Prosecution, IP Leadership Forum, New Delhi, India, January 9, 2014.

Speaker, Protecting protein and peptide related inventions, PepCon-2013, Suzhou, China, March 21, 2013.

Speaker, Demystifying the Current Obviousness Standard and Its Implications for Biotech Patenting, American Conference Institute's Biotech Patents Conference, Boston, MA, November 29, 2012.

Speaker, Protein and Peptide Related Inventions, PepCon-2012, Beijing, China, March 25, 2012.

Speaker, The America Invents Act, Pharma IPR Conference, Mumbai, India, February 1, 2012.

Speaker, Preparing for a Radical Overhaul of the U.S. Patent System: The Impact of Reform on Biotech Patent Strategies, American Conference Institute's Biotech Patents Conference in Boston, December 1, 2011.

Speaker, Patenting Your Medicinal Chemistry Invention, Chinese National Medicinal Chemistry Symposium, Guangzhou, China, November 20, 2011.

Speaker, Patenting of Antibodies, American Conference Institute's Biotech Patents Conference, Boston, MA, December 1, 2010.

Speaker, Patenting of Antibodies, American Conference Institute's Biotech Patents Conference, Boston, MA, November 30, 2010.



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Bar Admissions

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1991, District of Columbia

Court Admissions

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of Columbia
U.S. Court of Appeals for the Federal
Circuit
U.S. Court of Appeals for the First
Circuit
U.S. District Court for the District of
Massachusetts
U.S. Supreme Court

Memberships

American Chemical Society
IPO Pharmaceutical Issues Committee

Practice Areas

Counseling, Opinions & Licensing
Jury Trials
Litigation
Patent Prosecution

Industries

Chemistry & Chemical Engineering
Life Sciences & Pharmaceuticals

Speaker, IP Basics, Zhongguancun Haidian Science Park Beijing, Beijing China, September 10, 2010.

Speaker, US Patent Practice, The Patent Information Annual Conference of China (PIAC China), hosted by the State Intellectual Property Office, Beijing China, September 9, 2010.

Speaker, Safe Harbor Provision of 35 USC sec. 271(e)(1), American Conference Institute's Hatch-Waxman Bootcamp in Boston July 19-20, 2010.

Speaker, "IP Issues Relating to Therapeutic Oligonucleotides and Peptides," IBC LifeSciences TIDES Conference, Boston, MA, April 28, 2010.

Hosts a Roundtable Discussion, "The Practical Aspect of Patents as Strategic Business Tools," Cambridge Healthtech Institute's 9th Annual Peptide and Protein Conference, San Diego, CA, January 12, 2010.

Speaker, "Maximizing Your Global Patent Strategy," 5th International Conference on Corporate Intellectual Property Strategy, Zhengzhou, Henan Province of China, October 28-30, 2009.

Guest Lecturer, "Making Medicine," Harvard University, Cambridge, MA, June 22, 2009.

Speaker, "Freedom to Operate and Injunctions under US Law," Unitalen Law Firm, Beijing, China, June 5, 2009.

Keynote Speaker, "Global Patent Strategies," International Symposium on Drug Discovery and Intellectual Property, Suzhou, China, June 2, 2009.

Short Course Lecturer, "Intellectual Property as it Relates to Antibodies", Cambridge Healthtech Institute's 5th Annual PEGS Protein Engineering Summit, Boston, MA, April 5, 2009.

Chair and speaker, "Biotechnology and Technology Transfer," BIT Life Sciences 3rd Annual Protein and Peptide Conference, Beijing, China, March 23, 2009.

Short Course Lecturer, "Intellectual Property as It Relates to Peptides and Proteins ad Therapeutics and Diagnostics", Cambridge Healthtech Institute's Peptide and Protein Week, San Diego, CA January 11, 2009.

Keynote Speaker, Beijing International Workshop on Drug Design and IP Protection in Beijing, China, October 23-24, 2008.

Speaker and Chair, BIT's 5th Annual International Conference on Drug Design Science and Technology in Beijing, China, October 18-22, 2008.

Speaker, "We've Got Patents. How Can We Be Sued"?, BIT's 1st Annual Protein and Peptide Conference in Shenzhen, China, April 22-24, 2008.

Speaker, "Avoiding IP Surprises"; Cambridge Healthtech Institutes 14th Annual Molecular Medicine Tri-Conference in San Francisco March 25, 2008.

Speaker, Protein and Peptide Patent Law, Cambridge Healthtech Institute's Peptide and Protein Week, San Diego, CA January 12, 2008.

Speaker, "US Pharmaceutical Patent Law", State Intellectual Property Office of the People's Republic of China pharmaceutical conference in Beijing October 17-19, 2007.

Speaker, "Freedom to Operate: Analysis and Opinions for Pharma and Biotech Patents, Pharma/Biotech Patent Boot Camp, American Conference Institute, San Francisco, September 18-19, 2007.

Speaker, Protecting Start-Up Intellectual Property; CELLutions Summit, Cambridge Healthtech Institute, Boston MA, August 20, 2007.

Speaker, Written Description and Enablement in Biotechnology related cases: Current Developments in Federal Circuit Caselaw, American Conference Institute, Palo Alto, California, April 18-19, 2007.

Speaker, "Intellectual Property Issues for Emerging Technology Companies"; Cambridge Healthtech Institutes 13th Annual Molecular Medicine Tri-Conference in San Francisco February 27, 2007.

Speaker, "Nanotechnology", South Shore Science Center, January 27, 2007.

Speaker, "Peptide and biomarker related Inventions"; Cambridge Healthtech Institute's 6th Annual Peptide-Protein Information conference in San Diego January 9-12, 2007.

Speaker, "Corporate Counsel Seminar" in Chicago December 8, 2006.

Speaker, "Current trends in drafting pharmaceutical patent applications" for American Conference Institute's 7th Advanced Forum on Biotech Patents in Boston November 29-30, 2006.

Speaker, "Protecting Your Pharmaceutical Inventions", State Intellectual Property Office of the People's Republic of China pharmaceutical conference in Beijing November 1-3, 2006.

Speaker and Course Organizer; Cambridge Healthtech Institutes's Second Annual Executives on Target pharmaceutical conference in Boston October 24-25, 2006. Short course on Protecting Your Pharmaceutical Inventions. Speaker on litigation issues involving pharmaceutical inventions.

Speaker, "Patents as Business Tools"; Cambridge Healthtech Institutes' Partnerships & Technology conference, August 17, 2006 in Boston.

Speaker, "Building Foundations for Screening Technologies, Therapeutics and Regenerative Medicine": Cambridge Healthtech Institutes' Science of Stem Cell Research conference, August 14, 2006 in Boston.

Speaker, "Patenting Peptides and Peptide-Related Inventions", CHI's Annual Peptide Conference, San Diego, January 2006 Speaker, "Overview of the Patent Application Process", Harvard University, 2003.

Speaker, "The Present Status of Gene Patenting", National Human Genome Research Institute, 2002.

Speaker, "Gene Patenting", University of Maryland School of Law, 2002 Speaker, "Patenting Plastics", Society of Plastic Engineers, 2001.

Articles and Publications

"The Attack on Patentable Subject Matter Continues: Organic Seed v. Monsanto Pushes Utility to the Limit"; *BNA's Patent, Trademark & Copyright Journal*, May 2011

"The Attack on Patentable Subject Matter: ACLU v. Myriad Genetics as a Harbinger of Things to Come"; *BNA's Patent, Trademark & Copyright Journal*, August 2010

"Oral Argument Sheds Light in *Bilski v. Kappos*," *Genetic Engineering & Biotechnology News*, December 2009

"Tips on How to Properly Construe Patent Claims"; *Genetic Engineering & Biotechnology News*, December 2008

"Biotechnology & Pharmaceutical Sector Special Report"; *Financier Worldwide*, February 2007

"International Efforts Are Achieving Credible IP Enforcement Even Amid Chronic Abuse", *Intellectual Property & Technology Law Journal*, March 2006

"Stemming the Tide of Counterfeits Abroad", *National Law Journal*, December 2005

"Brazil's Agreement with Abbott: A New Perspective on Patent Prosecution as a Business Process", *Intellectual Property & Technology Law Journal*, December 2005

Zhongguancun Haidian Science Park Beijing, Beijing China, September 10, 2010



SEAN J. JUNGELS

Attorney

Sean Jungels enjoys practicing in all areas of intellectual property law. He has experience in researching and analyzing both legal and technical issues, drafting motions and opinions, and assisting in various phases of litigation and client counseling.

Sean currently concentrates on intellectual property litigation, representing clients from small companies to Fortune 500 corporations. Sean recently helped to represent a Fortune 500 client in the apparel industry in a trademark dispute.

Sean graduated Order of the Coif and earned his J.D. degree with high honors from Chicago-Kent College of Law. He also received a certificate in intellectual property law and two Cali awards in legal writing. He was also an associate editor for the Chicago-Kent Journal of Intellectual Property and was involved with the Intellectual Property Law Society. Sean earned a Bachelor of Science in Mechanical Engineering from the University of Illinois Urbana-Champaign.

Sean is admitted to practice before the Supreme Court of Illinois. He is also admitted to practice before the United States Patent and Trademark Office.

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Patent Prosecution
Trademarks

Industries



RAJIT KAPUR

Attorney

Rajit Kapur has handled a broad range of intellectual property issues in a number of different technical areas, including matters involving computer software, mobile devices, Internet applications, video games, graphical user interfaces, financial products and services, multimedia networks and systems, satellite communications and positioning systems, business methods, ergonomic office products, wind turbines, printers and multifunction devices, and mechanical devices. In addition to his extensive experience in drafting and prosecuting patent applications for different technologies, Rajit also has experience in researching and analyzing legal and technical issues, drafting opinions, preparing reexamination requests, and assisting in various phases of IP litigation and counseling.

Rajit's clients range from large corporations to small businesses, startups, and individual inventors. One of Rajit's representative clients is a software startup that designs and develops social networking apps, mobile games, and other innovative apps for mobile devices. In representing this company, Rajit has assisted in developing IP protection and enforcement strategies and in preparing and prosecuting a number of patent, trademark, and copyright applications.

While attending law school, Rajit first worked with the firm as a summer associate and as a law clerk, and he later spent several years with the firm as an attorney before relocating to Northern California. Prior to rejoining Banner & Witcoff in 2012, Rajit worked as an associate in the Silicon Valley office of a large international law firm, where his practice focused on patent prosecution in the electrical and computer arts.

Rajit earned his B.S. in Mechanical Engineering, *magna cum laude*, from Tufts University and his J.D. from The George Washington University Law School, where he was the Vice President of the Student Intellectual Property Law Association.



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Trademarks

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Internet, E-Commerce & Business
Methods



ROBERT S. KATZ

Attorney

Robert Katz has benefited firm clients in the areas of utility patents and industrial designs. Mr. Katz has drafted and prosecuted to issuance numerous and significant utility patents in the U.S. and in foreign countries. These clients include Fortune 500 companies as well as many individual inventors and small companies who rely on strong patent protection in their marketplaces. The patents have been directed primarily to mechanical and electromechanical devices, and to software and computer-related inventions. Many patents drafted and prosecuted by Mr. Katz have been successfully enforced with some having served as the cornerstone for the successful sale of companies.



Mr. Katz has also provided advice and prepared opinions regarding the patentability of inventions, patent infringement, patent validity, and trade secret protection to help clients properly assess the advantages and disadvantages of certain intellectual property and business decisions.

In patent and trademark litigation matters, he has assisted clients in enforcing and defending intellectual property related claims at the district court and the Court of Appeals for the Federal Circuit, and in the International Trade Commission.

Both nationally and internationally, Mr. Katz is considered as one of the premier practitioners in the field of industrial designs leading the way in the procurement and enforcement of design patents. On behalf of the firm's clients, he has helped procure over 5,000 design patents in the U.S. and over 15,000 design patents/registrations outside the U.S., and has helped to successfully enforce over 100 design patents. Leaders from foreign Design Patent Offices have consulted with him regarding industrial design policies, and he has been named as an expert in multiple design patent litigations.

He is a frequent speaker on industrial design-related topics and has been invited to speak before industry and legal professional organizations on six continents. He has spoken at conferences and seminars hosted by ABA (American Bar Association), AIPLA (American Intellectual Property Law Association), FICPI (Federation International des Conseils en Propriete Industrielle), INTA (International Trademark Association), IPO (Intellectual Property Owners Association), IPR University Center (Finland), the U.S. Patent and Trademark Office (USPTO), and WIPO (World Intellectual Property Office). Representatives from the Japanese Patent Office and WIPO have consulted with him on issues of design patent harmonization.

Mr. Katz has written articles addressing issues relating utility patent, design patent, and trade dress rights. Mr. Katz has authored a section of a recently published book entitled *Writing Patents for Litigation and Licensing* for BNA Publishing. He is currently a professor at George Washington University Law School teaching Design Law and a professor at Georgetown University Law School teaching Intellectual Property Pretrial Litigation Skills.

Mr. Katz is a member of several professional organizations including: AIPLA, FICPI, ABA, IPO, and IDSA (Industrial Design Society of America). In FICPI, he currently serves as Secretary of the U.S. Section, and is a former Chair of the Industrial Design Section for both FICPI and AIPLA. Mr. Katz also serves as a member of the Industrial Designs working group of the AIPLA Special Committee on Legislation, and on an INTA Presidential Task Force on Trademarks and Innovation.

Before joining Banner & Witcoff, Mr. Katz was a patent examiner at the USPTO. In that capacity, he examined patent applications for article and material handling devices covering a broad range of applications including robotics, conveyors, and loading and unloading vehicles. Mr. Katz also worked as a mechanical engineer at Digital Equipment Corporation's High Performance Systems where he designed mechanical, electrical, and electromechanical devices for main-frame computers. Additionally, he is a co-inventor of U.S. Patent No. 4,723,549 entitled "*Method and Apparatus for Dilating Blood Vessels*."

Mr. Katz earned his Bachelor of Science degree in Mechanical Engineering from Carnegie-Mellon University, and his Juris Doctor degree, with honors, from George Washington University. He is admitted to practice before many courts including the U.S. Court of Appeals for the Federal Circuit and the U.S. District Court for the Eastern District of Virginia. He is a member of the bar in Virginia and the District of Columbia, and is registered to practice before the U.S. Patent and Trademark Office.

Mr. Katz was named as one of the "Top 50 Under 45" intellectual property attorneys in 2008 by *IP Law*

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Patent Prosecution
Trademarks

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Mr. Katz practices in the Washington, DC office of Banner & Witcoff, Ltd.



ANNA L. KING

Attorney

Anna King enjoys practicing in many areas of intellectual property law. Anna currently concentrates her practice on trademark and copyright prosecution and counseling matters. Her experience in these fields includes prosecution of applications, enforcement and oppositions. She is part of a team representing a leading foodservice products company and a professional audio product company.

Anna co-wrote several articles for such organizations as The International Trademark Association, Practising Law Institute and The Bureau of National Affairs as well as World Trademark Review. A complete list of these articles can be seen below.

Anna currently serves as Chair of the Trademark Committee of the Intellectual Property Law Association of Chicago (IPLAC).

Anna was awarded her J.D. degree from Indiana University School of Law-Bloomington. There she was involved in the Intellectual Property Association, Sports & Entertainment Law Society and Sherman Minton Moot Court. Anna earned a Bachelor's of Arts degree in Anthropology, *cum laude*, from Connecticut College.

Anna is admitted to practice before the Supreme Court of Illinois and the U.S. District Court for the Northern District of Illinois.

Anna practices in the Chicago office of Banner & Witcoff, Ltd.

Published Articles

- *Be prepared: The importance of due diligence in choosing between bench and jury trials*, (World Trademark Review) (April/May 2013).
- *Brand Locally, Think Globally: International Trademark Searching & Filing Strategies*, (Practicing Law Institute's Understanding Trademark Law) (June 2011).
- *Where to Start?: Understanding Trademark Searching and Filing in a Global Marketplace* (Practicing Law Institute's Understanding Trademark Law) (June 2010).
- *Caution: Do Not Outsource Your Ethical Obligations!, Outsourcing and Ethical Issues* (Int'l Trademark Ass'n Annual Meeting, Boston, MA) (May 2010).
- *Global Harmonization of Trademark Laws: Not Quite There Yet*, 74 BNA PTCJ 77 (2007).



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Trademarks

Industries

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CRAIG W. KRONENTHAL

Attorney

Craig Kronenthal devotes his practice to the preparation and prosecution of patent applications in various fields, and especially in the computer and electronic device areas. Additionally, Craig is actively involved in litigation and reexamination matters, client counseling, and preparing patentability and infringement opinions. Craig regularly works with start-ups and entrepreneurs as well as large, multinational corporations.

Craig has extensive experience in matters related to semiconductors, antennas, telecommunications, computer networks, data encryption, e-commerce, and nanotechnology. Craig also has significant experience in prosecuting and preparing applications for biomedical and mechanical inventions. Further, Craig has technical experience in the fabrication, measuring, and testing of micro-resonators and other silicon based microelectromechanical systems for biomedical applications.

Before joining Banner & Witcoff, Craig was a patent examiner at the U.S. Patent & Trademark Office (USPTO) for more than two years. As a patent examiner, his primary focus was on image processing with regards to watermark, biomedical, and object tracking applications. Moreover, Craig obtained valuable experience through his previous positions at the law firms of IP&T Group LLP in Annandale, VA, Sughrue Mion, PLLC in Washington, DC, and Christopher & Weisberg, PA in Ft. Lauderdale, FL. His experiences include conducting prior art searches, drafting patent applications, responding to office actions, and preparing trademark and patentability opinions.

Craig graduated from the Georgia Institute of Technology with a Bachelor of Science degree in Electrical Engineering and a Certificate of Entrepreneurship. While at Georgia Tech, Craig worked for the MicroSensors and MicroActuators Group in the School of Electrical and Computer Engineering. In addition, Craig earned his Juris Doctorate, *cum laude*, from the University of Miami School of Law. During law school, Craig participated in the Health and Elder Law Clinic and was Vice President of the Intellectual Property Law Society and a member of the University of Miami Business Law Review.

Mr. Kronenthal is admitted to practice before the United States Patent & Trademark Office and in the State of Virginia. Practice in the District of Columbia is limited to matters and proceedings before federal courts and agencies.



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Patent Post-Issuance Proceedings
Patent Prosecution

Industries

Electrical & Computer Technologies
Internet, E-Commerce & Business
Methods



ERNEST V. LINEK

Attorney

In over thirty years of practice, Ernest Linek has successfully prosecuted hundreds of U.S. and international patent applications in fields including natural product chemistry, polymer chemistry, pharmaceuticals, biotechnology, electroplating, semiconductors, and photoreceptors. Non-chemical utility patents and design patents obtained by Mr. Linek have included household storage containers, police safety equipment, toys, games and sporting goods.

In addition to his patent practice, Mr. Linek's trademark practice has resulted in his assisting clients in the selection and registration of hundreds of new trademarks and service marks, both in the United States and abroad, including Community Trademark and Madrid Protocol filings. He is also very active in providing client counseling and opinions regarding the validity and infringement of patents and trademarks.

Mr. Linek has extensive litigation experience and has successfully protected his client's interests in numerous Federal District Courts and before the U.S. Court of Appeals for the Federal Circuit. Specific areas of litigation have included trademark infringement, trade dress infringement, design patent infringement and utility patent infringement actions.

Mr. Linek also provides his clients with counseling and legal opinions regarding issues of validity and infringement of both patents and trademarks. On multiple occasions, Mr. Linek has served as a patent expert in litigation.

Mr. Linek also devotes time to the education of future lawyers, and he has been a guest lecturer at Franklin Pierce Law School in Concord, New Hampshire and at Northeastern Law School in Boston, Massachusetts.

Mr. Linek earned his B.S. degree in Chemistry (with a minor in computer science) in 1975 from the State University of New York, College at Fredonia, and his M.S. in Organic Chemistry in 1977 from the University of New Hampshire. He earned a J.D. degree in 1982 from Seton Hall University. From 1977 to 1984, Mr. Linek was employed by the multi-national pharmaceutical company - Merck & Co., first as a research chemist, then as a patent agent and finally as a patent attorney.

He is admitted to practice in the states of New Jersey and Massachusetts, as well as the Federal District Courts thereof. In addition, Mr. Linek is admitted in the U.S. District Court for the Eastern District of Wisconsin, and the Courts of Appeals for the Ninth and Federal Circuits. He is also active in numerous professional organizations, including the New York Academy of Science, the American Chemical Society, the American Bar Association, the Boston Bar Association, the Massachusetts Bar Association, the Federal Circuit Bar Association, the American Intellectual Property Law Association and the Boston Patent Law Association.

Mr. Linek was selected to appear on the 2007, 2008, 2009, 2010 and 2011 New England Super Lawyers list published by Thomson Reuters. The listings were published in *Boston Magazine* and in the legal publication, *New England Super Lawyers*.

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Copyright
Design Patents
Jury Trials
Litigation
Patent Prosecution
Trademarks

Industries

Chemistry & Chemical Engineering
Internet, E-Commerce & Business Methods
Life Sciences & Pharmaceuticals
Medical Devices



ERIK S. MAURER

Attorney

Erik Maurer focuses his practice on intellectual property litigation and counseling. He represents clients in matters involving utility patent, design patent, trade secret, trademark, trade dress, unfair competition, antitrust, and copyright issues, from both plaintiffs' and defendants' perspectives. In every instance, Erik strives to understand clients' goals and then to efficiently achieve those goals using appropriate advocacy and dispute resolution skills reinforced by modern technological resources.



With this approach Erik has successfully served as appellate advocate; handled temporary restraining order and preliminary injunction hearings; secured and executed seizure orders; examined witnesses, presented evidence, and argued to judge, jury, and arbitrator; efficiently conducted complex ESI discovery; drafted winning motions through every phase of litigation; and briefed successful appellate and amicus curiae submissions.

Mr. Maurer enjoys teaching and serves as an adjunct professor at Northwestern University School of Law in Chicago teaching Patent Trial Practice. Mr. Maurer taught Patent Trial Practice at the Georgetown University Law Center in DC, where he also taught Trial Practice in the High Technology Courtroom, a course he wrote based on experiences simplifying complex patent issues for expert examinations at trial and for pre-trial *Markman* hearings.

Mr. Maurer is also a contributing author to the *Patent Trial Advocacy Casebook, Second Edition* published by the American Bar Association.

Erik graduated *Order of the Coif* and earned his Juris Doctor, *cum laude*, from Northwestern University School of Law. He was an associate editor of *Northwestern's Law Review*, and published his article, "An Economic Justification for a Broad Interpretation of Patentable Subject Matter" in the *Law Review's* Spring 2001 volume. Prior to law school, Erik worked in the environmental engineering field and in policy development at the United States Environmental Protection Agency. Erik earned a Bachelors of Science in Biology from the University of Illinois, Urbana-Champaign in 1996.

Mr. Maurer has earned an AV Preeminent® peer review rating from Martindale-Hubbell. He was again named an "Illinois Super Lawyers Rising Star" in the field of Intellectual Property Litigation in the February 2011 edition of *Chicago Magazine*. Super Lawyers Rising Stars names the state's top 2% of up-and-coming attorneys under the age of 40 based on a comprehensive research process to find evidence of peer recognition and professional achievement.

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Section 337/ITC Litigation
Trade Dress
Trademarks

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CHRISTOPHER L. MCKEE

Attorney

Christopher McKee has focused on patent litigation, counseling and prosecution throughout his career. His concentration is in the mechanical and electrical/computer related arts.

Mr. McKee has extensive experience in handling litigation-related patent reexaminations, as well as new post-grant proceedings available under the America Invents Act. Since enactment of the AIA, his practice has been largely devoted to handling of *inter partes* review (IPR) proceedings before the USPTO's Patent Trial and Appeal Board. He served as lead counsel on behalf of the patent owner in two of the earliest filed IPRs. One of those (IPR 2012-00041) was the first to conclude in denial of the IPR petition in its entirety. The other (IPR 2012-00042) was the first IPR to result in a final written decision upholding the bulk of the patent claims in the trial.

The AIA review proceedings and reexaminations he has handled have involved a variety of art areas, including electronic design automation (EDA), computer networking/digital data transmission and dynamic system control.

In addition, Mr. McKee has substantial experience in patent litigation and licensing matters, and he has prepared and successfully prosecuted scores of patent applications, in numerous technologies. These include EDA, integrated circuit fabrication, computer (hardware and software), telecommunications, medical device and machine tool technologies, and consumer appliances.

Mr. McKee began his career in intellectual property law with the USPTO, where he served as a patent examiner from 1984-86. There, he examined patent applications in a variety of arts, including metal founding and metal fusion bonding. Mr. McKee's early experience as a patent examiner has given him a particular sensitivity to examiner concerns, enabling him to negotiate cases to allowance with great effectiveness.

Mr. McKee serves as an adjunct law professor at the Georgetown University Law Center, teaching a class on Intellectual Property Litigation, Pretrial Skills. He previously served as a faculty member for Patent Resources Group's bi-annual patent bar review course, and as a steering committee member of the Bar Association of the District of Columbia's Patent, Trademark and Copyright Section. Mr. McKee chaired the firm's New Attorney Education program from 2003 - 2009, and remains active as a presenter in that program.

Mr. McKee earned his Bachelor of Science in Industrial Engineering from Iowa State University in 1983, and his Juris Doctor from the National Law Center of George Washington University in 1988. He is admitted to the bars of Virginia and the District of Columbia, and to practice before the Court of Appeals for the Federal Circuit and the Supreme Court of the United States.

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Patent Post-Issuance Proceedings
Patent Prosecution
Trade Dress

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Internet, E-Commerce & Business
Methods



HELEN HILL MINSKER

Attorney

Helen Hill Minsker provides assistance to clients concerning a broad range of issues arising under trademark and unfair competition laws, as well as copyright law. Her experience in these fields of law includes counseling, prosecution and registration of applications before the U.S. Patent and Trademark Office and the U.S. Copyright Office, internet, licensing, enforcement, oppositions and cancellations, and litigation in the courts. Helen also counsels clients in protecting their trademark portfolios internationally.

Helen is active in a number of professional organizations. She has held leadership roles with national and international IP associations, including serving on both the INTA Board of Directors and the AIPLA Board of Directors (as a Board member and as Treasurer). From 2006 - 2009, Helen served on the Editorial Board of the INTA publication *The Trademark Reporter*. Over the years, Helen has chaired various committees for these associations and others, such as the ABA IP Law Section's Committee on Franchising, and she served as co-Chair of INTA's Annual Meeting in Amsterdam in 2003. Helen also was chair of the Bar Association of DC's Patent, Trademark & Copyright Law Section.

Helen received her undergraduate degree (A.B.) in political science from Vassar College, and her J.D. from George Washington University. She also spent a year studying at the London School of Economics and Political Science. She is admitted to the Bar of the District of Columbia Court of Appeals and the Bar of the Supreme Court of Illinois, as well as several courts, including the United States Supreme Court and the Court of Appeals for the Federal Circuit.

From 2001-2011, Helen served as an adjunct professor of law at Georgetown University, where she co-authored and taught a course on intellectual property pretrial litigation skills. She also is a frequent lecturer in continuing legal education programs, and is a former Contributing Editor/Trademarks for the *Federal Circuit Bar Journal*. On the international front, Helen is a member of the European Community Trademark Association (ECTA). Helen was included in "IP Stars - Top 250 Women in IP" in *Managing Intellectual Property* in 2013 and 2014, and recognized as a "World's Leading Trademark Professional" in the *World Trademark Review 1000* in 2012-2015.

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U.S. District Court for the Central
District of Illinois
U.S. District Court for the District of
Columbia
U.S. District Court for the Northern
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Practice Areas

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Copyright
Counterfeit Goods Seizure
Litigation
Trade Dress
Trademarks

Industries

Internet, E-Commerce & Business
Methods



ASEET PATEL

Attorney

Aseet Patel concentrates on patent prosecution and litigation matters primarily in the electrical, computer, and business method arts. He also provides opinion counseling services to clients, including various types of clearance opinions on patents.

Mr. Patel relies on his experience as a former Patent Examiner at the United States Patent and Trademark Office when representing clients in all phases of the prosecution of patent applications. While at the Patent Office, Mr. Patel examined patent applications directed to high technology inventions such as memory devices, RAMs/ROMs, flash memories, caching algorithms, memory partitioning techniques, memory addressing techniques, hard drives, and RAID systems.

Before serving at the Patent Office, Mr. Patel worked as a consultant and programmer for Trilogy Software, Inc. in Austin, TX where he helped develop and deploy multi-million dollar software products for Fortune 500 clients. He is Java Programmer Certified by Sun Microsystems and has developed e-commerce software using HTML, Java server pages (JSP), Java, javascript, relational database technologies, and other web technologies.

At Banner & Witcoff, Mr. Patel has been preparing and prosecuting patent applications for many years in a variety of technology areas, including those relating to electronic circuits, computer hardware and networks, cellular telephones, Internet and e-commerce, business methods, semiconductor processing, and medical devices.

Mr. Patel also has substantial litigation experience. He has represented clients in all aspects of litigation, including pre-trial discovery, witness preparation, depositions, and trial. While representing a major set-top box manufacturer in a multi-patent infringement suit, Mr. Patel used his software expertise to analyze source code in several different programming languages to assess infringement and assisted at the depositions of technology-savvy witnesses. Mr. Patel has also prepared witnesses and exhibits for trial and drafted various court documents.

Mr. Patel earned a B.S. degree in Computer Engineering from the University of Illinois at Urbana-Champaign, where he was the Vice President of the Institute of Electrical and Electronic Engineers (IEEE) student chapter, a Student Senator representing the College of Electrical and Computer Engineering, and the recipient of numerous scholarships. Mr. Patel received his Juris Doctor degree from Loyola University Chicago School of Law. He is admitted to the bar of the State of Illinois and is registered to practice before the United States Patent and Trademark Office.

Mr. Patel was recently recognized in *Lawyers of Color's* "Hot List 2013," an inaugural publication that honors early- to mid-career attorneys from six different regions in the U.S. who have excelled in the legal profession.

Mr. Patel practices in the Chicago office of Banner & Witcoff, Ltd.

[Download the Invention Disclosure Meeting Checklist](#)



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Bar Admissions

2006, Illinois

Court Admissions

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U.S. Circuit Court of Appeals for the
Federal Circuit

Practice Areas

Litigation
Patent Prosecution

Industries

Electrical & Computer Technologies
Internet, E-Commerce & Business
Methods



H. WAYNE PORTER

Attorney

Wayne Porter concentrates his practice in patent prosecution and related counseling, including evaluation of patent infringement and validity issues. He has prepared and prosecuted numerous patent applications in various software, electronic and mechanical fields. His areas of experience include database management, electronic design automation, microprocessor emulation, signal processing, computer input devices and other computer hardware, user interfaces, power conversion and regulation, telecommunications, computer networking, electrical connectors, construction materials, medical devices, manufacturing, and semiconductors. He has substantial experience in design patents, and has also assisted clients in other areas of intellectual property law, including copyrights.

Prior to receiving his law degree, Mr. Porter was employed as a mechanical engineer for the United States Government, where his duties included mechanical design and testing.

Mr. Porter earned a Bachelor of Mechanical Engineering from the Georgia Institute of Technology and a Juris Doctor degree, with *high honors*, from the University of Florida College of Law. While in law school, he was on the board of the *Florida Law Review* and graduated as a member of the Order of the Coif. Mr. Porter is admitted to practice before the U.S. Patent and Trademark Office and in the District of Columbia. Mr. Porter is also a member of the Florida bar and of the American Bar Association.

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Bar Admissions

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Court Admissions

U.S. Patent and Trademark Office
U.S. Supreme Court

Memberships

American Bar Association (ABA)

Practice Areas

Counseling, Opinions & Licensing
Design Patents
Patent Post-Issuance Proceedings
Patent Prosecution

Industries

Electrical & Computer Technologies
Internet, E-Commerce & Business
Methods



CHRISTOPHER J. RENK

Attorney

Chris Renk focuses his practice on litigating patent, trademark, copyright, trade secret, false advertising and unfair competition cases. Chris utilizes a value added approach in his litigation practice and believes that litigation goals should always be defined by each client's business objectives. He is skilled in developing and implementing litigation strategies to fulfill those objectives.

Since joining the firm in 1988, Chris has successfully represented both plaintiffs and defendants as lead and co-counsel in jury trials, bench trials, and appeals. His cases have involved diverse subjects such as computer software, consumer electronics, product designs, electrical controls, internet content delivery, medical and surgical devices, heat transfer, distilled spirits, contact lenses, fuel injection systems, athletic footwear and textiles processing.

In each year from 2010 to 2014, Chris was selected for inclusion in the editions of *The Best Lawyers in America* (click link to view). *Best Lawyers* is considered the oldest and most respected national peer-review publication in the legal profession, and is based on an annual peer-review survey. In each year from 2005 to 2014, Chris was included in *Illinois Super Lawyers*, and was also selected to their Top 100 list featured in *Chicago* magazine in 2005, 2009, 2010 and 2011. Since 2004, Chris has yearly been named to the *Leading Lawyers Network* and in 2010 was profiled in *Leading Lawyers* magazine (click link to view). Based upon peer nominations and approval by the network's Advisory Board, only the top lawyers are nominated and eligible for membership in the *Leading Lawyers Network*. In 2014, Chris was named on the BTI Client Service All-Star Report. Inclusion in this exclusive report is driven solely by direct feedback from in-depth interviews of General Counsels from more than 3,700 large and Fortune 1000 companies. These interviews determine precisely which attorneys top the charts in client service excellence. Law firms and their attorneys have no influence on these rankings.

In addition to his active practice, Chris is a fellow of the American Bar Foundation and is a Member of the Sedona Conference Working Group on Patent Remedies. Chris also serves as an Adjunct Professor of Law at the Georgetown University Law Center and Northwestern University Law School where he teaches Patent Trial Practice and Patent Litigation II. He is a contributing author of the *Patent Litigation Strategies Handbook*, BNA, 2000, *Patent Litigation*, PLI, 2001, and *Patent Trial Advocacy Casebook*, (Third Edition), ABA, 2013. Chris is a frequent speaker on various intellectual property issues, is the author of several articles on intellectual property law, and has been a featured guest on WB's First Business (click link to view), discussing intellectual property piracy in China.

Chris earned his engineering degree from Iowa State University in 1983. Prior to attending law school, he was an engineer at General Dynamics Corporation. He is a 1988 graduate of the University of Minnesota Law School.

Chris is a registered patent attorney and is admitted to practice in Illinois, Minnesota, and the District of Columbia. He also is admitted to practice before the United States Supreme Court, the Court of the Appeals for the Federal Circuit and numerous federal district courts.

Mr. Renk practices in the Chicago office of Banner & Witcoff, Ltd.



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Bar Admissions

1988, Illinois
1990, Minnesota
1991, District of Columbia

Court Admissions

U.S. Supreme Court
U.S. Circuit Court of Appeals for the Federal Circuit
U.S. Court of Appeals for the Fourth Circuit
U.S. Court of Appeals for the Fifth Circuit
U.S. Court of Appeals for the Sixth Circuit
U.S. Court of Appeals for the Seventh Circuit
U.S. District Court for the Central District of Illinois
U.S. District Court for the Northern District of Illinois
U.S. District Court for the Western District of Michigan
U.S. District Court for the Eastern District of Wisconsin
Supreme Court of Illinois
Supreme Court of Minnesota
District of Columbia Court of Appeals
U.S. Patent and Trademark Office

Practice Areas

Appellate Litigation
Copyright
Design Patents
Jury Trials
Litigation
Section 337/ITC Litigation
Trade Dress
Trademarks

Industries

Electrical & Computer Technologies
Internet, E-Commerce & Business
Methods
Medical Devices



PAUL M. RIVARD

Attorney

Paul M. Rivard has extensive experience in counseling in intellectual property matters and in preparing and prosecuting patent applications in the chemical and pharmaceutical arts. His practice focuses on developing and managing worldwide patent portfolios with a view toward meeting his clients' business objectives. Representative technologies include plastics and polymer chemistry, molding and coating technologies, chemical manufacturing, packaging materials, pharmaceuticals, ceramics, composite materials, and agricultural sciences.

Paul handles all phases of patent practice before the U.S. Patent and Trademark Office, including ex parte prosecution, reissue applications, reexamination proceedings, as well as ex parte appeals and contested matters before the Patent Trial and Appeal Board. Recently he successfully defended a patent owner in ex parte reexaminations that had been requested by a patent infringement-defendant. The reexamination decisions were favorably cited by the U.S. Court of Appeals for the Federal Circuit when it reversed a jury verdict of invalidity in the concurrent litigation.

Mr. Rivard also is experienced in preparing technology transfer agreements and has represented clients in intellectual property litigation before the U.S. District Courts and the U.S. Court of Appeals for the Federal Circuit.

Paul is active in the American Bar Association, having authored amicus curiae briefs for the ABA in patent cases before the U.S. Supreme Court, including *KSR v. Teleflex*. Prior to entering private practice, he served as a Patent Examiner in the U.S. Patent and Trademark Office, where he examined applications in the chemical arts.

Paul earned a Juris Doctor, cum laude, from Catholic University in Washington, DC, and a Bachelor of Science in chemical engineering from Clarkson University in Potsdam, New York.

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1998, Virginia
1999, District of Columbia

Court Admissions

U.S. Court of Appeals for the Federal Circuit
U.S. Court of Appeals for the Fourth Circuit
U.S. District Court for the Eastern District of Virginia
U.S. Supreme Court
U.S. Patent and Trademark Office

Practice Areas

Counseling, Opinions & Licensing
Patent Interferences
Patent Prosecution

Industries

Chemistry & Chemical Engineering
Life Sciences & Pharmaceuticals



CHARLES W. SHIFLEY

Attorney

Over a full career, Charles Shifley has concentrated on intellectual property cases and trials. Recently, Charles and a team gained the transfer of an ongoing patent case from the home base of Caterpillar in Peoria to a neutral court in Las Vegas. See 2012 WL 6618602. Earlier counsel had failed in a motion to dismiss from Peoria. Charles and a team also kept the ongoing defense of a motorcycle manufacturer away from risks of a jury by diverting the patent dispute into arbitration. Charles has been succeeding for patent owners in patent post-grant proceedings, putting requesters in situations worse for them than if they had not started proceedings they expected to win for them. See USPTO 95/001600, 95/000437, 95/000467. Charles enjoys juries, avoiding juries, fast-paced efforts, and resolutions that involve allowing others to act and events to occur in their own time. Last year, Charles and a team brought to a settlement a multi-year defense of a large automotive company against patent infringement for duplicating the products of a terminated supplier in 2008. Injunction efforts were defeated and the settlement was less than 6% of the supplier's demand, at one-third the supplier's legal fees. Earlier, Charles avoided litigation altogether by engaging opponents as needed and appropriate, while having third parties have priority and defeat the opponents, and even simply watching as windows of liability closed from passages of time.

In contrast, Charles is skilled in gaining fast relief for clients in difficult situations. Charles and a team brought the urgent enforcement of a patent for a construction industry company to a successful result in eight months, on a patent Charles had gained for the company. See Civil Action No. 4:07-cv-2099 (E.D.Mo.) Charles and teams of lawyers have gained preliminary injunctions on a once-lapsed patent, see 56 USPQ2d 1329, a just-issued patent, see 53 USPQ2d 1547, and a patent in an uncertain market, see 2006 U.S. Dist. LEXIS 4910. Earlier, Charles directed a team of lawyers for an arbitration in the digital video disk and movie industries, within 16 days of notice of arbitration. The arbitration settled on the 16th day, in major part because of the speed and thoroughness of the preparation. Charles also gained two trademark preliminary injunctions, see 48 USPQ2d 1299 and 45 USPQ2d 1846. Similarly, Charles and a team brought the defense of a major instant message provider against a \$160M patent claim to a successful early summary judgment and resulting settlement. See Civil Action 04C4240 (N.D.I.). Charles and a trial team successfully enforced IP rights for a start up company against a multimillion-dollar defense effort. Charles also successfully defended an Internet music delivery company, successfully defended a rail supply company, and successfully ended an offensive case for a pharmaceutical software provider. Charles has gained several other early injunctions and seized counterfeit goods within hours of filing suits and within a day of contact with clients having problems to solve. In a case including a jury trial, Charles and his trial team proved willful patent infringement and had a permanent injunction in place 11 months after filing suit.

Where extended efforts are required, Charles provides them. Charles and a team brought the defense of the automotive industry and the nation's largest automotive supplier to a successful, affirmed summary judgment against patent infringement. See 501 F.3d 1274. Earlier, a trial team under his direction won an affirmed \$6M jury verdict for willful patent and copyright infringement and breach of a shrink-wrap agreement. See 302 F.3d 1334. Charles also won an affirmed multi-million dollar jury award for willful patent infringement and attorneys fees. See 9 F.Supp.2d 601, 1999 U.S. App. LEXIS 8584, and 189 F.3d 1327. Charles and a team brought the defense of a major building systems provider against a \$200M trade secret misappropriation claim through extended arbitration discovery and to a successful settlement. See Civil Action 3:07CV312 (N.D.Tex.). Charles was also co-counsel in a trial defeating patent infringement claims, see 65 F.Supp.2d 757, and defended the judgment on appeal, 56 USPQ2d 1445. Earlier, and at a jury trial, Charles and a team of lawyers won an affirmed permanent injunction and \$1M patent infringement award. See 61 USPQ2d 1152. Charles has also gained an important 7th Circuit trademark decision by appeal, see 362 F3d 986.

Charles has served as lead and co-counsel in numerous successful trials and appeals for Fortune 100 and additional companies, across the country. Technical subjects have included in-building wireless systems; airbag actuation electronics; Internet delivery software; digital video disks; photochemistry; photographic software; engines, electronic components, and automotive hardware; human heart pacemakers and defibrillators; welding equipment; computerized controls; high technology valves; industrial franchise operations; high-technology metal casting and consumer goods. He has generated several large claims for damages, including one for \$30 million based on \$300,000 in accused sales. He has been consistently sensitive to costs and client communication.



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Bar Admissions

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Court Admissions

Supreme Court of Illinois
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U.S. Court of Appeals for the Seventh Circuit
U.S. District Court for the Eastern District of Michigan
U.S. District Court for the Eastern District of Wisconsin
U.S. District Court for the Northern District of Illinois
U.S. District Court for the Central District of Illinois

Practice Areas

Appellate Litigation
Copyright
Counseling, Opinions & Licensing
Jury Trials
Litigation
Patent Interferences
Patent Post-Issuance Proceedings
Trademarks

Industries

Electrical & Computer Technologies
Internet, E-Commerce & Business
Methods
Life Sciences & Pharmaceuticals
Medical Devices

In addition, Charles has also developed capable counseling, negotiation, settlement and patent procurement strategy skills, see USPTO 13/116851, and prepared opinions and gained clients many valuable contracts concerning patents, trademarks, copyrights, trade secrets, and franchises. He is proud to have had a client grow from startup to \$25M in sales in a short time on the strength of its inventions, patents he gained, and patent enforcement suits he successfully pursued. He is also proud to have brought an individual inventor patent license royalties in excess of \$1M, for a single and simpler invention.

Mr. Shifley speaks on patent litigation and related matters, and authors articles espousing critical thinking in handling intellectual property concerns. He has taught pretrial, trial and appellate advocacy at Northwestern University, Georgetown, John Marshall of Chicago, and Chicago Kent Colleges of Law, with Federal Circuit Court of Appeals Chief Judge Paul Michel among others, and taught Law for Engineering Managers at Northwestern for many years. He is currently an Adjunct Professor at John Marshall Law School, Chair of the Amicus Committee of the Intellectual Property Law Association of Chicago, and past President of the Richard Linn American Inn of Court. Charles has represented IPLAC in several U.S. Supreme Court, Federal Circuit and Illinois Supreme Court cases on issues including patent-eligible subject matter, patent damages, jurisdiction, and inequitable conduct. See Supreme Court 11-1118, Federal Circuit 2011-1301, 2011-1363, 2012-1548 and Illinois 112910.

Charles earned a Bachelor of Science degree in Mechanical Engineering, summa cum laude, and a Juris Doctor degree, cum laude, both from The Ohio State University, in his home state.

Mr. Shifley practices in the Chicago office of Banner & Witcoff, Ltd.

JOSEPH M. SKERPON

Attorney

Joseph Skerpon practices in the areas of litigation, interferences, counseling in patent matters, licensing and the preparation and prosecution of patent applications in the chemical and biotechnology arts. Throughout his career, Mr. Skerpon has achieved each client's business objectives by maintaining a close working relationship. This has been particularly evident in his successful resolution of numerous interferences, whether by settlement, on preliminary motion, or through testimony to Final Hearing.

He also has experience in civil litigation following interference proceedings, having protected favorable Patent Office decisions through the district court and the Federal Circuit. In this regard, he helped to define the bounds of raising new issues in an interference appeal when he successfully argued before the Federal Circuit in the case of *G.I. v. Scientific Atlanta*. Mr. Skerpon's patent litigation experience includes both bench and jury trials.

Mr. Skerpon also has a broad patent preparation and prosecution practice with experience in wood and paper technologies, polymers and other organic and inorganic materials, pharmaceuticals, food technology and general chemical processing.

Mr. Skerpon received his B.S. in Chemical Engineering, *cum laude*, from Princeton University in 1975 and his J.D., with *honors*, from the University of Buffalo in 1981. Employed for seven years as a patent liaison, senior chemical engineer for the Linde Division of the Union Carbide Corporation before entering private practice in 1982, he earned invaluable experience working directly with inventors in helping to define their inventive contributions.

Mr. Skerpon is a member of the American Intellectual Property Law Association, the Bar Association of the District of Columbia, the American Bar Association, and is an Adjunct Professor of Law at George Mason University and Johns Hopkins University, teaching in the areas of patent law and biotechnology patent law. Mr. Skerpon is admitted to the bar in New York and the District of Columbia and before the U.S. Court of Appeals for the Federal Circuit and the U.S. District Court of the District of Columbia.

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Bar Admissions

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1983, District of Columbia

Court Admissions

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Circuit
U.S. District Court for the District of
Columbia

Practice Areas

Litigation
Patent Interferences
Patent Prosecution

Industries

Chemistry & Chemical Engineering
Life Sciences & Pharmaceuticals

RICHARD S. STOCKTON

Attorney

Richard Stockton has substantial experience with intellectual property counseling, litigation and prosecution matters.

He provides tactical and strategic advice to clients based on a broad range of experience stemming from large and small patent, copyright and trademark litigations, preparation of opinions, prosecution work, general counseling and the management of portfolios, including a portfolio with more than 2000 properties.

With regard to prosecution, he has obtained more than 1000 US design patents, trademark registrations, copyright registrations and utility patents for clients. Richard writes and presents on various intellectual property topics, from basic trademark and America Invents Act overviews to detailed assessments of ICANN's generic top level domain liberalization and the Hague System for international design registration.

Internationally, Richard manages thousands of intellectual properties in more than 70 foreign jurisdictions, has experience with mass multi-jurisdictional transfers of properties between entities, and has visited more than 70 countries.

Richard earned a Bachelor of Science degree in Electrical Engineering from the University of Illinois at Urbana-Champaign in 1997, where he was a member of the Mortar Board, Eta Kappa Nu, Knights of St. Patrick and Senior 100 honor societies.

Richard graduated, *cum laude*, from the University of Illinois College of Law in 2000, where he was the Editor-in-Chief of *The University of Illinois Journal of Law, Technology & Policy* and the Legislation Editor of the Illinois Law Update section of *The Illinois Bar Journal*. He participated in the Giles S. Rich Intellectual Property Moot Court competition, was a founding editor of *Modern Trends in Intellectual Property* and received a Rickerts award.

Richard continues his involvement with the University of Illinois as a member of the Athletic Board and as a member of the President's Council, Chancellor's Circle and Cribbet Society. He also served on the Board of Visitors for the College of Law, Board of Directors of the University of Illinois Law Alumni group, and was a member of the Campus Alumni Advisory Board. He has also volunteered for the Division of Intercollegiate Athletics and the Illinois Imprint leadership program, has mentored dozens of students, and regularly returns to campus to discuss careers in patent law.

In 2012, Northwestern University School of Law appointed Richard as an Adjunct Professor, where he co-teaches "Intellectual Property Pre-Trial Litigation Skills." Richard taught the same course as an Adjunct Professor at Georgetown University Law Center from 2005-2011. He also serves on the Midwest Coordinating Committee for the INTA-sponsored Saul Lefkowitz Trademark Moot Court Competition, and has been a panelist, moderator or speaker at the University of Illinois College of Law, Northwestern University School of Law, Chicago-Kent College of Law and The John Marshall Law School. Richard is also a co-chair of the Technology for the Litigator committee of the American Bar Association's Section of Litigation.

Richard also has experience with governmental relations. He has drafted legislation for members of the Illinois General Assembly, including P.A. 91-778, which substantially amended the University of Illinois Board of Trustees Act. Richard also interned for a Congressman in Washington D.C. and served as a legislative extern to the Illinois House of Representatives.

Richard has been named an "Illinois Super Lawyers Rising Star," which touts the state's top 2% of up-and-coming attorneys under the age of 40.

Richard is admitted to the Illinois State Bar and is also admitted to practice in the U.S. Patent and Trademark Office as a registered patent attorney. He is a member of the American Bar Association, Illinois State Bar Association, International Trademark Association and the American Intellectual Property Law Association.

Richard practices in the Chicago office of Banner & Witcoff, Ltd.



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Bar Admissions

2000, Illinois

Court Admissions

U.S. District Court for the Northern
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U.S. Patent and Trademark Office

Practice Areas

Copyright
Counterfeit Goods Seizure
Design Patents
Litigation
Trade Dress
Trademarks

Industries

Electrical & Computer Technologies
Internet, E-Commerce & Business
Methods



J. PIETER VAN ES

Attorney

Pieter van Es has over twenty years of experience in intellectual property enforcement, counseling and procurement. He has worked on matters involving patent, trademark, trade dress, copyright, trade secret and antitrust issues.

Pieter has handled intellectual property disputes in trials and preliminary injunction hearings, conducted complex discovery and briefed successful motions and appeals. His experience has ranged from ex parte seizures of counterfeit goods to advantageous settlement of disputes in court supervised settlement hearings. He has procured and licensed patents and trademarks for clients in a wide variety of fields. The subject matter of his work has included electronic sensors and monitors, medical and diagnostic devices, audio electronics, telecommunications equipment, lighting fixtures, internet content delivery networks, processed food, healthcare products, sporting goods and software.

Pieter has been selected as an "Illinois Super Lawyer" nearly every year since 2005. The Super Lawyers list represents the top 5% of Illinois lawyers, as chosen through a peer balloting process involving 47,000 lawyers from across Illinois, and through a research and review panel organized by *Law & Politics* magazine. *Law & Politics* asked the attorneys to name the best lawyers they personally observed in action.

Pieter recently taught intellectual property litigation as an adjunct professor of law at Northwestern Law School in Chicago and the Georgetown University Law Center in Washington, D.C. He earned a Bachelor of Science degree in Electrical Engineering and a Bachelor of Arts degree in Economics both from the University of Illinois at Urbana-Champaign in 1989. He graduated, *magna cum laude*, from the University of Illinois College of Law in 1992.

Pieter is a registered patent attorney and is admitted to practice in the states of Illinois and California. He also is admitted to practice before the Court of the Appeals for the Federal Circuit, numerous other federal courts and the Illinois Supreme Court. He practices out of the Chicago office of Banner & Witcoff, Ltd.



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Education

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J.D. 1992, University of Illinois

Bar Admissions

1992, Illinois
2007, California

Court Admissions

Supreme Court of Illinois
U.S. Court of Appeals for the Federal Circuit
U.S. Court of Appeals for the Fifth Circuit
U.S. Court of Appeals for the Ninth Circuit
U.S. Court of Appeals for the Seventh Circuit
U.S. District Court for the Northern District of Illinois

Practice Areas

Jury Trials
Litigation
Patent Post-Issuance Proceedings
Section 337/ITC Litigation
Trademarks

Industries

Electrical & Computer Technologies
Internet, E-Commerce & Business
Methods



BRADLEY J. VAN PELT

Attorney

Brad Van Pelt concentrates on litigation, prosecution, and counseling in all areas of intellectual property. Brad has wide-ranging experience in prosecution and counseling. He has years of patent drafting experience in the mechanical, software, and business method arts. He frequently prepares freedom-to-practice opinions, and has served on successful patent litigation teams in obtaining favorable rulings for clients. In addition to his utility patent practice, Brad also has extensive experience in procuring design patents and is active in the design patent bar. He was also named to the 2014 Illinois Super Lawyers Rising Stars, which include only the top 5 percent of attorneys in the state.



Brad assists clients with creative strategies in developing strong patent portfolios both domestically and internationally. Brad leverages his experience as a former examiner to creatively advance applications to grant. He has also presented at numerous conferences on creative strategies in advancing applications and development of prosecution strategies in light of the America Invents Act.

Brad has prepared and prosecuted software-oriented applications directed to security, networking, audio monitoring, cash handling devices, business methods, and graphical user interfaces and mechanical applications directed to merchandizing systems, transducers, microphones, earbuds, medical devices, insulation devices, sporting equipment, composite materials, container handlers, and dispensers.

Prior to his role at Banner & Witcoff, Brad was a patent examiner at the U.S. Patent and Trademark Office in the early 2000s. While at the Patent and Trademark Office, Brad examined patent applications directed to the mechanical arts, especially in the automotive, transportation, and power generation arts. Brad served in the chambers of the Honorable Richard Linn of the United States Court of Appeals for the Federal Circuit, which hears all patent appeals in the United States. Brad was also a design engineer for Sub-Zero Freezer Company where he designed testing equipment for digital refrigeration components and software.

He earned his undergraduate degree in Mechanical Engineering from the University of Wisconsin-Madison in 2002. He was awarded his J.D. degree from Georgetown University in 2007.

Brad is registered to practice before the U.S. Patent and Trademark Office, and is admitted to practice in Illinois. Brad practices in the Chicago office of Banner & Witcoff, Ltd.

Presentations

- "The Total User Experience: Improving the Content and Quality of Your Company's Patent Application Post-AIA" at Witcon, Banner & Witcoff's Corporate Intellectual Property Seminar in 2014
- "The Total User Experience: Improving the Content and Quality of Your Company's Patent Application Process Post-AIA" at the MIP conference in DC in 2014
- "Two Sides of Patents: Getting Stronger Patents for Your Company and Alternative Ways to Defend Against Patent Litigation." At the ACC Chicago CLE Program in Rosemont, IL and in Chicago, IL in 2014
- "The Total User Experience: Improving the Content and Quality of Your Company's Patent Application Process Post-AIA" in a Banner & Witcoff and BNA webinar in 2013
- "Emergency IP: Expediting the Granting of Patent Rights" at Banner & Witcoff's Corporate Intellectual Property Seminar in 2012

Articles

"AIA Toolbox: Intake, Checklists, and Faster Drafting Techniques," IP Update, Fall/Winter 2014

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Bar Admissions

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Court Admissions

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Practice Areas

Copyright
Counseling, Opinions & Licensing
Litigation
Patent Prosecution
Trademarks

Industries



WILLIAM E. WOOTEN

Attorney

William Wooten maintains a comprehensive intellectual property practice, with an emphasis on prosecution, litigation, and counseling in patent matters. He has prepared and prosecuted numerous patent applications directed to a wide range of technologies, including computer software and hardware, near field communication, medical imaging, telecommunications, and business methods. Mr. Wooten works with a diverse base of clients, including members of the Fortune 500, startups, universities, and individual inventors.

Mr. Wooten earned his B.S. in Computer Science, *summa cum laude*, at North Carolina State University and his J.D. with honors at the University of North Carolina School of Law, where he was a staff member of the *North Carolina Law Review* and the *North Carolina Journal of Law & Technology*. Prior to attending law school, Mr. Wooten served as an officer in the United States Navy and worked in information technology for an aerospace wire manufacturer. Mr. Wooten is admitted to the State Bar of North Carolina and is registered to practice before the United States Patent & Trademark Office.

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Education

J.D. 2010, University of North Carolina
B.S. 2004, North Carolina State
University

Bar Admissions

2010, North Carolina
2013, District of Columbia

Court Admissions

U.S. Patent and Trademark Office
U.S. Supreme Court
U.S. District Court for the Eastern
District of North Carolina

Practice Areas

Counseling, Opinions & Licensing
Litigation
Patent Prosecution

Industries

Electrical & Computer Technologies
Internet, E-Commerce & Business
Methods
Medical Devices



BRADLEY C. WRIGHT

Attorney

Brad Wright concentrates on prosecution, litigation and counseling in patent and copyright matters, especially in the electrical and computer areas, including Internet and e-commerce. He has drafted and prosecuted numerous patent applications in such technologies as computer hardware and software, cable TV systems, electrical devices, facsimile systems, neural networks, smart cards, Internet applications, operating systems, computer games, business methods, mobile telephones, and video processing techniques. In 2010, two patents drafted by Mr. Wright were successfully asserted in litigation, resulting in a \$200 million settlement.

Brad has also won several appeals before the Board of Patent Appeals and Interferences. He represents clients in district court litigation including patent, copyright and trademark matters. He has also successfully argued and briefed appeals before the U.S. Court of Appeals for the Federal Circuit. He has also provided clients with infringement, validity and patentability opinions in numerous different technical areas. Additionally, Brad is experienced with protecting inventions overseas under patent treaties and conventions.

Mr. Wright is a former law clerk to the Honorable William C. Bryson of the Court of Appeals for the Federal Circuit, which hears all patent appeals in the United States. He earned his electrical engineering degree from the Massachusetts Institute of Technology and his law degree, with *distinction*, from George Mason University, where he graduated as the top student in the Patent Law Track and was a member of the Law Review. After earning his electrical engineering degree, Brad worked as an electrical engineer and software engineering manager for E-Systems, which is now part of Raytheon Corp. In that position, Brad developed novel algorithms relating to signal intelligence and specialized hardware, and worked on database projects including an object-oriented database.

Mr. Wright is registered to practice before the U.S. Patent and Trademark Office. He is admitted to the bars of the Supreme Court, the Court of Appeals for the Federal Circuit, and is a member of the Virginia and District of Columbia bars. Brad is also active in the American Intellectual Property Law Association, where he co-chaired the Software Patent Subcommittee of the Emerging Technologies Committee. He is also a member of the Institute of Electrical and Electronic Engineers and the American Bar Association, where he chaired subcommittees relating to business method patents, patent litigation, and multimedia and interactive technology. Additionally, Brad has been an adjunct professor of law at George Mason University School of Law, where he has taught copyright and patent law.

Mr. Wright was the President of the Patent Lawyers Club of Washington. He has published numerous articles and has given speeches before various organizations regarding intellectual property law.

Mr. Wright served as Editor-in-Chief and a chapter author of *Drafting Patents for Litigation and Licensing*, published by BNA Books in 2008. This book, the first of its kind, was written to help patent practitioners draft the broadest possible patent that can sustain a validity challenge by synthesizing and applying lessons from the case law.

Mr. Wright has earned an AV Preeminent® peer review rating and was selected by Martindale-Hubbell as a 2013 Top Rated Lawyer in Appellate Law. Mr. Wright was selected to the Washington D.C. *Super Lawyers* list in 2014, and was named one of the World's Leading IP Strategists by *Intellectual Asset Management* magazine. He is listed as a leader in intellectual property law in the 2015 edition of *Best Lawyers in America*. He is recognized by *Managing Intellectual Property* as a 2014 IP Star.

Mr. Wright practices in the Washington, DC office of Banner & Witcoff, Ltd.

Sample Articles and Publications

"Functional Claiming," presented at the *2014 9th Annual Advanced Patent Law Institute* (January 23-24, 2014)

"Developments in Patent Law 2013," presented at *The D.C. Bar's 2013 IP Law Year in Review Series* (December 11, 2013)

"Patent Developments for IT Practitioners," presented at the *2012 Virginia Information Technology Legal Institute* (September 28, 2012)

"Developments in Patent Law," presented at John Marshall Law School's *56th Anniversary Conference*



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Education

B.S.E.E. 1984, Massachusetts
Institute of Technology
J.D. 1994, George Mason University

Bar Admissions

1994, Virginia
1995, District of Columbia

Court Admissions

U.S. Circuit Court of Appeals for the
Federal Circuit
U.S. Court of Appeals for the Fourth
Circuit
U.S. Court of Appeals for the Sixth
Circuit
U.S. District Court for the District of
Columbia
U.S. District Court for the Eastern
District of Virginia
U.S. Patent and Trademark Office
U.S. Supreme Court

Practice Areas

Appellate Litigation
Copyright
Litigation
Patent Prosecution

Industries

Electrical & Computer Technologies
Internet, E-Commerce & Business
Methods

on *Developments in Intellectual Property Law* (February 24, 2012)

"Developments in Patent Law 2011," presented at *The D.C. Bar's 2011 IP Law Year in Review Series* (December 13, 2012)

"Patent Developments for IT Practitioners," presented at the *2011 Virginia Information Technology Legal Institute* (September 23, 2011)

"Drafting Patents for Litigation and Licensing, with 2011 Cumulative Supplement," *BNA and ABA-IPL* (August 1, 2011)

"Functional Claiming and Functional Disclosure," *Banner & Witcoff IP UPDATE* (Spring/Summer 2011)

"Developments in Patent Law 2010," presented at *The D.C. Bar's 2010 IP Law Year in Review Series* (December 15, 2010)

"Patent Developments for IT Practitioners", presented at the *2010 Virginia Information Technology Legal Institute* (October 8, 2010)

"Supreme Court Eases Test for Patentability in *Bilski v. Kappos*," *Intellectual Property Advisory* (June 28, 2010)

"Recent Developments in IP Law", presented at John Marshall Law School's *54th Annual Conference on Developments in Patent, Trademark, Copyright and Trade Secrets Law* (February 26, 2010)

"Developments in Patent Law 2009," presented at *The D.C. Bar's 2009 IP Law Year in Review Series* (December 18, 2009)

"Supreme Court Hears Argument in *Bilski* Case," *Intellectual Property Advisory* (November 9, 2009)

"Supreme Court Grants Cert in *Bilski* Case," *Banner & Witcoff IP UPDATE* (November 1, 2009)

"Federal Circuit Issues Split Decisions on PTO Continuation Rules," *Banner & Witcoff IP UPDATE* (Spring/Summer 2009)

"Developments in Patent Law," presented at *The D.C. Bar Program on Developments in Intellectual Property Law* (December 2008)

"End of the Road for E-Commerce Patents?," *E-Commerce Times* (May 2008)

"Patents Under Attack," *Executive Counsel* (June 2008)

"Federal Circuit May Clamp Down on Process Patents," *Intellectual Property Advisory* (May 8, 2008).

Recent Speaking Engagements

"Patent Developments for IT Practitioners," 2012 Virginia Information Technology Legal Institute, Falls Church, VA, September 28, 2012.

"Recent Developments in Patent Law," John Marshall Law School's 56th Intellectual Property Law Conference, Chicago, IL, February 24, 2012.

"The Corporate Response to New Legislation: Changes in Portfolio Development and Patent Defense Strategies," 2012 Advanced Patent Law Institute at the USPTO, Alexandria, VA, January 19, 2012.

"The New Patent Law and More," DC Bar's IP Year in Review Series, Washington, DC, December 13, 2011.

"IP Basic Training Series: Patents, Trademarks, and Copyrights," D.C. Bar Conference Center, Washington, DC, October 18, 2011.

"Patent Developments for IT Practitioners," 2011 Virginia Information Technology Legal Institute, Falls Church, VA, September 23, 2011.

"Recent Developments in Patent Law," John Marshall Law School's 55th Intellectual Property Law Conference, Chicago, IL, February 25, 2011.

"Functional Claiming and Functional Disclosure," University of Texas at Austin, School of Law's 6th Annual Advanced Patent Law Institute, Alexandria, VA, January 21, 2011.

"Recent Developments in Patent Law," D.C. Bar's 2010 IP Year in Review Series, Washington, DC, December 15, 2010.

"Patent Developments for IT Practitioners," 2010 Virginia Information Technology Legal Institute, Falls Church, VA, October 8, 2010.

"Patentable Subject Matter After Bilski," BNA Webinar, July 8, 2010.

"The Use of Opinion of Counsel as Evidence in Patent Litigation," ABA IPL Section's 25th Annual Intellectual Property Law Conference, Arlington, VA, April 9, 2010.

"Recent Developments in IP Law," John Marshall Law School's 54th Annual Conference on Developments in Patent, Trademark, Copyright and Trade Secrets Law, Chicago, IL, February 26, 2010.

"Recent Developments in Patent Law," D.C. Bar's 2009 IP Year in Review Series, Washington, DC, December 17, 2009.

"Developments in Patent Law, 2008," D.C. Bar's 2008 IP Year in Review Series Part II, Washington, DC, December 10, 2008.

"New Practical Patent Strategies," Virginia Information Technology Center, Waterford, VA, September 26, 2008.



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