

ALLAN J. STERNSTEIN

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CAREER SUMMARY

Broad experience in all areas of Intellectual Property over the past forty years, with particular emphasis in patent litigation, licensing and client counseling. Currently Director of the IP Clinic at the University of Arizona James E. Rogers School of Law, and Professor of Intellectual Property teaching classes in Patent Law, Patent Litigation, IP Law, and Clinical IP Practices. Forty years in private practice including Assistant Chair of IP Division and Head of IP Litigation at Lathrop & Gage, Director of Intellectual Property Law and IP Litigation Department at Dykema Gossett, and managing partner at Brinks Hofer Gilson & Lione. Also served as Division Patent Counsel for Abbott Laboratories. Most recent prior teaching experience as an adjunct professor and lecturer for courses in patent law and patent litigation at the University of Illinois College of Law; Oxford University, UK; and the University of Victoria, Canada.

ACCOMPLISHMENTS

- * Participated in and tried cases in Federal District Courts throughout the United States and have argued before Federal and State courts of appeal including the Court of Appeals for the Federal Circuit.
- * Prepared and presented the damages portion of a patent infringement action before a jury obtaining a record setting \$102 million damages verdict and a final judgment, including punitive damages and interest, of \$165 million.
- * Chaired committee responsible for drafting Local Patent Rules for the Northern District of Illinois.
- * Experience as a mediator, arbitrator, and expert witness.
- * Extensively published, lectured and taught classes relating to patents and patent litigation.

EMPLOYMENT in PRACTICE OF LAW

Lathrop & Gage (Partner) (Asst. Divn. Chair of National IP Division, Head of IP Litigation)	2013-2017
Dykema Gossett PLLC (Partner) (Director of National IP/IP Litigation Dept.)	2005-2013

Brinks Hofer Gilson & Lione (shareholder) (COO/managing partner)	1987-2005 1996-1999
Abbott Laboratories (Division Patent Counsel)	1984-1987
Neuman, Williams, Anderson & Olson (associate, partner)	1976-1984
Sunbeam Corporation (law clerk, patent agent)	1973-1976

TEACHING EXPERIENCE

- Director, Professor of Intellectual Property, University of Arizona, Tucson, AZ (2015-present)
(Director of IP Clinic, Professor of Intellectual Property teaching classes in Patent Law, Patent Litigation, IP Law, and Clinical IP Practices)
- Adjunct Professor, University of Illinois, Champaign-Urbana, IL (1992-2015)
(teaching classes in Patent Litigation, Patent Law, and Patent Prosecution)
- Lecturer/Instructor, St. Peter's College, Oxford University, United Kingdom (2003)
(program on International IP Law, responsible for classes on US Patent Law and Litigation)
- Lecturer/Instructor, University of Victoria, British Columbia, Canada (2002)
(program on International IP Law, responsible for classes on US Patent Law and Litigation)
- Lecturer/Instructor, National Science and Technology Development Agency, Chulalongkorn University, Bangkok, Thailand (1994)
- Adjunct Professor, DePaul University, Chicago, IL (1990-1992)
(teaching classes in Patent Law)
- Adjunct Professor, John Marshall School of Law, Chicago, IL (1989-1990)
(teaching classes in Patent Law)

EDUCATION

- Loyola University, School of Law, Chicago, IL, J.D., 1977
University of Michigan, Ann Arbor, MI, M.S.E., 1972
University of Illinois, Champaign-Urbana, IL, B.S.A.A.E. w/Honors, 1970

ADMITTED TO PRACTICE

- Illinois
U.S. Court of Appeals, 7th Circuit
U.S. Court of Appeals, 5th Circuit
U.S. Court of Appeals, Federal Circuit

U.S. District Court, Northern District of Illinois, including Trial Bar
U.S. District Court, Central District of Illinois
U.S. District Court, Eastern District of Texas
U.S. District Court, Eastern District of Michigan
U.S. District Court, Western District of Michigan
U.S. District Court, Eastern District of Wisconsin
U.S. District Court, Northern District of Ohio
U.S. Patent and Trademark Office

HONORS / RECOGNITIONS

- Recognized in *The Best Lawyers in America*®
- Named an Illinois Leading Lawyer by the *Leading Lawyers Network*
- Named an Illinois Super Lawyer for Intellectual Property Litigation by *Law & Politics*
- Named one of the Leading American Attorneys in the area of intellectual property and computer law by the American Research Corporation
- Listed in Who's Who in Science and Engineering
- Listed in Who's Who in American Law
- Listed in Who's Who in America
- Listed in Who's Who in the World

PROFESSIONAL ACTIVITIES AND PUBLICATIONS

A. Seminars, Speeches

Panel Speaker, *Intellectual Property - Trade Secrets*, International Association of Korean Lawyers 18th Annual Conference, Chicago (2010)

Panel Speaker, *Working with Local Patent Rules*, The John Marshall Law School, Chicago (2010)

Speaker, "Emerging IP Trends in Mergers & Acquisitions," Dykema Gossett Seminars (2006)

Speaker, *Calculating & Proving Patent Damages*, Law Seminars International, Chicago (2005)

Speaker, "Assessing and Proving Damages in Patent Cases," Seminar, The John Marshall Law School (1998)

Speaker, "Patent Licensing Agreement Provisions," Chicago Bar Association (1997)

Speaker, "Efficient and Effective Damages Discovery," LES Annual Meeting (1995)

Speaker, "Alternative Dispute Resolution - Case Studies," Brinks Hofer 75th Anniversary Seminar (1992)

B. Publications

Author, "Patent Holders Score Victories in Qui Tam Lawsuits," *InsideCounsel* magazine, August 24, 2010

Author, "Considerations When Filing Patent Infringement Claims," *InsideCounsel* magazine, August 10, 2010

Author, "Baseless Trademark Suits," *InsideCounsel* magazine, July 13, 2010
Author, "Patent Case Damages are in Decline," *InsideCounsel* magazine, June 29, 2010
Author, "The Ethos, Logos and Pathos of Patent Cases," *InsideCounsel* magazine, June 15, 2010
Author, "The Shrinking Lure of the Eastern District of Texas," *InsideCounsel* magazine, June 1, 2010
Author, "Federal Circuit's Ariad Decision Important to Patent Community," *InsideCounsel* magazine, May 18, 2010
Author, "Are Significant Patent Damages Being Overlooked?," *The National Law Journal* (2006)
Principal Author, "The Changing Tides in Patent Infringement Damages," *2003 Intellectual Property Law Update*, Aspen Publishers (2003)
Principal Author, "Increasing Trends in Patent Infringement Damages," *1998 Wiley Intellectual Property Law Update* (1998)
Principal Author, "Reaching for the Sky and Beyond—Patent Infringement damages are set to get higher in the United States," *Managing Intellectual Property* (March 1997)
Principal Author, *Designing an Effective Intellectual Property Compliance Program*, Clark Boardman Callaghan (1993; updated annually)

C. Judicial Engagements

Arbitrator, Circuit Court of Cook County (1996-1998)

D. Memberships

Member, Intellectual Property Owners Association (IPO) (past Damages Committee vice-chairman)
Member, American Intellectual Property Law Association (AIPLA)
Member, Intellectual Property Association of Chicago (IPLAC)(Chairman, Patent Local Rules Subcommittee, Litigation Committee, responsible for drafting Local Patent Rules being implemented in N.D.Ill.)
Member, American Bar Association (ABA)
Member, Chicago Bar Association (CBA)
Member, Richard Linn Inn of Court

REPRESENTATIVE CASES and TECHNOLOGIES (clients in italics)

In the Matter of Certain Vision-Based Driver Assistance System Camera, Components Thereof, and Products Containing Same; *TRW Automotive US*, Respondent (U.S. International Trade Commission, 2015); unfair trade practices involving claims of patent infringement relating to vehicle vision systems, won in ITC trial and before full Commission.

TRW Automotive US v. Magna Electronics (W.D.Mi. 2013). Patent infringement action relating to vehicle vision systems; settled.

Arvegenix LLC v. Pennycress Energy Co (C.D.Ill. 2013). Tortious interference, unfair competition, deceptive business practices case relating to biofuel technology and, in particular, field pennycress; settled.

Scholle Corp. v. Rapak (N.D.Ill.) 2013). Patent infringement action relating to collapsible bags and associated spout, settled after obtaining/winning preliminary injunction.

Intellectual Ventures v. Fifth Third Bank (C.D. Ohio 2013). Patent infringement action under five patents relating to software and/or Internet methods of operation; obtained dismissal with prejudice on all patents.

Traffic Information v. Fifth Third Bank (E.D.Tx. 2013). Patent infringement action relating to software and/or Internet methods of operation; settled.

Unified Messaging Solutions v. Fifth Third Bank (N.D.Ill. 2013). Patent infringement action relating to software and/or Internet methods of operation; pending.

Magna Electronics v. TRW Automotive US (W.D.Mi. 2013). Patent infringement action relating to vehicle vision systems; settled.

Magna Electronics v. TRW Automotive US (W.D.Mi. 2012). Patent infringement action relating to vehicle vision systems; settled.

Tellabs v. Fujitsu (N.D.Ill.) - Mediator; obtained settlement

Phoenix v. Fifth Third Bank (E.D.Tx. 2012). Patent infringement action relating to software and/or Internet methods of operation; settled.

Scholle Corp. v. Liqui-Box (N.D.Ill. 2012). Patent infringement action relating to collapsible bags; settled.

Liqui-Box v. Scholle Corp. (D.Del. 2012). Won dismissal for lack of personal jurisdiction.

Stambler v. Fifth Third Bank (E.D.Tx. 2012). Patent infringement action relating to software and/or Internet methods of operation; settled.

TuitionFund v. Fifth Third Bank (M.D.Tenn. 2011). Patent infringement action relating to software and/or Internet methods of operation; settled.

Data Treasury Corp. v. Fifth Third Bancorp et. al. (E.D.Tx. 2011). Patent infringement action relating to image-based check processing; settled.

Body Science LLC v. Boston Scientific Corp, Philips Electronic N Amer., et. al. (N.D.Ill. 2011). Patent infringement action relating to wireless medical monitors, settled.

Linde LLC v. Cryogenic Systems Equipment, Inc. (N.D.Ill. 2010). Patent infringement action relating to refrigeration conveyor belt; settled.

GeoTag, Inc. v. Fifth Third Bancorp, et. al. (E.D.Tx. 2010). Patent infringement action relating to online systems for associating identified locations with geographic areas; settled.

Elite Outdoors LLC v. Strother Archery, Inc. et al. (W.D. N.Y. 2009), misappropriation of trade secrets

action relating to archery bows, settled.

Furtsperson, Inc. v. *Iscopeia Software, Inc.* (N.D. Ill. 2009), misappropriation of trade secrets action relating to software platform for interview testing processes; settled after filing counterclaims seeking preliminary injunction

Restricted Spending Solutions, LLC v. *Fifth Third Bancorp*, et al (N.D.Ill. 2009), patent infringement action relating to credit card systems and method of processing same; settled.

TSERA, Inc. v. *Bang & Olufsen America, Inc.* et al (E.D. Tx. 2009), patent infringement action relating to touchpad controls for electronic systems; settled.

Scholle Corp. v. Rapak Corp. (N.D. Ill. 2009), patent infringement action relating to plastic bags; settled.

Bemis Manufacturing Co. v. *Centoco Plastics Ltd.* (E.D. Wis. 2008), patent infringement action relating to manufacturing processes; settled.

In the Matter of Certain Silicon Microphone Packages and Products Containing Same, *Knowles Electronics LLC*, Complainant (U.S. International Trade Commission, 2008), unfair trade practices involving patent infringement relating to silicon microphones used in cell phones, won in ITC trial, affirmed by full Commission.

FM Industries, Inc. v. *Citicorp Credit Services, Inc.* et al. (N.D.Ill. 2007), copyright infringement action relating to software processing.

ADC Communications, Inc. v. *Panduit Corp.* (D.MN, 2007), patent infringement action relating to fiber and electronic cable routing products.

Phoenix IP, LLC v. *Square D Company*, et al. (E.D. Tx. 2007), patent infringement action relating to software used in power meters.

Meyer Corp. v. Bodum, Inc. (N.D. Ill. 2006); patent infringement action relating to milk frothers.

Square D Company v. E.I. Electronics, Inc. (N.D. Ill. 2006), patent infringement action involving 15 patents relating to power meters; settled after favorable Markman ruling.

Knowles Electronics, LLC v. American Audio Components, et al. (N.D. Ill. 2006), misappropriation of trade secrets action relating to silicon MEMS microphones for cell phones; settled.

Textron Innovations Inc. v. *Fairplay Electric Cars* (S.D. Georgia 2006), design patent infringement action relating to golf carts; settled.

Calphalon Corp. v. *Meyer Corp.* (E.D. Calif 2005), design patent infringement action relating to cookware, won jury trial.

Motorola, Inc. and *GMP/Wireless Medicine, Inc.* v. Nonin Medical, Inc. (N.D. Ill. 2004), patent infringement action relating to wireless medical monitors; settled.

Optivus Technology, Inc. and Loma Linda University v. Ion Beam Applications S.A. (C.D. Calif. 2004), patent infringement action relating to proton beam therapy systems.

Motorola, Inc. and GMP/Wireless Medicine, Inc. v. Welch-Allyn Protocol, Inc. (N.D. Ill. 2004), patent infringement action relating to wireless medical monitors; settled.

Manitowoc Cranes, Inc. v. Liebherr-America, Inc. (E.D. Wis., 2003); patent infringement action relating to a control and hydraulic system for liftcranes; settled.

A.L. Hansen Manufacturing Co. v. Bauer Products, Inc. (N.D.Ill. 2003); patent infringement action relating to support arm for lids over pick-up truck beds; settled.

Optobionics v. Peyman (N.D. Ill. 2002); misappropriation of trade secrets, breach of contract, Lanham Act violation relating to artificial retina devices; settled.

Peyman v. Optobionics (E.D. La. 2002); declaratory judgment breach of contract action relating to artificial retina devices; won dismissal of case on motion for abuse of Declaratory Judgment Act and in favor of later filed Illinois action.

Technical Concepts v. Zurn (W.D.Pa. 2002); patent infringement action relating to automatic flush valve assemblies; settled.

Technical Concepts v. Zurn (W.D.Pa. 2002); declaratory judgment action relating to automatic flush valve assemblies, and corresponding patent infringement action, *Zurn v. Technical Concepts* (W.D.Pa. 2002); settled.

Zurn v. Sloan Valve Company (W.D.Pa. 2002); patent infringement action relating to automatic flush valve assemblies ; settled.

Borg-Warner v. New Venture Gear (N.D. Ill., 2000); patent infringement action relating to 4WD automobile transfer cases; settled.

Multi-Tech v. VocalTec Communications Inc. (D. Minn., 2000): patent infringement action relating to voice over Internet technology; settled.

Prototype Equipment v. Fallas Automation (N.D. Ill., 2000); patent infringement action relating to equipment for positioning and placing articles in containers; won temporary restraining order and preliminary injunction leading to settlement.

Panduit v. Band-It IDEX (N.D. Ill., 2000); patent infringement action relating to bundling straps; won preliminary injunction, affirmed on appeal; permanent injunction obtained on summary judgment.

Coca-Cola v. Liqui-Box (N.D. Georgia, 1999); patent infringement action relating to collapsible containers; obtained permanent injunction after patent found valid and infringed.

Varis Corporation v. Scitex Digital Printing, Inc., (S.D. Ohio, 1999): patent infringement action relating to high speed printing equipment and processing; settled.

Champion International Corporation v. Honeywell-Measurex Corporation (mediation, 1999): mediator for patent infringement action relating to monitoring systems for continuous manufacturing processes

FF Acquisition Corp. v. Icon Fitness Corp. (N.D. Miss. 1999): patent infringement and antitrust action relating to treadmills; settled.

Smiths Industries Aerospace & Defense Systems Inc. v. Simmonds Precision Products, Inc. (S.D. Calif., 1999): declaratory judgment action for misappropriation of trade secrets, breach of contract, copyright infringement relating to Health and Usage Management Systems (HUMS) for helicopters; settled.

Lund Industries, Incorporated v. Auto Ventshade Company (D. Minn., 1998): patent infringement action relating to vehicle shield; settled.

S.C. Johnson Commercial Markets, Inc. v. The B.F. Goodrich Company (W.D. Wis., 1998): patent infringement action relating to graphic arts polymer coatings; settled

Simmonds Precision Products v. Global Associates, Ltd. (D. Md., 1998): misappropriation of trade secrets, breach of contract, copyright infringement relating to Health and Usage Management Systems (HUMS) for helicopters; settled.

Circadian Pharmaceuticals (Australia) Pty Limited v. Eli Lilly and Company (The Supreme Court of Victoria at Melbourne, 1997): expert witness on United States patent practices.

Autonomous Technology Corp. v. VISX, Inc. et al. (D. Del., 1996): patent declaratory judgment action relating to excimer laser system and processes for Photorefractive keratectomy (PRK) eye surgery; settled.

Discovision Associates v. Disc Manufacturing Inc., and DLC Manufacturing, Inc., v. Pioneer Electronic Corp. et al. (D. Del., 1995): consolidated cases of patent infringement and antitrust violations relating to compact discs and CD encoding and mastering system; settled.

Square D Company v. Power Measurement Ltd. (D. Del., 1995): patent infringement action relating to power monitors, with antitrust and unfair competition counterclaims; settled.

Viskase Corp. v. American National Can Company (N.D. Ill., 1993): patent infringement action relating to heat shrinkable plastic films; prepared and presented damages case, winning record setting \$102.3 million jury verdict, increased to \$164.9 million judgment including enhanced damages and prejudgment interest.

Carabillo v. Norm Thompson Outfitters [Hartmarx Corp.] (D. Oregon, 1993): patent infringement action relating to trouser construction; case won/dismissed on summary judgment.

Herman Miller, Inc. v. Teknion (N.D. Ill., 1993): patent infringement action relating to office wall panels; settled.

Facility Management Systems v. DataFlo (D. Neb., 1993): patent infringement action relating to security monitoring devices; settled.

Wolverine v. NIKE (W.D. Mich., 1993): patent infringement action relating to shoe design; case won/dismissed on summary judgment.

Haworth v. Herman Miller, Inc. (W.D. Mich., 1992): patent infringement action relating to office wall panels; settled.

BFGoodrich Flightsystems v. Insight Instruments (S.D. Ohio, 1992): patent infringement action relating to stormscope radar devices; settled.

Laser Pacific v. Encor Video (C.D. Calif., 1991): patent infringement action, with antitrust, RICO, Lanham Act counter-claims; settled.

Kelsey-Hayes v. Motor Wheel Corp. (W.D. Mich., 1990): patent declaratory judgment action relating to steel wheel construction; settled.

W. R. Grace & Company v. Viskase Corp. (N.D. Ill., 1990): patent infringement action relating to patched bags; settled.

ALCOA v. Reynolds Metals Co. (N.D. Ill., 1988): patent infringement action relating to aluminum formulations; patent held valid and infringed after jury trial.

Thomas & Betts v. AMP (D. N.J., 1988): patent infringement action relating to electrical connectors; settled.

Atari v. Taito (N.D. Ill., 1987): copyright infringement action; settled.

Kasper v. I-Tech (N.D. Ill., 1987): patent infringement action relating to hockey helmets; case won/dismissed after motion for lack of personal jurisdiction.

Rolls-Royce, Renishaw v. Daishowa Seiki Co. (E.D. Mich., 1987): patent infringement action relating to machine sensors; settled.

Kaken v. Eli Lilly (S.D. Ind., 1986): breach of contract action; settled.

Williams & Humbert v. Ruiz Mateos (D. D.C., 1985): trademark valuation and ownership; won at trial.

Baxter v. Abbott Laboratories (N.D. Ill., 1985): patent infringement action relating to peritoneal dialysis procedure; settled.

M.I.T. v. Abbott Laboratories (D. Mass., 1983): patent infringement action relating to amino acid feeding procedures; settled.

Information International Inc. v. Compugraphic (C.D. Calif., 1983): patent infringement action relating to computerized photo-typesetters; settled.

Moore v. Stewart (W.D. Ark., 1982): design patent infringement action relating to toy train whistle; won at trial, with finding of patent validity and infringement.

Precision-Cosmet v. Surgidev (D. Minn., 1982): patent infringement action relating to intra-ocular lenses; settled.

Rockwell v. Eltra (C.D. Calif., 1981): patent infringement action relating to computerized phototypesetters; settled.

W. R. Grace & Co. v. Union Carbide Corp. (N.D. Ill., 1978): patent infringement action relating to layered, oriented polymer bags; settled.

Schumann v. IPCO (Ill. Circuit Court, 1978): trade secrets; case won/dismissed on summary judgment, affirmed on appeal.

EMI v. Ohio Nuclear (N.D. Ohio, 1976): patent infringement action relating to CAT scanners (EMI's inventor and Ohio Nuclear's expert witness later shared Nobel prize in Medicine); settled.