

BRINKS  
GILSON  
& LIONE  
100 YEARS OF IP LAW



## JAMES R. SOBIERAJ SHAREHOLDER

"Jim Sobieraj is phenomenal; I feel lucky to work with him. He's highly sought-after and always busy, but he makes time for us no matter what."  
IP Counsel – Global product marketing company

**Jim Sobieraj believes his success for clients derives from being able to capably manage two apparently contradictory traits. "A successful litigator needs to listen and to lead," he states.**

Jim excels at both. To the benefit of his clients he relies on his tenacious competitiveness and his collegiality. "When I'm involved in a patent litigation," he notes, "I'm constantly thinking about how to win—evenings, weekends, while driving—any time. And I don't back down." At the same time, Sobieraj adds, "It's important to develop strong, collegial relationships with clients. In the best relationships, we're fighting hard for them—and winning—but our clients become friends and colleagues."

With more than 35 years of experience in more than 100 IP litigations, Jim has learned how to develop and apply strategies that never lose focus of achieving the client's business objectives. That means holding himself to a higher standard for service. And his clients agree.

Says one IP counsel at a global product marketing company, "Jim Sobieraj is phenomenal; I feel lucky to work with him. He's highly sought-after and always busy, but he makes time for us no matter what. He's terrific." Notes the IP counsel at a Tier 1 automotive supplier that Sobieraj represented in a jury trial: "Jim and the Brinks' team kicked [opposing counsels] tail.... The [opposition] was on its heels the entire time... . [I]t was an easy shot to knock them over [at settlement]."

Another client adds, "Jim is a great analyst and he's incredible in motion practice ... . He projects so much intellectual integrity that after a while the judges all want to hear from him." Another adds,

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3600  
Chicago, IL 60611

### EDUCATION

J.D.  
University of Michigan Law School,  
1982

B.S., Electrical Engineering,  
magna cum laude  
University of Michigan, 1979

### BAR ADMISSIONS

Supreme Court of the United  
States  
U.S. Court of Appeals, 10th Circuit  
U.S. Court of Appeals, 6th Circuit  
U.S. Court of Appeals, 8th Circuit  
U.S. Court of Appeals, Fed. Cir.  
U.S. Court of Federal Claims  
U.S. Dist. Court, C.D. Illinois  
U.S. Dist. Court, Dist. of Colorado  
U.S. Dist. Court, E.D. Michigan  
U.S. Dist. Court, E.D. Texas  
U.S. Dist. Court, N.D. Illinois, Trial  
Bar  
U.S. Dist. Court, S.D. Indiana  
U.S. Dist. Court, W.D. Michigan  
U.S. Dist. Court, W.D. Texas  
U.S. Patent & Trademark Office

"Jim deserves particular recognition for his leadership, courtroom presence, and ... organizational skills...." Still another applauds his "... extraordinary effort ... commitment and passion."

"I wake up every day proud to be trusted by clients to handle some of their toughest legal challenges with respect to IP," says Jim. "As I consider how my work best exemplifies the spirit and work ethic of Brinks, an arbitration case comes to mind. There we not only won a \$25 million judgment for our client, but also used the rubric of the case to develop a plan for minimizing future litigation over similar claims, which included changing contracts and procedures for protecting the client's most valuable trade secrets. That to me typifies how Brinks is always looking ahead for our clients."

Jim also served as president of Brinks Gilson & Lione from 2012 through 2017. During his tenure, the firm opened new offices in Florida and China.

## EXPERIENCE | OVERVIEW

Jim has been lead counsel in litigations involving the infringement, validity and ownership of patent rights, license agreements, misappropriation of trade secrets, trade dress infringement, unfair competition, false advertising, fraud, antitrust, and other commercial litigation. His experience includes bench and jury trials, temporary restraining orders, preliminary injunctions, Markman hearings, appeals, arbitrations and mediations. He has represented companies in a variety of technologies, including in analog and digital electronics, telecommunications, software, medical devices, hydraulics, automotive components, and various consumer goods.

Jim also advises clients on strategies for building, maintaining, enforcing, defending and commercializing patent portfolios. He works with global clients in the U.S, Canada, Europe, Asia and Australia, and has developed a large network of highly-regarded IP professionals in many countries around the world. He has received many legal industry accolades and awards.

## EXPERIENCE | LEGAL

**Brinks Gilson & Lione**, Chicago, Illinois

Past-President, 2012-2017

Member, Board of Directors, 1990, 1994, 1995, 2000, 2001, 2010-2017

Chair of the Litigation Practice Group, 2002-2007

Chair of the Strategic Planning Committee, 2008-2009

Shareholder, 1987-Present

Associate, 1982-1986

## EXPERIENCE | NON-LEGAL

**IBM Corporation**, Burlington, VT

Engineering intern, 1979 and 1980

## EXPERIENCE | CIVIC ACTIVITIES

**St. Edward's Church Parish Council**

President, 2006-present

## **Union League Club of Chicago**

### **Chicago Volunteer Legal Services**

#### **PRACTICE GROUP(S)**

- Appellate
- Copyright
- International Patent
- International Trade Commission (ITC)
- International Trademark
- Licensing
- Litigation
- Post-Grant Patent
- Trade Secrets

#### **AREA OF FOCUS**

- Automotive
- Electrical & Computer
- Mechanical
- Medical Device

#### **TECHNICAL BACKGROUND**

- Analog Electronics
- Digital Electronics
- Semiconductors
- Software

#### **FORWARD THINKING**

##### **Publications**

- Feature Profile: Detroit Native Heads One of Chicago's Top IP Firms - *March 23, 2012*
- "Know-How in the United States," Wurzer-Kaiser, ed. (Bundesanzeiger, Verlag: Koeln, 2007) Ch. 5. - *2007*
- International Litigation - *2005*
- Current Issues and Future Trends for Large Corporate Licensing Programs - *June 2004*
- Protecting Your IP in Joint R&D Projects - *July 01, 2003*

##### **Alerts**

- Time to Appeal: Challenging PTAB Time-Bar Determinations at the Federal Circuit - *January 16, 2018*
- Biosimilar Product Notice - *July 13, 2016*

##### **Books**

- International Litigation - *2005*

##### **Presentations**

- "Recent IP Decisions from the U.S. Supreme Court," AIPPI-US (AIPLA) Global IP Educational Forum, Chicago 2017
- "Legal and Business Cases in IP Licensing," LES Thailand 2017 Meeting
- "Fifty Years of a Changing Landscape for Patents in the United States," *les Nouvelles*, March 2016
- "Current Global Trends in Licensing, LES Asia Pacific 2015 Meeting, Kuala Lumpur" "Important Changes Concerning the Procurement and Enforcement of IPR in the United States, Licensing Executives Society Scandinavia 2015 Annual Meeting
- "US IP Litigation", Licensing Executives Society (Britain and Ireland), 2015 Annual Meeting
- "Managing the Changing IPR Landscape in High Tech Industries", Licensing Executives Society (USA & Canada) 2011 Annual Meeting
- "The Devil's in the Deals: Sticky transactional issues", Licensing Executives Society (USA & Canada) 2010 Annual Meeting
- "Global Leaders of Corporate Licensing," moderator, Licensing Executives Society International Conference, Chicago, Illinois, May 2008
- Evaluating and Managing the Risks of IP Litigation in the U.S," Freshfields Bruckhaus Deringer and Brinks Gilson & Lione Litigation Seminar, "What Every European Company Should Know About Litigation in the U.S.," Munich, Germany, June 21, 2007
- "Resolving International Licensing Disputes Through Mediation," Licensing Executives Society International Conference, Zurich, Switzerland, June 20, 2007
- "International Arbitration," Licensing Executives Society (USA & Canada) 2006 Annual Meeting
- "The Quilt Work of Damages Methodologies in Matters Within the Circuit's Preview," Federal Circuit Bar Association Bench and Bar Conference, Albuquerque, New Mexico, July 1, 2006
- "Managing The Risks of IP Litigation," Lorman Seminar, Chicago, Illinois, May 4, 2006
- "Antitrust Issues in Patent and Technology Licensing," Licensing Executives Society International Conference, Seoul, Korea, April 12, 2006
- "Dispute Resolution Alternatives in the Pacific Rim," Licensing Executives Society International Conference, Seoul, Korea, April 10, 2006
- "Assessing and Managing the Risks of IP Litigation," Brinks Gilson & Lione Litigation Seminar, October 25, 2005
- "What Business Executives Must Know About IP Litigation,"

## Licensing Executives Society (USA & Canada) 2005 Annual Meeting

- "Leaders of Licensing Panel Discussion," Licensing Executives Society (USA & Canada) 2005 Annual Meeting
- "IP Bankruptcy: A Dastardly Deed," Licensing Executives Society International, Paris, France, March 31, 2004
- "The Doctrine of Equivalents in Europe and the U.S.: A Case Study," Licensing Executives Society International Conference, Oslo, Norway, June 18, 2003
- "Business Method Patents: Introduction and Strategies," Chicago Bar Association Corporate Law Department Committee, June 5, 2003
- "Protecting Your Turf: Tips and Traps for Ownership of IP Rights," Licensing Executives Society, Silicon Valley Chapter, San Jose, California, March 26, 2003
- "Intellectual Property Issues Arising From Joint Development Projects," Joint Meeting of the Licensing Executives Society of Korea and AIPPI, Seoul, Korea, October 7, 2002
- "The Role of Intellectual Property in E-commerce and the Internet," Licensing Executives Society, USA & Canada, Annual Meeting, 2001
- "Winners and Losers – Finding the Right Intellectual Property and E-Business Strategies," Licensing Executives Society, USA & Canada, Winter Meeting, 2001
- "Innovation at the Speed of E-Commerce: Strategic Business and Intellectual Property Perspectives," University of Chicago Graduate School of Business Symposium, Chicago, Illinois, September 7, 2000
- "Strategic Alliances in the Electronics Industry," Licensing Executives Society (USA & Canada) Annual Meeting, 1994
- "Contracting for Alternative Dispute Resolution: An Application to Intellectual Property," American Intellectual Property Law Association Annual Meeting, 1993
- "Structuring the Licensing Agreement," Licensing Executives Society (USA & Canada) Seminars, Chicago, Illinois, 1992 and 1990
- "Reasonable Royalties – What Does Reasonable Mean?" Licensing Executives Society (USA & Canada) Annual Meeting, 1991
- "Building a Damages Claim," Licensing Executives Society (USA & Canada) Annual Meeting, 1990

## HONORS

- Martindale-Hubbell "AV Preeminent" rating
- IP Star, *Managing Intellectual Property* magazine, 2013-2017
- Leading Patent Practitioner, *Intellectual Asset Management's* "IAM

Patent 1000 – The World’s Leading Patent Practitioners," 2012-2017  
(Litigation and Transactions)

- Leading Intellectual Property Strategist, *Intellectual Asset Management* magazine's "IAM 300 - A Guide to the World's Leading IP Strategists," 2014
- Leading Patent Litigator, *Intellectual Asset Management's* "IAM Patent Litigation 250 - The World’s Leading Patent Litigators," 2011
- Euromoney Patent Experts Guide (11<sup>th</sup> Edition)
- Euromoney Expert Guide to the World's Leading Patent Law Practitioners, 2005, 2009, 2017
- Leading Intellectual Property Strategist *Intellectual Asset Management's* "IAM 250 - A Guide to the World’s Leading IP Strategists," 2009-2011
- *Guide to the World's Leading Patent Law Practitioners*, published by Managing Intellectual Property, 2007, 2010
- Legal Media Group's Guide to the World's Leading Patent Law Experts, 2005
- BTI Client Service All-Star Team for Law Firms, 2004
- *Euromoney Guide to the World’s Leading Technology, Media and Telecommunications Lawyers*, 2003
- *Euromoney Guide to the World’s Leading Information Technology Advisors*, 1999

## AFFILIATIONS

- Licensing Executives Society  
President, 2002-2003  
President-Elect, 2001-2002  
Secretary, 1998-2001  
International Delegate, 1997-2007  
Board of Trustees, 1996-2004  
Various other roles 1992-1996
- Licensing Executives Society International  
Past President, 2016-2017  
President, 2015-2016  
President Elect, 2014-2015  
Treasurer, 2011-2014  
Counsel to the Board of Directors, 2008-Present  
Chair, 2008 LES International Conference  
Vice Chair, Dispute Resolution Committee, 2005-2007  
Various other roles 2000-2005
- Intellectual Property Law Association of Chicago  
President, 2007  
President-Elect, 2006  
Vice President, 2005  
Judges Dinner Chair, 2004-2005  
Judicial Appointments Committee Chair, 2009-2011  
Patent Law Symposium Co-Chair, 2007-2011

- National Inventors Hall of Fame  
Board of Directors, 2004-2010
- IP Hall of Fame Academy, 2007-Present
- The LES Standards Board, 2017-Present
- The Licensing Foundation  
Board of Directors, 2003-2008
- Certified Licensing Professionals, Inc.  
Board of Governors, 2007-2008  
President, 2008  
Counsel to the Board of Governors, 2008-2010
- American Intellectual Property Law Association  
Chairman, Contracting for ADR Committee, 1990-1993  
Judge, Giles S. Rich Moot Court Competition
- Richard Linn American Inn of Court, Founding Member
- Federal Circuit Bar Association
- Federal Bar Association
- The Lawyers Club of Chicago
- Intellectual Property Owners Association

## REPRESENTATIVE MATTERS

- *Alticor Inc. et al v. UMG Recordings Inc. et al.* (M.D.Florida): Represents the plaintiffs in a breach of contract and copyright case against the three largest record companies in U.S. The case is pending.
- *Quixtar Inc.v. Woodward et al.* (Arbitration; E.D. Mich.): Represented Quixtar in an action relating to misappropriation of trade secrets, breach of contract and tortious interference. After a 16-day trial, the arbitrator awarded Quixtar more than \$25 million, which was affirmed in federal court.
- *Cuno, Inc. v. Pall Corporation* (E.D.N.Y.): Represented the plaintiff during a 5-week jury trial involving claims of patent infringement asserted by both parties. The patents were directed to nylon microporous membranes. The parties settled the case when the defendant agreed to pay the plaintiff \$12 million and to provide additional consideration.
- *AMP Incorporated v. AT&T Corporation.* (M.D.Pa.): Represented AMP in a patent infringement suit against AT&T. After a summary jury trial, the parties reached a settlement, with AT&T paying AMP \$9 million and granting the company additional consideration.
- *Phi-Insul Corp. d/b/a IntegraSpec v. Reward Wall Systems, Inc. et al* (E.D. Texas and Nebraska): Represented a Canadian company accused of infringing a patent relating to an insulated concrete form. The Eastern District of Texas granted a motion to transfer the case to the District of Nebraska. The Nebraska court granted summary judgment of non-infringement in favor of our client, which was affirmed by



the Federal Circuit.

- *Progressive Casualty Insurance Co. v. Liberty Mutual Insurance Co. (Fed. Cir.):* Represented the appellant in appeals of two of the first Covered Business Method Patent Reviews decided by the PTAB.
- *Tenneco Automotive Inc. v. Visteon Corp., (D.Del.):* Defended Visteon, which was accused of infringing two patents on catalytic converters. One patent was dismissed prior to trial. Following a six-day jury trial on the second, the parties settled before the jury delivered a verdict.
- *Procter & Gamble v. Randy Haugen and Amway Corporation (D. Utah; 10<sup>th</sup> Cir.):* Defended Amway against P&G's claims based on the Lanham Act, defamation per se, tortious interference with business relations, unfair competition, negligent supervision and vicarious liability. All of P&G's claims were dismissed at the pleading stage or by summary judgment, and the 10<sup>th</sup> Circuit affirmed.
- *Nitro Distributing et al. v. Alticor Inc., et al. (W.D.Mo.; 8<sup>th</sup> Cir.):* Represented the defendants in an antitrust case. On the eve of trial, the Court granted defendants' motion for summary judgment and dismissed all of the claims. The 8<sup>th</sup> Circuit Court of Appeals affirmed the dismissal of all claims. The U.S. Supreme Court denied plaintiffs' petition for certiorari.
- *Wolverine World Wide Inc. v. Nike Inc., (W.D. Mich; Fed. Cir.):* Defended Nike against a claim that one of its popular shoe lines infringed a patent owned by Wolverine. The Federal Circuit affirmed the lower court's grant of summary judgment of non-infringement.
- *Nartron Corp. v. Amway Corp. (Michigan Circuit Court; W.D.Mich. Bankruptcy Court):* Represented Amway in a lawsuit involving claims of ownership of patent rights, breach of contract, and misappropriation of trade secrets relating to end-of-life indicators for water filters. Following bench trials on liability and damages, the trial court awarded Amway all of the patent rights and damages for Nartron's breach of contract and trade secret misappropriation. The Court of Appeals affirmed the award of patent rights, affirmed Nartron's liability for several hundred thousand dollars of damages and interest, and remanded the case for further proceedings on Amway's claim for additional damages. Nartron subsequently filed for bankruptcy protection. The parties settled with Nartron paying Amway \$3.5 million.
- *New Medium Technologies LLC et al v. LG Philips LCD et al. (N.D.Ill.):* Mr. Sobieraj represented LG Philips LCD, which had been accused of infringing three patents relating to LCD panels. The parties settled.
- *JSDQ Mesh Technologies, Inc. v. BelAir Networks Corp et al. (D.Del.):* Defended Ericsson Inc. and several affiliates, which had been accused of infringing four patents relating to wireless communications networks. The parties settled.



- *Oxford Gene Technology Limited v. Motorola, Inc.*, (N.D.Ill.):Defended Motorola, which had been accused of infringing a patent directed to DNA arrays. The parties settled.
- *Standard Oil v. Showa Entetsu*(E.D. Mich.):Represented Standard Oil in a case asserting that the defendant that breached an exclusive trade secret license for an electroplating process. The court entered a temporary restraining order shortly after the lawsuit was filed, and a issued preliminary injunction after an extensive evidentiary hearing.
- *AMP Incorporated v. Teradyne, Inc.* (M.D.Pa.):Represented AMP, which had sued Teradyne for infringing two AMP patents and for misappropriating trade secrets related to high density/high speed electrical connectors. The case involved a two-day Markman hearing. The parties settled shortly after AMP filed its oppositions to Teradyne’s motions for summary judgment.
- *Alticor Inc. v. Ultra-Sun Technologies, Inc.* (W.D.Mich; Fed. Cir.):Represented Alticor in an action based on claims of false advertising under federal and state law, and infringement of two patents relating to water treatment systems. The false advertising claims were settled before trial. The Federal Circuit ruled in Alticor’s favor on the patent claims, after which the parties settled.
- *Delta T Corporation v. Sun-North et al.* (E.D.Ky., and AAA):Represented several Canadian corporations in an action removed from a Kentucky state court, and then ordered to arbitration. The plaintiff alleges patent infringement, extortion and breach of contract. The court declined to grant a preliminary injunction against our client after a 1 day trial. The parties then settled.
- *Nano-Proprietary Inc. v. Till Keesmann* (N.D.Ill.):Defended a German inventor, Till Keesmann, in an action concerning the termination of an exclusive license agreement for a pioneer patent in the field of carbon nanotubes. The parties settled.
- *Maui Jim, Inc. v. Bargain Depot* (C.D.Ill.):Represented Maui Jim, which sued Bargain Depot for infringing a design patent. The court granted Maui Jim’s motion for summary judgment of infringement and validity, and awarded sanctions and costs against defendant.

### **Representative Published Decisions**

- *Nitro Distrib., Inc. v. Alticor Inc.*, 565 F.3d 417 (8th Cir. 2009)
- *Nitro Distrib., Inc. v. Alticor Inc.*, 453 F.3d 995 (8th Cir. 2006)
- *Alticor Inc. v. Ultra-Sun Technologies, Inc.*, 269 F.Supp. 2d 936 (W.D. Mich. 2003)
- *Procter & Gamble v. Haugen and Amway Corp.*, 317 F.3d 1121 (10th Cir. 2003)
- *Procter & Gamble v. Haugen and Amway Corp.*, 222 F. 3d

1262 (10th Cir. 2000)

- *Nike Inc. v. Wolverine World Wide, Inc.*, 43 F. 3d 644 (Fed. Cir. 1994)
- *Wolverine World Wide Inc. v. Nike Inc.*, 38 F. 3d 1192 (Fed. Cir. 1994)
- *Amway Corp. v. Nartron Corp.*, 29 USPQ 2d 1314 (Fed. Cir. 1993)
- *Amway Corp. v. Nartron Corp.*, 25 USPQ 2d 1944 (W.D. Mich. 1992)
- *Cuno Inc. v. Pall Corp.*, 729 F. Supp. 234 (E.D. N.Y.1989)
- *Michod v. Walker Magnetics Group Inc.*, 115 FRD 345 (N.D. Ill. 1987)
- *Dana Corp. v. American Precision Co.*, 221 USPQ 1098 (N.D. Ill. 1984)