



JAMES K. CLELAND SHAREHOLDER

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EDUCATION

J.D., cum laude
Indiana University Maurer School of Law, 1997
B.S., cum laude, Chemical Engineering
University of Michigan, 1994

BAR ADMISSIONS

Michigan
Illinois
U.S. Dist. Court, Dist. of Delaware
U.S. Patent & Trademark Office
U.S. Dist. Court, N.D. Illinois
U.S. Dist. Court, E.D. Texas
U.S. Dist. Court, E.D. Michigan
U.S. Court of Appeals, Fed. Cir.
U.S. Court of Appeals, 9th Circuit
U.S. Court of Appeals, 6th Circuit

Working relentlessly to achieve his clients' objectives, Jim Cleland brings a mix of high energy, a wealth of litigation experience in district, appellate and patent courts across the country, a reputation for legal excellence and old-fashioned common sense to solve a broad spectrum of his clients' intellectual property issues.

Jim is co-chair of the firm's automotive group and his practice focuses on patent, trademark, copyright, trade secret and unfair competition litigation in a broad range of technologies including the chemical, automotive, materials science, mechanical, electrical and medical device arts, as well as in client counseling, opinion and licensing work in those same areas. His litigation experience includes trials, preliminary injunction hearings, Markman hearings summary judgment proceedings and all aspects of fact and expert witness discovery, spanning federal courts across the country. Jim also focuses on post grant review proceedings before the Patent Trial and Appeal Board, a forum that is quickly becoming the busiest patent court in the country.

Jim strives to provide a combination of excellent legal strategy and efficiency for all clients, whether large global corporations, small companies or individual clients.

In the world of intellectual property litigation, no two disputes are the same. Some demand immediate, aggressive action, while others require a more collaborative approach. Jim pays particular attention to recognizing the difference, and crafting legal solutions tailored to the dispute. He focuses heavily on the cost-benefit analysis for every project, whether large or small.

EXPERIENCE | OVERVIEW

- *Robert Bosch, LLC v. Snap-on Inc. et al.*, 769 F.3d 1094 (Fed. Cir. 2014).
- Jim successfully defended tool and diagnostic manufacturers Snap-On and Drew Technologies in a patent infringement lawsuit involving a patent directed to a diagnostic tester for motor vehicles. After first successfully transferring the case from California to his client's home base in Michigan, Jim argued the claim terms "program recognition device" and "program loading device" were indefinite because they are means-plus function elements with no corresponding structure disclosed in the specification. The District Court agreed and found the patent invalid. On October 14, 2014, the Federal Circuit affirmed the decision. This

decision represents the first time the Federal Circuit has ever held a means-plus-function term indefinite when the term did not use the word "means."

- *Wasica Finance et al. v. Continental*, (D.Del. 2012-present); In re [Continental IPR]
- Faced with a lawsuit in the District of Delaware, Jim represented Defendant Continental in staying the District Court action at the outset of the case and obtaining institution of an *inter partes* review of the asserted patent. Jim represented Continental before the PTAB and invalidated most claims of the asserted patent. He continues to represent Continental now on appeal before the Federal Circuit, while the District Court action remains stayed.
- *Drew v. Society of Automotive Engineers*, Case No. 14-325 (Washtenaw County Circuit Court 2014)
- When his client was removed from a vehicle diagnostics committee in an automotive standards setting organization, Jim took immediate action to reinstate his client to the committee. He obtained a temporary restraining order and preliminary injunction to keep his client on the committee, and invoked a little used arbitration clause in the SAE's governing rules to trigger a more favorable arbitration forum. Jim obtained a favorable settlement permanently reinstating his client to the committee, an important facet of his client's high tech business.

EXPERIENCE | CIVIC ACTIVITIES

- Youth Sports Coach, 2005-Present
- Juvenile Diabetes Research Foundation, 2001-Present

EXPERIENCE | LEGAL

- **Brinks Gilson & Lion**, Ann Arbor, Michigan
Shareholder, 2008-Present
Associate, 2004-2007
- **Greenberg Traurig/Law Offices of Dick & Harris**, Chicago, Illinois
May 1997-October 2004

PRACTICE GROUPS

Post-Grant Patent

Litigation

Trade Secrets

Appellate

Copyright

Patent Prosecution

Trademarks & Unfair Competition

AREA OF FOCUS

Automotive

FORWARD THINKING

Alerts

- Alice One Year Later - Litigation Trends in Districts Courts and the PTAB, June 10, 2015
- Federal Circuit Overturns PTAB and Provides Another Benchmark Decision on Handling Post-Petition Invalidity Arguments During IPR Proceedings, November 21, 2016
- Supreme Court Alters the Landscape of Venue for Patent Infringement Litigation, May 23, 2017
- Supreme Court Signals Full Steam Ahead for Challenging Patents in AIA Proceedings in Back-to-Back Oil States and SAS Institute Decisions, April 25, 2018
- PTAB Provides Guidance On The Impact Of SAS On AIA Trial Proceedings, April 27, 2018

Blog Posts

- Federal Circuit Overturns PTAB and Provides Another Benchmark Decision on Handling Post-Petition Invalidity Arguments During IPR Proceedings, November 21, 2016

Presentations

- "2017 Litigation Update," Brinks Webinar, June 14, 2017
- "The Alice Games," June 24, 2015
- "Brinks Post-Grant Patent Webinar," March 19, 2015
- "When Can Your Business Sue or be Sued by a Competitor Under Intellectual Property Laws," Ann Arbor Spark, July 27, 2007
- "How IP Litigation Can Work For Your Business," Ann Arbor IT Zone, May 18, 2007

HONORS

- Leading Patent Practitioner, *Intellectual Asset Management* magazine's "IAM Patent 1000: The World's Leading Patent Practitioners," 2018
- Leading Intellectual Property Lawyer, Leading Lawyers Network, 2014-present
- Named among the "Top Lawyers in Metro Detroit, Trade Secrets," *DBusiness* magazine, 2017
- Michigan Super Lawyers, Rising Stars 2008-2011, 2014

AFFILIATIONS

- Michigan Intellectual Property Inn of Court
- Sporting Goods Manufacturers Association
Legal Task Force
- Intellectual Property Owners Association
Trade Secret Committee
- Federal Bar Association
- American and Michigan Intellectual Property Law Associations
- Washtenaw County Bar Association

REPRESENTATIVE MATTERS

- *ArvinMeritor Technology, Inc, et al v. KIC LLC, KIC Holdings, Inc., et al.*, No. 15-13862 (E.D. Mich. 2015-present). Currently representing Meritor in a case involving allegations of patent infringement, false patent marking, false advertising and unfair competition relative to automotive brake drum.
- *Wasica Finance GmbH, et al v. Continental Automotive Systems U.S., Inc.*, No. 13-01356 (D. Del 2013-present) Obtained an early stay of the district court action pending completion of a successful petition for inter partes review of the asserted patent. The case remains stayed pending appeal of the final IPR decision to the Federal Circuit.
- *3M Innovative Properties Company, et al. v. GDC Inc. et al.*, No. 13-01287 (DMN. 2011-present). Lead counsel defending GDC against allegations of patent infringement involving acoustic insulation used primarily in automotive applications.
- *Miniature Precision Components, Inc. v. ContiTech North America, Inc.*, No. 15-00592 (E.D. Wisconsin 2015). Obtained an early dismissal of a patent infringement suit involving automotive engine components on behalf of ContiTech.
- *Videoscope, LLC. v. Snap-on Inc.*, No. 15-00089 (E.D. Tex. 2015). Lead counsel in defending Snap-on against a prolific NPE in Texas in a case involving allegations of patent infringement relative to video-equipped boroscopes, Obtained a favorable settlement very early in the case to minimize litigation expenses.

- *Continental Automotive Systems, Inc. v. BlueArc Finance AG, et al.*, IPR No. 14-01454 (PTAB 2014-2015) An IPR involving tire pressure monitor technology, the PTAB invalidated most of the claims of the asserted patent. The Board's decision is now on appeal before the Federal Circuit.
- *Robert Bosch LLC v. Snap-on Inc. et al.*, No. 12-11503 (E.D. Mich. 2012-2015). Successfully defended tool and diagnostic manufacturers Snap-On and Drew Technologies in a patent infringement lawsuit involving a patent directed to a diagnostic tester for motor vehicles. After first successfully transferring the case from California to his client's home base in Michigan, successfully argued the claim terms "program recognition device" and "program loading device" were indefinite because they are means-plus function elements with no corresponding structure disclosed in the specification. The district court agreed and found the patent invalid. On October 14, 2014, the Federal Circuit affirmed the decision. This decision represents the first time the Federal Circuit has ever held a means-plus-function term indefinite when the term did not use the word "means."
- *Michael L. Drew v. Society of Automotive Engineers, Inc.*, No 14-325 (MI Circuit Court Washtenaw County 2014) Lead counsel representing a plaintiff removed from a vehicle diagnostics committee in an automotive standards setting organization, obtained a temporary restraining order and preliminary injunction reinstating plaintiff on the committee. Invoked a little used arbitration clause in the SAE's governing rules to trigger a more favorable arbitration forum, and obtained a favorable settlement permanently reinstating plaintiff to the committee, an important facet of plaintiff's high tech business.
- *EBC Brakes USA, Inc. v. Allan M. Teaganj et al*, No. 11-12907 (E.D. Mich. 2011-2014). Lead counsel representing industry leading motorcycle brake manufacturer EBC Brakes, pursued claims of trademark infringement, copyright infringement, unfair competition and Digital Millennium Copyright Act violations. Obtained a favorable settlement on the verge of trial stopping Defendant from using EBC's trademarks and copyrights.
- *Alticor et al. v. Schirle et al.*, No. 12-cv-00636 (W.D. Mich. 2012). In a case involving claims of trademark infringement, Lanham Act violations, tortious interference, unfair competition, and fraud, obtained a favorable settlement early in the litigation on behalf of plaintiff Alticor stopping the complained of acts.
- *Quixtar v. Woodward, et al.*, No. 09-12946 (E.D. Mich. 2008-2011). Represented Quixtar in an arbitration involving claims of trade secret misappropriation, breach of contract and tortious interference. Obtained award of over \$25 million for Quixtar after a 16-day trial.
- *Polar Molecular Corp. v. Amway, et al.*, No. 07-0460 (W.D. Mich. 2007-2009). In a case involving allegations by Polar Molecular Corporation ("PMC") of Lanham Act violations, breach of contract, trade secret misappropriation, conversion, and civil conspiracy against our client Alticor, Inc. and some of its affiliates relating to the sale of fuel additives, the U.S. District Court for the Western District of Michigan dismissed conversion count, common law trade secret misappropriation count, portions of the breach of contract count and portions the Lanham Act count. After discovery and subsequent briefing, the Court granted Alticor's motion for summary judgment on the remaining claims, including trade secret misappropriation and breach of contract based upon disclosure of confidential information.
- *Eaton Corporation v. ZF Friedrichshafen A.G. and ArvinMeritor, Inc.*, No. 03-74844 (E.D. Mich. 2005-2008). Represented Defendants ZF Friedrichshafen and ArvinMeritor in a patent infringement action involving heavy-duty truck transmission technology. Obtained jury verdict dismissing all claims against clients, including determinations non-infringement and invalidity of the patents-in-suit.
- *Karmann GmbH v. Dura Convertible Systems, Inc.*, No. 05-55927 (Bankr. E.D. Mich. 2006-2007) Defended Dura in a bankruptcy court adversary proceeding involving patent infringement claims relating to convertible tops for automobiles. Obtained settlement advantageous to Dura just prior to trial after successfully procuring an aggressive four month filing to trial "rocket docket."

- *Maclean Vehicle Systems v. HTG, et al.*, No. 05-73512 (E.D. Mich. 2005-2007). Negotiated successful settlement for plaintiff MVS on the eve of trial in a patent infringement case involving capped wheel nuts for automobile wheels.
- *Alticor Inc. v. Tristrata Technology, Inc., et al.*, No. 05-763 (W.D. Mich. 2005). Secured a favorable settlement on behalf of Alticor quickly after filing a complaint for declaratory judgment.
- *Tenneco Automotive v. Visteon Corp.*, No. 03-1030 (D. Del. 2003-2005). Represented Visteon in a two-week patent infringement jury trial in August of 2005 involving catalytic converter technology. Obtained favorable settlement during jury deliberations.
- *Atofina v. Great Lakes Chemical Corp.*, No. 02-1250 SLR (D. Del. 2002-2004). Successfully defended Great Lakes in a two-week bench trial on patent infringement involving fluorochemistry and catalyst chemistry, securing ruling of a seldom-achieved trifecta of non-infringement, invalidity and inequitable conduct.
- *Aesculap v. Lorenz Surgical (C.D. Cal. 2002)*. Defended Lorenz Surgical in a patent infringement action involving cranial clamp manufactured by biomedical company subsidiaries of Biomet and B. Braun for brain surgery applications. Obtained favorable settlement after Markman hearing and expert reports.
- *TruCook, Inc. v. The Helman Group, et al.*, No. 00-C-4865 (N.D. Ill. 2000-2002). Represented plaintiff in a design patent and trade dress infringement case relating to temperature-sensing barbeque forks, including a rare Markman hearing on design patent claim interpretation. Case settled favorably.
- *Megadyne v. Triad*, No. 00-0548K (D. Utah 2000-2001). Represented Triad in a patent infringement case relating to electrocautery medical device used during surgery. Case settled after a two-day preliminary injunction hearing involving a Markman hearing and expert testimony.
- *TruCook, Inc. v. Big Lots, et. al. (N.D. Ill. 2000)*. Aggressively pursued preliminary injunction as counsel for plaintiff in trade dress, copyright and design patent infringement and unfair competition case relating to temperature sensing barbeque forks. Case settled shortly after filing for preliminary injunction.
- *Goebel v. Cobbs Manufacturing Co.*, No. 97-N-2023 (D. Colo. 1996-1997). Successfully represented defendant Cobbs in a copyright infringement lawsuit involving copyrighted product packaging. After a favorable ruling following a bench trial, the case settled.