



## JAMES P. NAUGHTON **SHAREHOLDER**

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### EDUCATION

J.D., cum laude  
University of Illinois College of Law, 1981  
B.S., with highest honors, Electrical Engineering  
University of Illinois, 1978

### BAR ADMISSIONS

Illinois  
U.S. Patent & Trademark Office  
U.S. Court of Appeals, Fed. Cir.

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Jim Naughton is a senior shareholder with Brinks Gilson & Lione with over 35 years of experience in patent litigation, procurement and counseling. He has created and managed several successful client teams and currently focuses his practice on patent studies, portfolio analysis and management, and strategic advice. Jim has analyzed thousands of patents, written opinions on hundreds of patents and been deposed several times on prosecution and opinion matters.

Jim has extensive experience in diverse technical fields such as medical devices, vehicle navigation and audio, athletic footwear and apparel, e-commerce and financial services, LEDs, vehicle transmissions, machine tools and printing equipment. Emphasizing client service, he understands the client's business and provides high-value strategic analysis that meets the client's practical business needs. Jim is also sensitive to client cost constraints and has partnered with clients to implement creative alternative fee arrangements successfully.

### EXPERIENCE | OVERVIEW

- *MercExchange v. Overture*. Represented defendant in “rocket docket,” patent litigation involving Internet search engines.
- *Information International v. Adobe Systems and Apple Computer*. Represented plaintiff in patent litigation involving electronic character generation, including five week trial and Federal Circuit appeal. [Represented plaintiff in prior related cases, *Information International v. Compugraphic* and *Rockwell International v. Allied*]
- *A.G. für Industrielle Elektronik (AGIE) v. Sodick*. Represented plaintiff in federal court patent infringement action and companion ITC action (In re Certain Wire Electrical Discharge Machining Apparatus And Components Thereof), including two-week ITC hearing. Technology involved electric discharge machine tools. [Represented AGIE in prior related cases, *AGIE v. Mitsubishi Electric* and *Colt Industries v. AGIE*
- *Zenith v. AMP*. Represented defendant in patent litigation involving computer touch screens.
- *London v. Samsonite*. Represented plaintiff in Federal Circuit appeal; took over case following loss in the trial court.

### EXPERIENCE | LEGAL

- **Brinks Gilson & Lione**, Chicago, Illinois  
1993-Present
- **Roper & Quigg**, Chicago, Illinois  
Founding Partner, 1990-1993

- **Neuman, Williams, Anderson & Olson**, Chicago, Illinois  
1981-1990; Partner 1986-1990

#### **PRACTICE GROUPS**

Litigation  
Licensing  
Post-Grant Patent  
Patent Prosecution

#### **AREA OF FOCUS**

Electrical & Computer  
Medical Device  
Green Technology

#### **FORWARD THINKING**

##### **Alerts**

- Federal Circuit Confirms Patent Agent Privilege, March 08, 2016
- Adequacy of Explanation Remains Key Area of PTAB Reversal, January 03, 2019

##### **Presentations**

- The Best Lawyers in America, Patent Law, 2020
- "Patent Fundamentals," Boston, Massachusetts, March 2016
- "Current Topics In U.S. IP Law," Japan, September 2014
- "Post-Grant Proceedings In The USPTO For Patent Correction And Validity Challenges," Japan, December 2013
- "America Invents Act: Impact And Strategy," various venues, 2012-2013
- Manufacturing and Clean Technology Luncheon, Chicago, Illinois, February 2012
- "The America Invents Act -- It's Time For A Change!," October 2011
- "Patent Specification Requirements Under 35 U.S.C. §112(1)," Presenter, Japan, October 2010
- "What's Not Going to Work Anymore: Effective Pricing Strategies for the 'New' Economy," The 17th Annual Law Firm Marketing Partner Forum 2010, Palm Beach, Florida, January 2010
- Midwest Clean Tech 2009 Conference and Exhibition, Chicago, Illinois, November 2009
- Green Technology, The Nanotechnology Seminar & NanoBusiness Alliance Meeting, Chicago, Illinois, December 2009
- "Adapting your IP Strategy to the New Economic Environment," The 2009 NanoBusiness Conference, Panelist, Chicago, Illinois, September 2009

#### **HONORS**

- *The Best Lawyers in America*, Patent Law, 2010-2019
- Illinois Super Lawyers, Intellectual Property Law, 2005-2009, 2011-2013, 2016-2017
- Leading Intellectual Property Lawyer, *Leading Lawyers Network*, Law Bulletin Publishing Company, 2004, 2005, 2007, 2009-2014, 2016

#### **AFFILIATIONS**

- American Bar Association
- American Intellectual Property Law Association
- Chicago Bar Association
- Institute of Electrical and Electronics Engineers

### TECHNICAL BACKGROUND

- Analog Electronics
- Business Methods
- Semiconductors
- Software

### REPRESENTATIVE MATTERS

- *MercExchange v. Overture*. Represented defendant in “rocket docket,” patent litigation involving Internet search engines.
- *Information International v. Adobe Systems and Apple Computer*. Represented plaintiff in patent litigation involving electronic character generation, including five week trial and Federal Circuit appeal. [Represented plaintiff in prior related cases, *Information International v. Compugraphic and Rockwell International v. Allied*]
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