

BRINKS
GILSON
& LIONE
100 YEARS OF IP LAW



LYLE VANDER SCHAAF SHAREHOLDER

Lyle began his career on IP cases representing small companies defending themselves against Fortune 500 corporations in “bet the company” type ITC proceedings and learned early on how important it is to provide a strong, tireless defense in order for his clients to prevail. He still brings an impassioned tirelessness to all his clients’ cases - as if their problems were his own. And, he hates to lose.

Lyle is the managing partner of the firm’s Washington, D.C. office. He has an active practice in investigations before the U.S. International Trade Commission (ITC) and their parallel proceedings in Federal Court, covering alleged patent infringement, trademark infringement, copyright infringement, trade secret misappropriation and other alleged unfair practices in import trade. He served in the Office of General Counsel of the ITC from 1991 to 1996 and was detailed to the Office of Chairman Watson in 1994.

Outside of his ITC practice, Mr. Vander Schaaf has an active practice combating counterfeiting of clients’ products, licensing clients-IP, litigating in federal courts, counseling clients on data privacy and cyber-security issues, and conducting antidumping / countervailing duty and customs matters for international trade clients.

In addition to appearing on numerous panels in the United States and abroad, Lyle has provided numerous presentations on IP and international trade matters and has authored numerous articles on various IP, ITC and international trade subjects. He has been quoted numerous times in *Bloomberg*, the *Washington Post*, *Managing IP*, the *LA Times*, *Law360* and *China Intellectual Property News* and appeared on Bloomberg TV.

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EDUCATION

J.D.,
American University Washington
College of Law, 1988

B.A., Liberal Arts, with Honors
The University of Iowa, 1985

BAR ADMISSIONS

District of Columbia
Maryland
Supreme Court of the United
States
U.S. Court of Appeals, Dist. of
Columbia
U.S. Court of Appeals, Fed. Cir.
U.S. Court of International Trade
U.S. Dist. Court, E.D. Michigan

Lyle focuses his practice on the ITC and studies all of its decisions. He has anticipated the changes that have occurred over the past several years in the ITC so that his clients were able to successfully maneuver through the agency's changing proceedings. He is never afraid to challenge how other attorneys bring matters before the ITC.

EXPERIENCE | OVERVIEW

Lyle's background suits him well to defend clients in ITC Section 337 IP proceedings. On behalf of three small importers, Lyle stood up to the world's largest manufacturer of bearings and prevailed in the ITC, and then prevailed when the losing party appealed to the U.S. Court of Appeals for the Federal Circuit and then succeeded in defending against a *certiorari* petition in the U.S. Supreme Court. Lyle also has fought against one of the world's largest heavy equipment manufacturers that sought in the ITC to exclude his small clients' imports of heavy equipment. His steadfast defense did not diminish all the way to the eve of trial when the opposing party sought settlement on terms acceptable to his clients. Lyle was also fundamental to the defense of the firm's clients who were in a hard-fought skirmish against one of their key competitors at the ITC. The clients prevailed on all but one claim of one patent (out of a total of 96 claims in 6 patents) and then designed-around that claim. Lyle's experience before the ITC helped the clients prevail in an enforcement proceeding at the ITC (the first ever such victory for a respondent), proceedings before U.S. Customs and Border Protection, appeals to the U.S. Court of International Trade and finally in an emergency appeal to the U.S. Court of Appeals for the Federal Circuit. Ultimately, none of the clients' imports were excluded from the market. More recently, Lyle was key to the success of a client in China that was sued on four separate occasions in the ITC and prevailed in all four cases – and any appeals that ensued in the Federal Circuit.

EXPERIENCE | OVERVIEW

Lyle formerly worked in the Office of the General Counsel of the ITC and was detailed for a time to the then-Chairman's Office and, from this experience, he provides an insider's perspective to how the ITC will decide a case. Having worked on Section 337 IP proceedings and antidumping/countervailing duty trade proceedings inside the ITC, he now provides his insights as an insider to win cases on behalf of his clients at the ITC. Since leaving the ITC, Lyle has worked on numerous Section 337 proceedings covering patent infringement, copyright infringement, trademark infringement, trade secret misappropriation and other unfair practices in import trade. Since working on a Section 337 proceeding in 1988 as a first-year associate, he has handled over 40 Section 337 proceedings either inside the ITC or in private practice representing clients before the agency.

Lyle has an in depth understanding of all facets of ITC proceedings, including the Commissioners' review phase of the ALJ's initial determination, the Presidential review phase before the Office of the U.S. Trade Representative (USTR), the enforcement phase before the ITC, and the customs enforcement phase before U.S. Customs and Border Protection

(CBP). Throughout his career, Lyle has worked on numerous matters before the USTR, CBP and the U.S. Department of Commerce (DOC). He has handled over 25 cases before the U.S. Court of International Trade on customs, IP and international trade matters stemming from decisions of CBP, the DOC or the ITC. He also has argued five cases before the U.S. Court of Appeals for the Federal Circuit, which presides over all appeals of ITC Section 337 proceedings and all customs and trade appeals from the U.S. Court of International Trade.

PRACTICE GROUP(S)

Appellate
International Trade Commission (ITC)
Licensing
Litigation
Post-Grant Patent
Trade Secrets
Trademarks & Unfair Competition

AREA OF FOCUS

Biotechnology & Pharmaceutical
Electrical & Computer
Mechanical

FORWARD THINKING

Publications

- Fed. Circ. Breaks Impasse On ITC Authority In *Suprema* - August 12, 2015
- Battling Grey Market Imports? The ITC is Here to Help - May 07, 2015
- Trade & Customs - January 02, 2014
- Why ITC Is Still A Good Venue For Patent Disputes - August 09, 2013
- Federal Circuit Affirms \$11 Million Penalty for Deliberate Evasion of ITC Remedial Orders - June 2012
- Making Business Sense of the Singapore FTAs (Wong Chian Voen Ed.) - 2004
- ITC Cases are on the Rise - 2004
- Thailand's Application of Post-Uruguay Round Antidumping Procedures in 2 DULPAHA - April-June 1997
- The International Lending Supervision Act of 1983: Has It Had an Effect on the Latin American Debt Crisis? - 1987

Alerts

- USTR Publishes Initiation of Section 301 Investigation into China's Practices Related to Technology Transfer, Intellectual Property and Innovation - August 30, 2017
- USTR Requests Comments in its Annual "Special 301" Review of Countries that Deny Adequate and Effective Protection of Intellectual Property Rights and Fair Market Access - January 04, 2017

- European Unitary Patent and Unified Patent Court after Brexit
- August 11, 2016
- Federal Circuit Validates U.S. International Trade Commission's Ability to Resolve Disputes Over Induced Infringement - August 11, 2015

Presentations

- "Recent Developments in U.S. IP Litigation Affecting the ICT Industry," ICT Forum on Innovation & IP Protection of the China Academy of Telecommunication Research (CATR) of the China Ministry of Industry and Information Technology (MIIT), Beijing, China, September 27, 2016
- IPO ITC Masterclass, Chicago, IL, June 10, 2016
- "Demystifying the Recent Decisions and Appeals at the ITC," Park Hyatt Washington, IP Strategy Summit, Washington, DC, June 7, 2016
- 2016 LESI Annual Conference, Beijing, China, May 16, 2016
- "Utilizing the ITC in Your Enforcement Strategy," Enforcement Conference Lunch 'n' Learn Event, Palo Alto, CA, March 19, 2015
- "How the ITC can Bolster Your IP Strategy," IP Strategy Summit, New York, New York, November 11, 2014
- "The Changing Landscape of 337 Proceedings Before the U.S. International Trade Commission," IP Strategy Summit: Enforcement, Silicon Valley, CA, June 19, 2014
- "Patent Litigation Strategy in U.S. Mobile Device Market" at the ICT Forum on Innovation & IP Protection of the China Academy of Telecommunication Research (CATR) of the China Ministry of Industry and Information Technology (MIIT), Beijing, China, June 5, 2014
- "Strategic Considerations Concerning the ITC and Federal Courts in Enforcing IP," Ningbo Technology Park Presentation With IP Society of Zhejiang Province, Ningbo, China, April 11, 2014
- "ITC Litigation Compared to District Court Litigation for Chinese Companies Involved in IP Litigation in the United States," China - U.S. Section 337 Investigation Conference of the China Ministry of Commerce (MOFCOM) Fair Trade Department and Federal Circuit Bar Association, Beijing, China, April 5, 2014
- "How Is The U.S. International Trade Commission Faring In Today's Regulatory Climate?" NLJ Regulatory Summit, Washington, DC, November 13, 2013
- "An Insider's View on ITC Enforcement Strategies," The IP Strategy Summit (TIPSS) Enforcement, Palo Alto, CA, October 17, 2013
- "Best Practices When Presenting to the ITC," The IP Strategy Summit: Enforcement, Washington, DC, May 30, 2013

- "How Chinese Companies can Enforce Their IP with ITC Section 337 and Defend Against ITC Section 337 Cases," IP Society of Zhejiang Province, Hangzhou, China, May 16, 2013
- "Multinational Litigation and Your Monetization Strategies," The IP Strategy Summit (TIPSS) Monetization: Harvesting Your IP, New York City, April 23, 2013
- "Case Analysis of the US 337 Investigations and Litigation Risk Control," ICT Seminar on IP Risks and Development Trend of Smart Terminals of the China Academy of Telecommunication Research (CATR) of the China Ministry of Industry and Information Technology (MIIT), Beijing, China, April 14, 2013
- "ITC Section 337 Investigation Update and Recent Trends," IP Salon, Shenzhen, China, November 17, 2012
- "U.S. International Trade Commission: Introduction to Section 337 Proceedings & Strategies for Foreign Companies," American Intellectual Property Law Association (AIPLA), Wenzhou, China, June 8, 2012
- "Structuring Deals to Maximize the Ability to Enforce Your Patent Portfolio," Licensing Executive Societies (LES) Spring Meeting, Boston, MA, May 17, 2012
- "Section 337 Proceedings Before the U.S. International Trade Commission," the International Trade Commission Trial Lawyers Association (ITCTLA), Guangzhou China, May 27, 2011
- "When & Why: Weighing the Pros and Cons of Litigating at the ITC - Lessons Learned from In-House Counsel," Panelist, ACI's Expert Forum on ITC Litigation & Enforcement, New York, NY, Feb. 24, 2011
- "IP Enforcement with ITC Section 337 Proceedings and U.S. Customs Actions," Utah Intellectual Property Summit, Salt Lake City, UT, Feb. 18, 2011
- "What High Tech Companies Need to Know About US Government International Trade Agencies, the Remedies They Impose, and the Assistance They Can Offer," Utah Technology Council (UTC) Legal Clinic, Salt Lake City, UT, Feb. 17, 2011

HONORS

- *Journal of International Law & Policy*, Editor-in-chief, American University, 1987-1988
- *The Legal Media Group Guide to the World's Leading International Trade Lawyers*, March 2007

AFFILIATIONS

- American Bar Association
Sections on Intellectual Property and International Law
- American Society of International Law
Secretary and Newsletter Editor, Section on International

Economic Law

- American Intellectual Property Law Association
- District of Columbia Bar Association
- Federal Circuit Bar Association
- International Trademark Association
- Intellectual Property Owners Association
- Licensing Executive Society
- ITC Trial Lawyers Association

REPRESENTATIVE MATTERS

ITC Section 337 Cases - Private Practice

- *Certain Semiconductor Devices, Semiconductor Device Packages, and Products Containing Same*, Inv. No. 337-TA-1010
- *Certain Portable Electronic Devices and Components Thereof*, Inv. No. 337-TA-994
- *Certain Vision-Based Driver Assistance System Cameras and Components Thereof*, Inv. No. 337-TA-907
Certain Vision-Based Driver Assistance System Cameras and Components Thereof, Inv. No. 337-TA-899
- *Certain Thermal Support Devices for Infants, Infant Incubators, Infant Warmers, and Components Thereof*, Inv. No. 337-TA-896
- *Certain Wireless Devices with 3G and/or 4G Capabilities and Components Thereof*, Inv. No. 337-TA-868
- *Certain Sintered Rare Earth Magnets, Methods of Making Same and Products Containing Same*, Inv. No. 337-TA-855
- *Certain Wireless Consumer Electronics Devices and Components Thereof*, Inv. No. 337-TA-853
- *Certain Electronic Devices For Capturing And Transmitting Images, And Components Thereof*, Inv. No. 337-TA-831
- *Certain Electric Fireplaces, Components Thereof, and Manuals for Same, Processes for Manufacturing or Relating to Same, And Products Containing Same*, Inv. No. 337-TA-826
- *Certain Wireless Devices with 3G Capabilities and Components Thereof*, ITC Inv. No. 337-TA-800
- *Certain Electric Fireplaces, Components Thereof, Manuals for Same, Certain Processes for Manufacturing or Relating to Same and Certain Products Containing Same*, Inv. No. 337-TA-791
- *Certain Set-Top Boxes, and Hardware and Software Components Thereof*, Inv. No. 337-TA-761
- *Certain Video Game Systems and Controllers*, ITC Inv. No.

337-TA-743

- *Certain Electronic Products, including Mobile Phones, Portable Music Players and Computers*, Inv. No. 701
- *MEMS Devices and Products Containing the Same*, ITC Inv. No. 337-TA-700
- *Silicon Microphone Packages and Products Containing the Same*, ITC Inv. No. 337-TA-695 (temporary exclusion order (TEO) proceeding and full proceeding)
- *Certain Flash Memory and Products Containing Same*, Inv. No. 337-TA-685
- *Active Comfort Footwear*, ITC Inv. No. 337-TA-660
- *Automotive Multimedia Display and Navigation Systems, Components thereof, and Products Containing Same*, ITC Inv. No. 337-TA-657
- *Cast Steel Railway Wheels, Certain Processes for Manufacturing Or Relating To Same and Certain Products Containing Same*, ITC Inv. No. 337-TA-655
- *Base Stations and Wireless Microphones*, ITC Inv. No. 337-TA-653
- *Silicon Microphone Packages and Products Containing Same*, ITC Inv. No. 337-TA-629
- *Ground Fault Circuit Interrupters and Products Containing Same*, ITC Inv. No. 337-TA-615
- *Magnifying Loupe Products and Components Thereof*, ITC Inv. No. 337-TA-611
- *Hydraulic Excavators and Components Thereof*, ITC Inv. No. 337-TA-582
- *Rubber Antidegradants, Components Thereof, and Products Containing Same*, ITC Inv. No. 337-TA-533
- *Certain Semiconductor Devices and Products Containing Same*, Inv. No. 337-TA-525
- *Automated Mechanical Transmission Systems for Medium-Duty and Heavy-Duty Trucks*, ITC Inv. No. 337-TA-503 and combined enforcement/advisory opinion proceeding
- *Home Vacuum Packaging Machines*, ITC Inv. No. 337-TA-496 (2/18/03) (temporary exclusion order (TEO) proceeding and full proceeding)
- *Coamoxiclav Products, Potassium Clavulanate Products, and Other Products Derived From Clavulanic Acid*, ITC Inv. No. 337-TA-479
- *Recordable Compact Disks and Rewritable Compact Discs*, ITC Inv. No. 337-TA-474
- *Bearings and Packaging Thereof*, ITC Inv. No. 337-TA-469

ITC Section 337 Cases - While Working at ITC

- *Asian Style Kamaboko Fish Cakes*, ITC Inv. No. 337-TA-378
- *Neodymium-Iron-Boron Magnets, Magnet Alloys, and Articles Containing Same*, ITC Inv. No. 337-TA-372
- *Salinomycin Biomass and Preparations Containing Same*, ITC Inv. No. 337-TA-370* (temporary exclusion order (TEO) proceeding only)
- *Bulk Bags and Process For Making Same*, ITC Inv. No. 337-TA-338
- *Translucent Ceramic Orthodontic Brackets*, ITC Inv. No. 337-TA-332