



## Jeremy R. Kriegel

Partner and Prosecution Practice Chair

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Jeremy R. Kriegel is listed in *Chambers USA* as a "key individual" at Marshall, Gerstein & Borun. *Chambers 2013* praises the "thorough[ness] in his consideration of the issues and their potential impact on his client's business," and his "innovative insight and creative solutions." *Chambers 2012* says he "is known for his work in medical device patents. He is well-respected by his peers for his expertise in patent prosecution." Mr. Kriegel reliably guides clients in such industries as medical devices and consumer products, across all phases of the product life-cycle. His clients find he readily grasps complex IP rights and business issues, building from his training in mechanical engineering. Detail-oriented by nature, he navigates clients toward optimal business positions through careful counsel and forward-thinking intellectual property strategies.

Mr. Kriegel has been named an "IP Star" in *Managing IP's* 2016 *IP Stars Survey* (fka the *World IP Handbook and Survey*). He was also selected as a "Leading Lawyer" by the Law Bulletin Publishing Company.



### Practices

- Design Patents
- Patent Prosecution

### Industries

- Cleantech & Renewables
- Consumer Products
- Industrial & Mechanical Technologies
- Medical Devices

## Representative Experience

Mr. Kriegel secured numerous patents for a global innovator of automated bottling, labeling, and quality control systems. He coordinated patent applications on consumer packaging and injection molding innovations for a Fortune 100 company. He has also counseled several medical device developers and manufacturers through patent application processes and freedom to practice issues, carefully guiding the companies in the protection of significant advancements in catheters, orthopedic devices, breastpumps, and ostomy products. As a result, they were able to bring to market products that have helped many people realize increased comfort and dignity after surgery, as well as an improved quality of life. In addition, he served as patent interference counsel in cases ranging from paper shredders to window shade pull devices and steered an industry-leading maker of injection-molded components for drainage, septic tank components, construction and consumer products through a myriad of patent, trademark, copyright and trade secret issues, from early design through product launch and beyond. In balancing patentable opportunities with infringement clearance concerns, he eased this innovative company's products' route to significant market successes.

Mr. Kriegel has also guided company innovations in such areas as:

- Intravenous drug delivery systems
- Dental instruments
- Gravity-feed shelving
- Furniture components
- In-line bottling technology
- Ink jet printing technology
- Meat processing equipment
- Fluid control systems
- On-site waste systems
- Retail displays
- Railcar decking and door hangers
- Consumer products
- Hardware
- Manufacturing equipment technology

## Background and Credentials

Jeremy R. Kriegel prepares and prosecutes U.S. and foreign patents in a wide range of mechanical technologies. He also helps lead companies' products to market by counseling on patent and trademark infringement, licensing, patent validity, right-to-make issues, and product marking. In addition, he is experienced in patent and trademark licensing, trademark litigation and prosecution matters, as well as Internet domain name disputes.

He has also represented clients in patent litigation matters, including participation in all phases of discovery, *Markman* hearings, and settlement negotiations.

His approach to securing patents begins with solid analysis and attention to detail. Then he leads clients through the process, simplifying complex issues for them. He works closely with them all along the way, being easily accessible to clients and helping them avoid pitfalls and realize commercial advantages within the nuanced, ever-changing world of intellectual property law.

He received his J.D. in 1995 from Washington University School of Law (St. Louis, MO). He received his B.S., with distinction, in Mechanical Engineering and a Certificate in Management Studies, with a concentration in Public Sector

Analysis, from the University of Rochester (Rochester, NY) in 1992, where he was inducted into the honors society *Tau Beta Pi*. While in law school, Mr. Kriegel served on the law review editorial board as Notes and Comments editor for the *Washington University Journal of Urban and Contemporary Law*, and served as a law clerk to the Hon. Edward M. Thomas of the Wayne County Circuit Court in Detroit.

## Education

- Washington University School of Law (J.D.)
- University of Rochester (B.S., *distinction*)
  - Mechanical Engineering
- University of Rochester
  - Certificate in Management Studies, public sector analysis

## Bar Admissions

- Illinois
- Michigan
- U.S. Court of Appeals, Federal Circuit
- U.S. Court of Appeals, Seventh Circuit
- U.S. Patent and Trademark Office

## Publications and Presentations

May 2017

### **"Through the Looking Glass" (featured quotes)**

*Chicago Lawyer Magazine*

December 2, 2016

### **"New EPO Requirements Regarding Patent Assignments"**

*Marshall Gerstein Alert*

October 18, 2016

### **"IP Basics for New Attorneys and Non-IP Attorneys"**

*CBA Introduction to Patent, Trademark, and Copyright Law Seminar*

May 10, 2016

### **"Hague Design Filings: Procedures and Strategies"**

*Cincinnati Intellectual Property Law Association*

February 17, 2016

### **"Breakfast Briefings 2016"**

*Illinois Manufacturers' Association*

November 18, 2015

### **"Legal Issues"**

*AUTM Business Development Course – Medical Devices*

October 7, 2015

**"US patent owners, get ready for the UPC"**

*World Intellectual Property Review*

June 5, 2015

**"Non-Patent IP Protection – There's More Than One Way to Skin a Cat"**

*University of Michigan Early Tech Development Program – Ann Arbor, Michigan*

May 7, 2015

**"Design Protection Under the Hague Agreement"**

*Mountain View, California*

March 26, 2015

**"Paths to Allowance – US After-Final Patent Prosecution Strategies"**

*Munich, Germany*

November 13, 2014

**"Avoiding Patent Prosecution Pitfalls Under *Edward Lifesciences v. Cook Medical*, and the AIA"**

*Association of University Technology Managers (AUTM) Business Development Course - Medical Devices*

March 3, 2014

**"5 Ramifications of USPTO Patent Owner ID Requirements"**

*Law360*

January 2014

**"IP Treaty Implementation – Answers to the Questions Patent Administrators Should be Asking"**

*Association of Legal Administrators webinar*

September 2013

**"The America Invents Act at Two Years"**

*Speaker at Association of Legal Administrators IP Retreat (Maryland)*

September 2012

**"The America Invents Act – What Patent Administrators Need to Know"**

*Keynote speaker at Association of Legal Administrators IP Retreat*

July-August 2012

**"Strategies to leverage Chinese patent subsidies"**

*Intellectual Property Magazine*

April 2012

**He lectured in London, UK and Munich, Germany in April 2012 on post-grant review under the America Invents Act.**

March 6, 2012

**"Is the Patent Office trying to price the AIA out of existence? - Drastic fee increases would discourage use of intended improvements to U.S. patent system"**

*InsideCounsel*

February 7, 2012

**"5 considerations when served with a post-grant review petition - Post-grant review under the America Invents Act—a new patent battlefield"**

*InsideCounsel*

January 10, 2012

**"First to File - It's Not Just a Race to the Patent Office - As March 16, 2013 Approaches, The America Invents Act Will Alter Patent Filing Strategies"**

*InsideCounsel*

December 15, 2011

**"IP: We passed the America Invents Act - what next?"**

*InsideCounsel*

November 15, 2011

**"We Passed the America Invents Act - Now What? - Five Tips To Help Companies Prepare For The Impending Implementation Of The AIA's Provisions"**

*InsideCounsel*

February 23, 2011

**"All Aboard For Post-Grant Patent Review In Detroit"**

*Law360*

January 2011

**"Five Benefits for Midwest Businesses from a Satellite US Patent Office"**

*Corp! Magazine*

September 2010

**Jeremy R. Kriegel shares a glimpse of his non-lawyer side**

*Chicago Lawyer*

8/25/2010, 8/26/2010

**"Patent Abstracts Are Not the Answer To Repatriating Jobs"**

*Patently-O, LexisNexis Patent Law Community Blog, The Wall Street Journal Guest Post and Advanced Biofuels Newsletter*

July 9, 2010

**"5 Tips For Managing A Complex Patent Portfolio"**

*Law360*

January 1, 2010

**"A Close Shave – In A 2-1 Decision, Gillette Gets A Second Chance At A Preliminary Injunction Against The Quattro® Razor"**

*"IP Law 360" – the "Newswire for IP Professionals"*

May 1, 2009

**“What You Need to Know About IP To Help Your Business Grow and Thrive”**

*America-Israel Chamber of Commerce, Young Entrepreneurs Forum*

April 28, 2009

**“Anatomy of a Patent Prosecution File History – Litigation Lessons from a Patent Prosecutor’s Desk”**

*Chicago Bar Association’s Intellectual Property Law Committee*

## **Community and Professional Involvement**

- He has twice co-chaired the Chicago Bar Association's national moot court competition.
- A volunteer for the Chicago Intellectual Property Alliance (CIPA), Mr. Kriegel mentored law students interested in careers in intellectual property law and also judges high school science students on behalf of CIPA at the Chicago Science Fair.
- A volunteer practicing attorney “coach” for the Chicago Committee LegalTrek program in which he mentored college students from historically underrepresented groups, helping them to develop and hone contract negotiation techniques while encouraging them to attend law school and pursue careers in the legal profession.

## **Representative Matters**

*Advanced Interactive v. Matsushita, Thomson Consumer Electronics,\* et al.* (local counsel)

U.S. District Court, Northern District of Illinois

Case Type(s): Patent Infringement

Area(s) of practice: Electrical Arts/Computer Software

*American Drillbox\* v. Beckett*

U.S. District Court, Eastern District of Michigan

Case Type(s): Patent Infringement

Area(s) of practice: Mechanical Arts

*ASC Machine Tools, Inc. v. The Bradbury Company\**

U.S. District Court, Eastern District of Washington

Case Type(s): Trade Secrets

Area(s) of practice: Trade Secrets, Mechanical Arts

*Belden Wire & Cable v. Cable Design Technologies, Inc.\*(local counsel)*

U.S. District Court, Northern District of Illinois

Case Type(s): Patent Infringement

Area(s) of practice: Mechanical Arts

*Black & Decker, Inc. v. The Coleman Company\**

U.S. District Court, Eastern District of Virginia

Case Type(s): Trade Secrets

Area(s) of practice: Trade Secrets, Mechanical Arts

*Cutting Edge Technology LLC v. Paradise Dental Technologies and Hu-Friedy Mfg. Co., Inc.\**

U.S. District Court, Southern District of Texas

Case Type(s): Patent Infringement

Area(s) of practice: Mechanical Arts

*Domestic Fabrics Corp. v. Sears, Roebuck and Co.\**

U.S. District Court, Eastern District of North Carolina

Case Type(s): Patent Infringement

Area(s) of practice: Mechanical Arts

*Hu-Friedy Mfg. Co., Inc.\* v. J&J Instruments, Inc.*

U.S. District Court, Northern District of Illinois

Case Type(s): Patent Infringement

Area(s) of Practice: Mechanical Arts

*International Bay Clubs, Inc. v. Tone Products, Inc.\**

Trademark Trial and Appeal Board

Case Type(s): Opposition

Area(s) of practice: Trademarks

*Intervisual Communications, Inc. v. One Up, Inc., et al.\**

U.S. District Court, Northern District of Illinois

Case Type(s): Licensing

Area(s) of practice: Intellectual Property Transactions, Mechanical Arts

*Jefferson\* v. City of Chicago, et al.*

U.S. District Court, Northern District of Illinois

Case Type(s): General Civil Litigation

*Lai v. Palmer (Newell Window Furnishings)\**

Board of Patent Appeals and Interferences of US Pat. & TM Office

Case Type(s): Patent Interference

Area(s) of practice: Mechanical Arts

*Manders, M.D.\* v. McGhan, et al.*

U.S. District Court, Western District of Pennsylvania

Case Type(s): Patent Infringement

Area(s) of practice: Mechanical Arts

*Matlin (Fellowes) v. Aries (ACCO Brands)\**

Patent Trial and Appeal Board of US Pat. & TM Office

Case Type(s): Patent Interference

Area(s) of practice: Mechanical and electrical arts

*Schnadig Corp.\* v. International Furniture*

U.S. District Court, Northern District of Illinois

Case Type(s): Trademark Infringement

Area(s) of practice: Trademarks

*SmithKline Beecham, Inc. v. STS Overseas Trading LLC\**

Trademark Trial and Appeal Board

Case Type(s): Opposition

Area(s) of practice: Trademarks

*Tuf-Tite, Inc.\* v. Federal Package, Inc.*

U.S. District Court, Northern District of Illinois

Case Type(s): Patent Infringement (declaratory judgment)

Area(s) of practice: Mechanical arts

*Tuf-Tite, Inc.\* v. Polylok, Inc., et al.*

U.S. District Court, Northern District of Illinois

Case Type(s): Patent Infringement

Area(s) of practice: Mechanical Arts

*Ty, Inc. v. Salvino, et al. (local counsel)\**

U.S. District Court, Northern District of Illinois

Case Type(s): Copyright Infringement

Area(s) of practice: Copyrights

\*Party Represented