



ROBERT S. MALLIN **SHAREHOLDER**

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EDUCATION

J.D.,
Loyola University Chicago School of Law, 1990
B.S., Chemical Engineering
University of Illinois, 1985

BAR ADMISSIONS

U.S. Patent & Trademark Office
U.S. Dist. Court, W.D. Texas
U.S. Dist. Court, W.D. Michigan
U.S. Dist. Court, N.D. Illinois, Trial Bar
U.S. Dist. Court, E.D. Wisconsin
U.S. Court of Appeals, Fed. Cir.
Illinois Supreme Court

Patent litigator Robert Mallin uses his experience as litigation strategist and first-chair trial attorney to maximize his clients' returns in patent and trademark disputes. Having significant exposure to both traditional patent litigation in federal courts and in post-grant *Inter Partes* Review (IPR) proceedings at the United States Patent and Trademark Office, Robert counsels clients on where and how to most effectively litigate patent invalidity claims. Where appropriate, Robert has successfully used the IPR process to invalidate patents asserted against his clients or to stay ongoing litigation, avoiding lengthier and more costly court proceedings.

Robert has vast experience in all phases of litigation—from preliminary injunctions to *Markman* hearings to jury trials—as well as in proceedings before the International Trade Commission, in IPR proceedings, and in other post-grant review proceedings before the Patent Trial and Appeal Board. Over his career, he has appeared in more than 75 cases in more than 20 different courts and other forums, including the ITC and PTAB. Alongside his successful litigation practice, Robert advises clients on licensing, patentability, and validity issues, as well as patent prosecution. Robert also has experience as a process engineer for a food manufacturing company where he worked with equipment used in a manufacturing environment for processing, packaging, quality control, and material handling and transportation. Throughout all of his work, he places an emphasis on anticipating issues and helping clients to think forward for long-term strength and effectiveness.

Robert has represented major clients in the bakery product manufacturing, automotive, telecommunications, and trading platform software products areas. He has counseled clients in a variety of other technical areas including electromechanical inventions, mechanical inventions, chemical processing, medical devices, computer chips, metallurgical processing and biotechnology.

EXPERIENCE | OVERVIEW

- Represented R.J. Reynolds in patent litigation involving electronic cigarettes.
- Represented Interactive Data Corporation and obtained summary judgment of noninfringement in an infringement action in federal district court involving a patent related to the processing of financial data
- Represented Kia Motors, Hyundai and 11 dealerships throughout the US in multi-forum dispute based on sales of vehicles with keyless ignition. Under Robert's guidance, cases brought in 10 different district courts were consolidated and dismissed pending IPR proceedings relating to patent invalidity and bankruptcy

Biographies | Robert S. Mallin

proceedings relating to patent ownership. The patent was subsequently invalidated in the IPR proceeding and found not to be owned by the plaintiff in the Bankruptcy proceeding.

- Represented defendant in patent litigation concerning equipment and processing methods for manufacturing corn-based crunchy snacks and included study of baking equipment and related processing
- Involved in trademark litigation concerning covered packaging and product configuration
- Handled opinions and counseling for food manufacturer

EXPERIENCE | NON-LEGAL

- **Frito-Lay**, Beloit, Wisconsin
Project Engineer, 1985-1987

PRACTICE GROUPS

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

AREA OF FOCUS

Biotechnology & Pharmaceutical
Automotive
Chemicals, Energy & Agriculture
Electrical & Computer
Mechanical
Medical Device

FORWARD THINKING

Alerts

- PTAB Designates Two Prior Opinions As Precedential, January 19, 2016
- Federal Circuit Concurring Opinion Recommends En Banc Review of Prior Ineligible Subject Matter Decision, October 16, 2018

Presentations

- "*Inter Partes Review: Strategies for Petitioner and Patent Owner*," Midwest Intellectual Property Symposium, November 15, 2018
- "PTAB and the District Courts," Managing Intellectual Property's US Patent Forum, Palo Alto, CA, March 15, 2016

HONORS

- Leading Intellectual Property Lawyer, Leading Lawyers Network, Law Bulletin Publishing Company, 2014

TECHNICAL BACKGROUND

- Chemical Engineering

REPRESENTATIVE MATTERS

- **District Court Litigation**
- *Fontem. v. R.J. Reynolds Vapor Company* (M.D.N.C.). Cased settled. Represented Reynolds in patent infringement litigation and multiple related IPR proceedings. (2017-2018).

- *Quest Licensing Corp. v. Interactive Data Corporation* (D. Del.). Cased dismissed on summary judgment of noninfringement. Plaintiff alleged infringement relating to technology for providing information to mobile telecommunications users. (2014-2017).
- *Kia Motors America, Inc. and Kia Motors Corporation v. Peter F. Wingard* (N.D. Ill.). Case dismissed pending IPR and bankruptcy proceeding relating to patent ownership. Kia sought a declaratory judgment of noninfringement of patent asserted against Kia vehicles. The patent was invalidated in the IPR proceeding and the Bankruptcy court determined that the plaintiff did not own the asserted patent. (2014-2015).
- *Peter F. Wingard and Netlatch LLC v. Hyundai Motor America and Orr Hyundai of Texarkana* (E.D. Tx.). Case dismissed pending IPR and bankruptcy proceeding relating to patent ownership. Plaintiff alleged infringement based on sales of Hyundai vehicles having keyless ignition. (2014-2015).
- *Peter F. Wingard v. Various Kia Dealerships Throughout the U.S.* (10 different district courts). Cases dismissed pending IPR and bankruptcy proceeding relating to patent ownership. Plaintiff alleged infringement against 11 different Kia dealerships in ten different district courts (E.D. Tx., S.D. Tx., N.D. Tx., N.D. Ill., C.D. Cal., W.D. Wisc., D. Del., M.D. Fla. D. N.J., and E.D. Va.) based on sales of Kia vehicles having keyless ignition. (2014-2015).
- *Patriot Scientific Corporation, Phoenix Digital Solution LLC, Technology Property Limited LLC v. ZTE Corporation and ZTE (USA) Inc.* (N. D. Cal). Represented defendants against claims of alleged infringement of three patents related to microprocessor technology.
- *Grupo Bimbo v. Snak King (C.D. Cal.)*. Case Settled. Asserted trademark and patent rights relating to rolled tortillas. (2013-2015).
- *Ronald D. Russo v. Wilson-Cook Medical, Inc.* (M. D. Fla.) Case settled. Represented defendant/counter-plaintiff in alleged breach of contract action. (2013-2014).
- *Draeger Medical Systems, Inc. v. Atom Medical International, Inc. et. al.* (M.D. Fla.). Case Settled. Technology related to infant incubators and warmers. (2013-2014).
- *Markets-Alert Pty, Ltd. v. eSignal.com et al.* (D. Del.). Case dismissed after patent determined to be invalid in related CBMR.
- *Twin Star International, Inc. et al v. Whalen Furniture Manufacturing Inc.* (S.D. Cal.). Case settled.
- *InvestPic LLC v. StatPro Inc.* (D. Del.). Case dismissed in client's favor before discovery. Technology related to trading software. (2011-2012).
- *GHJ Holdings, LLC v. Plasticade Products Corp.* (E.D. Tx.). NPE false marking case dismissed after new marking statute under AIA announced and implemented. (2010-2011).
- *GHJ Holdings, LLC v. ConvaTec Inc.* (E.D. Tx.). NPE false marking case settled after complaint dismissed for failing to meet the pleading requirements of Fed. R. Civ. P. 9(b). (2010-2011).
- *Hollister Incorporated v. ConvaTec Inc.* (N.D. Ill.). Hollister patent infringement claim dismissed on summary judgment. ConvaTec's counterclaims for false marking and false advertising were settled. Technology related to bowel management medical device for critical care patients, and the claims and advertising regarding those devices. (2010-2013).
- *Encore Rail Systems, Inc. v. The Willamette Valley Company* (N.D. Ill.). Case settled during discovery. Technology related to chemistry involved with new railroad spike repair material to prevent railroad misalignment and derailling. (2010-2011).
- *Unomedical A/S v. Smiths Medical MD, Inc.* (N.D. Ill.). Case settled after original opposing counsel withdrew while motion to disqualify for client conflict was pending. Technology related to a disposable needle for use with insulin infusion pumps. (2009-2011).
- *Kannar v. Alticor Inc.; Amway Corp.; and Access Business Group LLC* (C.D. Cal.). Case settled during expert discovery. Technology related to chemistry involved with nutraceutical garlic tablet formulation and processing. (2008-2010).

- *Yakima Products, Inc. v. Saris Cycling Group, Inc.* (D. Or.). Case settled. Technology related to multiple patents for various bicycle rack designs. (2008-2009).
- *Star Scientific, Inc. v. R.J. Reynolds Tobacco Company* (D. Md.). Obtained a jury verdict of noninfringement after a 5-week trial. Noninfringement verdict was affirmed on appeal. Technology related to alleged method for lowering the nitrosamine level in tobacco. (2008-2011).
- *Energizer Holdings, Inc. and Eveready Battery Company, Inc. v. Spectrum Brands, Inc.* (W.D. Wisc.). Case settled after client obtained a preliminary injunction. Technology related to lithium batteries. (2008-2009).
- *Arimathea LLC v. Wm. Wrigley Jr. Company et al.* (N.D. Ill.). Case resolved during settlement conference with Magistrate Judge. Technology related to design for tin containers. (2008-2009).
- *Techtronic Industries Co., Ltd and Richard Pando v. Chervon Holdings Ltd; Nanjing Chervon Industrial Co. Ltd; Chervon Ltd; Chervon North America, Inc.* (N.D. Ill.). Case settled after clients obtained a preliminary injunction. Technology related to wall-mounted laser level. (2006-2007).
- *One World Technologies, Inc. and Ryobi Technologies, Inc. v. Robert Bosch Tool Companies; Rexon Industrial Corp., Ltd.; and Power Tool Specialists, Inc.* (N.D. Ill.). Case settled. Technology related to ergonomic design for miter saws. (2006-2007).
- *One World Technologies, Inc. and Ryobi Technologies, Inc. v. Rexon Industries Corp., Ltd; and Power Tool Specialists, Inc.* (N.D. Ill.). Case settled. Technology related to use of laser technology in conjunction with miter saws. (2006-2007).
- *Jacobs Chuck Manufacturing Company; Power Tool Holders, Inc.; and Establishments Amyot, S.A. v. Shandong Weida Machinery Co. Ltd.; One World Technologies, Inc.; and Techtronic Industries Co., Ltd.* (E.D. Tx.). Case settled. Technology related to chuck design for drills. (2005-2006).
- *Black & Decker v. Ryobi Technologies and TechTronics Industries* (D. Del.). Case settled. Technology involved multiple patents involving both electrical and mechanical aspects of several different power tools. (2005-2006).
- *Tilia Int'l v. The Rival Co.* (N.D. Cal.). Case settled concurrently with *In re Home Vacuum Packaging Machines*. Technology related to vacuum packaging machines such as Foodsaver and Seal-a-Meal vacuum packaging machines. (2003-2004).
- *New Venture Gear, Inc. v. BorgWarner Inc. and BorgWarner TorqTransfer Systems, Inc.* (E.D. Mich.). Case settled. Technology related to four wheel drive technology used in transfer cases supplied to automotive industry. (2001-2002).
- *BorgWarner Inc. and BorgWarner TorqTransfer Systems, Inc. v. New Venture Gear, Inc.* (N.D. Ill.). Case settled. Technology related to four wheel drive technology used in transfer cases supplied to automotive industry. (2000-2002).
- *Integrated Paving Concepts, Inc. v. Nikon Enterprises and Sadi Sepassi* (C.D. Cal.). Obtained jury verdict of trademark and copyright infringement, and an award of damages. Subject matter related to unauthorized trademark and copyright use on internet. (1999-2001).
- *Ameritech Corporation v. Quaterra Communications Corporation* (E.D. Wisc.). Obtained default judgment. Subject matter related to Ameritech trademark rights. (1998).
- *Ryobi Outdoor Products v. American Honda Motor Company Inc., et al* (D. Az.). Case settled. Technology related to four cycle engine technology. (1998-2000).
- *Ruud Lighting v. Security Lighting Systems, Inc.* (E.D. Wisc.). Case settled. Technology related to light reflector patent. (1998-1999).
- *Bracey v. Brushtech* (N.D. Ill.). Case dismissed after discovery of invalidating prior art reference. Technology related to brush design. (1998).
- *United Technologies v. Borg-Warner Inc.* (E.D. Mich.). Case settled. Technology related to gear motor used in automotive industry. (1997-1999).

- **Illinois Tool Works v. Fori Automation** (E.D. Mich.). Case settled. Technology involved vision equipment for wheel and tire mounting equipment used by the automotive industry. (1997).
- **Minnesota Manufacturing & Mining v. M/A-COM Inc.** (W.D. Tx.). Case settled. Technology related to thermoplastic for electrical connectors. (1996-1997).
- **Amway Corporation v. Nartron Corporation** (W.D. Mich.). Patent held invalid on summary judgment. Technology related to water treatment technology. (1993-1996).
- **Weiss v. Ruud Lighting** (N.D. Ill.). Case settled. Technology related to unique lighting fixture. (1991-1992).
- **Inland Steel Company v. LTV Steel Company and USX Corporation** (N.D. Ill.). The asserted patents were invalidated during reexamination after a jury trial on infringement only. Technology related to prevention of internal oxidation during processing of cold rolled lamination steel. (1991-1993).
- **Kelsey-Hayes Company v. Motor Wheel Corporation** (W.D. Mich.). Case settled. Technology related to full face wheel technology utilized by the automotive industry. (1991-1992).
- **International Trade Commission**
- *Certain Thermal Support Devices for Infants, Infant Incubators, Infant Warmers, and Components Thereof*, Inv. No. 337-TA-896. Represented respondent Atom in patent infringement investigation (settled).
- *Certain Wireless Consumer Electronics Devices and Components Thereof*, Inv. No. 337-TA-853. Represented respondent ZTE in patent infringement investigation (no infringement).
- *Certain Electronic Devices For Capturing And Transmitting Images, and Components Thereof*, Inv. No. 337-TA-831. Represented respondent Kodak in patent infringement investigation (no infringement).
- *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. Represented complainant Twin Star in trade secret and copyright investigation (settled).
- *Home Vacuum Packaging Machines*, Inv. No. 337-TA-496. Represented respondent Rival in patent infringement investigation (settled).