



## Patent

### Patent Procurement and Portfolio Management

Hinshaw has highly experienced and skilled attorneys with varied technical backgrounds including chemistry, chemical engineering, computer science, electrical engineering and mechanical engineering. Our patent procurement and portfolio management practice helps clients identify, establish, enforce and obtain value from their United States and foreign patents. Unlike some large-firm “prosecution mills,” our group is small enough to provide dedicated personalized representation. Consequently, we become familiar with our client's business and its existing and future product fields. This understanding helps our client expend resources on patent portfolio development in a cost-effective manner. The result is increased long-term value for our client and its shareholders and customers.

Hinshaw lawyers have substantial expertise in numerous technical areas. Some specific areas include: batteries; blasting formulations; electronic devices, including compact fluorescent lamps; microprocessors; semiconductors; solar cells; coatings (including CVD, sputtered, and electromagnetic); contact lens solutions; food and beverage technologies; medical devices and methods, including contact lenses, blood storage, orthotic and prosthetic devices, drugs, wound dressings, synthetic blood, surgical equipment; organic chemistry; software and hardware for many types of industries; wireless mobile sensing systems; cellular routers and gateways; cargo tracking; and network edge platforms.

### Transactions

Hinshaw is active in providing a full range of intellectual property advice to clients. Our intellectual property practice includes preparing and negotiating contracts, including license and asset purchase, contract manufacturing, distributing, product development and joint venture agreements.

Hinshaw's intellectual property attorneys have substantial experience in all aspects of intellectual property mergers and acquisitions, including due diligence and risk evaluation and validity, infringement and enforceability aspects.

### Freedom to Practice, Design Around

When a company expects to introduce a new product or service, it is valuable to identify and address any patent problems before launch, especially for key products. Our lawyers are available to evaluate that product or service against the existing patent landscape and render advice, and if desired, a formal freedom to practice. Our specialized knowledge and experience enables us to efficiently evaluate the matter, and if needed, develop design alternatives or find any invalidating prior art.

### Service Area Contact

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### Related Services

Copyright  
Technology  
Trade Secrets  
Trademark



## America Invents Act

Our in-depth understanding of the first-to-file America Invents Act of 2011 (AIA) allows us to better position our clients now and in the future. The advent of increased Patent Office-based hybrid prosecution/litigation procedures to either potentially strengthen or attack a third party's patents plays into our deep understanding of both patent prosecution and litigation. These AIA-based proceedings include *ex parte* and *inter partes* proceedings. Patent owners have three potential options of strengthening an existing patent: *ex parte* reexamination, patent reissue and supplemental examination. Patent challengers have a total of four options: *ex parte* reexamination, post-grant review, *inter partes* review, and derivation (or interference for some patents) proceedings. Our attorneys advise clients on the advantages and availability of each type of proceeding, and then we implement the desired strategy.

## Intellectual Property Litigation

### Infringement, Validity and Other Evaluations

Before filing suit or before determining a proper litigation strategy, it is important to identify and evaluate infringement and other issues relating to patent invalidity and enforceability. Our intellectual property lawyers are highly skilled in all of these areas. An objective and properly conducted evaluation provides a solid basis and foundation for future action, which is always the best strategy for a successful business.

### Trolls

We handle these types of cases efficiently for our clients using techniques we have developed through our past successful representations. Our attorneys also have had great success in representing our clients against litigious nonpracticing patent entities or trolls. For example, we represented an online retailer in responding to threats made by a variety of trolls. Often, we have persuaded the troll to not file suit against our client, with no payment to the troll. In a case where our client was sued, we successfully sought indemnification from its software vendor, allowing our client to avoid a costly waste of time and resources. We also recently settled another litigious patent holder case on very favorable terms early in the case after reviewing its other license agreements and raising new and unique defenses for our client.

### Our Approach

Where litigation becomes necessary, as sometimes happens, our team of litigators — which has handled litigation matters in numerous technologies in district courts around the country — provides skilled counsel. This trial experience bolsters our clients' negotiating positions.

Hinshaw has extensive patent infringement litigation experience, including in jury trials and appeals. We have successfully represented both patent holders and accused infringers, ranging in size from individuals to Fortune 100 companies. Our depth of experience in these areas provides a comprehensive understanding of the patent litigation process and how to attack (or defend) patents in litigation. Having seen patent infringement issues from every conceivable angle, we can objectively view and evaluate patent disputes. We are able to understand our opponent's likely goals and strategies as well as reasonable outcomes under the particular circumstances of a case.

More specifically, our attorneys defended the accused infringers in a successful two-week jury trial and appeal that resulted in the invalidity or unenforceability of all four asserted patents. Our attorneys defended another client in a successful two-week jury trial resulting in an award of damages that was five percent of what plaintiff sought at trial. We represented a plaintiff asserting breach of a license agreement and patent infringement claims in a three-week arbitration hearing resulting in a favorable settlement when defendants called asking to settle the night before the arbitrators were to rule. We represented a patent holder in a declaratory judgment action brought by Oracle, which settled for eight figures on the eve of trial.

Although we can handle a patent infringement case all the way through to a successful trial and appeal, we recognize that this is not usually our client's most desired strategy. We therefore work with our client to ensure that it accomplishes its business goals, whether the matter at hand is litigation, licensing or other counseling.



An adverse result in an intellectual property litigation case can mean the difference between remaining a going concern and going out of business. We understand that litigation is nothing to leave to chance. We provide our client with the client service and practical, bottom-line focus customary of an intellectual property boutique law firm, and the experience that comes from a multidisciplinary national law firm that has handled large-scale patent litigation cases for some of the world's leading companies.

Our experience and approach — unlike that of many other law firms with a patent litigation practice — does not entail turning over every rock and digging into side issues that unnecessarily drive up the cost of litigation. Rather, we focus on the issues that matter and strive to keep both the court and the opposing party on track to an expeditious and efficient resolution.

#### Comprehensive Representation — From Start to Finish

We handle all aspects of patent litigation, from the inception of the claim to its ultimate conclusion, whether by means of a settlement, mediation, verdict, or appeal to the U.S. Court of Appeals for the Federal Circuit or the U.S. Supreme Court. As members of a national law firm, our patent litigators can tap into the firm's multidisciplinary resources when our clients are confronted with unique issues that fall outside the traditional patent law setting. As necessary, our Appellate Practice attorneys can provide trial-level legal assistance to prepare dispositive and other pretrial motions, craft jury instructions, and develop post-trial motions to strengthen our clients' position in the event of an appeal. Where defending or prosecuting an appeal becomes necessary, our patent litigators and appellate lawyers collaborate to provide legal representation tailored to our client's business goals, the patent at issue and the unique appellate process.

#### Hinshaw's Experience

Hinshaw's patent litigation attorneys have litigated patents involving numerous technologies, including computer software, consumer products, electronics, hardware, industrial products, and medical devices.

We have handled patent litigation across the United States. Given our strategic office locations throughout 11 states and London, we frequently are able to provide local counsel, no matter where the court is located. We are extensively experienced and have handled trial litigation in jurisdictions that see some of the highest volumes of patent cases, including California, Delaware, Illinois, Texas (including the Eastern District of Texas), and Wisconsin (including the Western District of Wisconsin).

In addition to representing clients in U.S. district courts across the country, we have appeared before the U.S. Court of Appeals for the Federal Circuit numerous times and have patent litigation experience before the U.S. Supreme Court.

## Experience

### Patent Litigation Matters

#### Computer Software

- Represented patent holder in litigation involving patents relating to internet website software. Obtained settlement on eve of trial.
- Represented accused infringers in litigation brought by a nonpracticing entity involving a patent relating to video game software. The federal district court held the patent unenforceable for inequitable conduct after a bench trial.
- Represented accused infringer in litigation brought by a nonpracticing entity involving a patent relating to live chat software.

#### Consumer Products

- Represented patent holder in litigation involving a patent relating to rodent glue traps. The jury in the federal district court trial returned a verdict of willful infringement.
- Represented patent holder in litigation involving a patent relating to rodent bait stations.



- Represented accused infringer in litigation involving a patent relating to cash boxes.
- Represented accused infringer in litigation involving a patent relating to ice fishing shelters.

#### Electrochemical

- Represented patent holder in international arbitration involving patents relating to nickel metal hydride batteries. After a three-week arbitration hearing and extensive post-hearing briefs, the case settled.

#### Electronics

- Represented accused infringer in litigation involving patents relating to television tuners.
- Represented party as both patent holder and accused infringer in litigation involving patents relating to CRTs.

#### Hardware

- Represented party as both patent holder and accused infringer in litigation involving patents relating to RAID memory systems.
- Represented party as both patent holder and accused infringer in litigation involving patents relating to DRAMs.
- Represented accused infringers in litigation involving patents relating to controllers for USB drives.

#### Industrial Equipment

- Represented patent holder in litigation involving a patent relating to lime-calcining equipment used in the mining industry.
- Represented patent holder in litigation involving a patent relating to tertiary rock-crushing equipment.
- Represented patent holder in litigation involving a patent relating to multiple spindle machines.
- Represented patent holder in litigation involving a patent relating to recycling/baler equipment.

#### Industrial Products

- Represented accused infringers in litigation involving four patents relating to specialty canola oil. Two of the patents were invalidated on summary judgment and the federal district court held the other two patents unenforceable due to inequitable conduct after a jury trial. The Federal Circuit affirmed.
- Represented accused infringer in litigation involving patent infringement and tortious interference claims relating to polymer films. The case settled after a jury trial in which the jury awarded the patent holder \$2 million, after it had argued for \$40 million.
- Represented accused infringer in litigation involving a patent relating to aluminum alloys used for airplane fuselage. Settled prior to taking of discovery.
- Represented patent holder in declaratory judgment litigation involving patents relating to vertical flooded heat exchangers installed in hospitals.

#### Medical

- Represented accused infringer in litigation involving patents relating to RFID wander monitor products used to detect and prevent the elopement of dementia patients. Following a trial to the federal district court, obtained a finding and judgment of noninfringement. The Federal Circuit affirmed. After two further appeals by the patent holder to the U.S. Supreme Court and two subsequent remands to the Federal Circuit, the noninfringement judgment was upheld.
- Represented patent holder in litigation involving patents relating to computer-controlled RFID infant security systems with alarming band technology.
- Represented patent holder in litigation involving a design patent relating to ear cures used by pediatricians.



## News

Patrick Patras Discusses Benefits to IP Owners of Patents Found Invalid But Revived by a Settlement  
January 13, 2016

David H. Levitt Honored as Immediate Past President of Illinois Association of Defense Trial Counsel  
June 27, 2015

Hinshaw & Culbertson LLP Adds Comprehensive Patent Prosecution and Intellectual Property Practice from Ryndak & Suri LLP  
January 14, 2014

## Events

Jeffrey Dixon, Alan Kaufman, Russell Klingaman, Roger Masson and Jane Schlicht to Present at NBI Advanced Intellectual Property Law Program  
December 1, 2014

Ambrose McCall and Mark Suri to Present on New Business Employee Issues on Social Media and Computer Fraud at the 2014 IESBGA Conference  
May 29, 2014  
Normal, Illinois

Hinshaw Attorneys to Present on Joint Development Agreements and Protecting Intellectual Property  
May 15, 2014  
National (Webinar)

## Publications

Three Recent Cases Make It Easier to Establish Liability for Multiparty Patent Infringement  
September 2, 2015  
Intellectual Property Update

U.S. Supreme Court Maintains Prohibition on Post-Patent Expiration Accrued Royalties  
June 24, 2015

Supreme Court Decision Leaves Patent Law on Divided Infringement in Flux  
June 24, 2014  
Intellectual Property Update

U.S. Supreme Court Liberalizes the Award of Attorney Fees in Patent Cases  
May 9, 2014  
Intellectual Property Update

Federal Circuit Holds That Non-Practicing Entity May Obtain a Preliminary Injunction  
April 30, 2014  
Intellectual Property Update

Failure to Comply With Fee-Sharing Agreement Rules Results in Loss of Fee  
April 30, 2014  
Lawyers for the Profession® Alert

U.S. Supreme Court Narrows Federal Jurisdiction For Malpractice Actions Arising out of Federal Patent Issues  
February 21, 2013  
Lawyers for the Profession® Alert

The America Invents Act Affects Patent Litigation, Too!



October 6, 2011  
Intellectual Property Update

U.S. Supreme Court Maintains Clear and Convincing Evidence Standard of Proof for Patent Invalidity  
June 24, 2011

Intellectual Property Update

U.S. Supreme Court Raises Knowledge Bar For Inducing Patent Infringement  
June 16, 2011

Intellectual Property Update

Federal Circuit Reins in Patent Inequitable Conduct Law  
June 2, 2011

Intellectual Property Update