



JACOB C. BACHMAN **SHAREHOLDER**

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EDUCATION

J.D., cum laude
The John Marshall Law School, 2007
B.S., with Honors, Mechanical Engineering
University of Illinois, 2004

BAR ADMISSIONS

Illinois
U.S. Patent & Trademark Office
U.S. Dist. Court, N.D. Illinois

Combining both litigation and patent prosecution experience, Jacob Bachman brings a 360-degree perspective to protecting and enforcing intellectual property assets. His dual focus provides a window onto how both litigators and patent prosecutors think—insights he uses for the benefit of his clients.

Jacob's practice covers a wide range of innovations including medical devices, automobile navigation and entertainment systems, insurance products, power tools, and kitchen and bath fixtures, among others. An engineer by training, Jacob takes a practical, hands-on approach to client counseling, often working directly with inventors to devise patent protection, enforcement, and avoidance strategies.

As a litigator, Jacob has been involved in all phases of trial preparation and motion practice for patent, trade secret and copyright cases. He has also prepared and defended against multiple petitions for *inter partes* review of patents before the United States Patent Office. As a prosecutor, he has devised and implemented strategies to develop portfolios in the United States and internationally. He regularly drafts patent applications as well as infringement and patentability opinions.

Jacob communicates frequently and clearly with clients to gain an understanding of their ultimate business goals. Thinking forward, he focuses on the tactics and strategies that lead most directly to those objectives, ensuring that client investment justifies the possible outcome.

EXPERIENCE | OVERVIEW

- Jacob has represented Trudell Medical International in assertion and defense of patents relating to respiratory treatment devices.
- Jacob has represented medical device leader Cook in a number of cases, including defense of a patent infringement suit filed by Boston Scientific involving gastrointestinal stent technology; and assertion of patent infringement against Endologix involving endovascular stent technology.
- He represented Progressive Casualty Insurance in high-stakes infringement litigation to protect its revolutionary Progressive Snapshot motor-vehicle monitoring technology.
- In a 16-day arbitration trial, Jacob helped Amway win an award of more than \$25 million for misappropriation of trade secrets, breach of contract, and tortious interference—an award subsequently confirmed in district court.
- Using novel defenses unique to the Internet and social media, he defended Amway against copyright infringement claims in connection with videos posted to Websites such as YouTube and Vimeo.

Biographies | Jacob C. Bachman

- On the prosecution side, Jacob secured and is expanding a portfolio of patents for a medical device technology and product line that provides OPEP therapy to treat lung disease, aid lung hygiene, and enhance lung performance.
- Donating his time pro bono, Jacob has obtained patents for solo inventors—for example, on a shower curtain expander that makes showering easier for handicapped individuals—and represented clients in multiple fair housing and eviction disputes.

EXPERIENCE | LEGAL

- **Brinks Gilson & Lione**, Chicago, Illinois
Shareholder, January 2016-Present
Associate, September 2007-December 2015
Summer Associate, May 2006-August 2006
- **Beem Patent Law Firm**, Chicago, Illinois
Law Clerk, May 2005-August 2005

EXPERIENCE | NON-LEGAL

- **Honeywell International**, Freeport, Illinois
Engineering Intern, Summer 2004
- **Baxter Healthcare**, Round Lake, Illinois
Engineering Intern, Summer 2003

EXPERIENCE | CLERKSHIPS & INTERNSHIPS

- United States District Court for the Northern District of Illinois Judicial Extern, Judge Ronald A. Guzmán, January 2006-April 2006

PRACTICE GROUPS

International Patent
Trademarks & Unfair Competition
Post-Grant Patent
Licensing
Litigation
Trade Secrets
Patent Prosecution
Copyright

AREA OF FOCUS

Green Technology
Medical Device
Mechanical
Automotive

FORWARD THINKING

Alerts

- Fed. Cir. Confirms § 271(e)(1) Safe Harbor Applies to Post-Approval Development of Clinical Data for Citizen Petition and Supplemental New Drug Application, May 22, 2015
- Real Party-In-Interest in an IPR: The PTAB's Determination is Final and Non-Appealable , October 28, 2016
- Recent Decisions In Favor Of Patent Eligibility Focus On Factual Inquiries, March 19, 2018

HONORS

- Emerging Intellectual Property Lawyer, Leading Lawyers Network, Law Bulletin Publishing Company, 2017, 2018
- Intellectual Property Law Certificate, The John Marshall Law School
- Executive Board Member, *The John Marshall Law School Review of Intellectual Property Law*, 2006-2007
- *Pi Tau Sigma*, Mechanical Engineering Honor Society

AFFILIATIONS

- American Bar Association
- Chicago Bar Association
- American Intellectual Property Law Association
- Intellectual Property Law Association of Chicago
- Rotary International

REPRESENTATIVE MATTERS

- *Monaghan Medical Corp. v. Smiths Medical ASD, Inc.* (D. Del. 2017-2018). Defending Monaghan Medical in a patent infringement suit concerning respiratory treatment devices.
- *Amway Corp. et al. v. UMG Recordings, Inc. et al.* (M.D. Fla. 2014-2017). Representing Amway entities in a breach of contract and copyright infringement action involving user-generated videos with music uploaded to social media websites.
- *Boston Scientific Corp., et al. v. Cook, Inc., et al.* (D. Mass. 2010-2017). Defending Cook entities in a patent infringement suit filed by Boston Scientific concerning gastrointestinal stents.
- *Progressive Casualty Ins. Co. v. Safeco Ins. Co. of Illinois et al.* (N.D. Ohio 2010-2012). Representing Progressive Casualty Ins. Co. in a patent infringement suit involving motor vehicle monitoring systems.
- *Cook, Inc. v. Endologix, Inc.* (S.D. Ind. 2009-2012). Representing Cook in a patent infringement suit involving endovascular stent technology.
- *Robert Bosch LLC v. Old World Industries, Inc.* (N.D. Ill. 2010). Defending Old World Industries in a patent infringement action involving automobile wiper blades.
- *Quixtar, Inc. v. Signature Management Team, et al.* (D. Nev. 2007-2010). Representing Quixtar in an action relating to misappropriation of trade secrets, breach of contract, and tortious interference.
- *Quixtar, Inc. v. Woodward, et al.* (JAMS Arbitration 2007-2010). Representing Quixtar in an action relating to misappropriation of trade secrets, breach of contract, and tortious interference. After a 16-day trial, an arbitrator awarded Quixtar over \$25 million. A district court subsequently confirmed the arbitrator's decision.