



Donald W. Rupert

Of Counsel

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With 40 years of experience, Donald W. Rupert has handled well over 100 IP litigation matters in the chemical, consumer products, heavy equipment, pharmaceutical, and computer industries. He has been lead trial counsel in jury and bench trials and lead appellate counsel in IP appeals; he also has acted as lead IP attorney in commercial transactions having a cumulative value of over \$15 billion. Mr. Rupert has handled the prosecution and defense of patent and trademark infringement cases for major manufacturers of heavy machinery, consumer goods, and sporting equipment, has developed a successful licensing strategy for a U.S. company relating to the world-wide distribution and use of dietary supplements, and has acted as an arbitrator in intellectual property and attorney fee disputes.

Mr. Rupert's skills and qualifications have been acknowledged annually by the Martindale-Hubbell® AV Peer Review Rating™ since 1987, and *The Legal 500*, which noted that clients describe him as a "person of ethics and integrity, with strong expertise." He was selected for inclusion *Illinois Super Lawyers*® annually from 2009–present wherein only five percent of the lawyers in the State are recognized each year. He also has been selected by the *Chicago Law Bulletin* as a "Leading Lawyer" each year since 2004, and has been selected by his peers for inclusion in *The Best Lawyers in America*® annually since 2007 in the practice areas of Biotechnology Law, Litigation–Patent, Litigation–Intellectual Property, and Patent Law. Mr. Rupert was named the "IP Lawyer of the Year (Midwest)" for 2014 by ACQ Global Awards, and "Lawyer of the Year in Biotechnology Law (Chicago)" in 2014 and 2018 by *Best Lawyers*. In addition to his honors, he is listed in *Who's Who in American Law*, *Who's Who in American Business*, *Who's Who in America* and *Who's Who in the World*.



Practices

- IP Litigation
- IP Transactions

Industries

- Chemical Sciences
- Consumer Products
- Medical Devices
- Pharmaceutical

Representative Experience

Mr. Rupert's trial and litigation work has included such products, among many others, as:

- Plastics and chemicals
- Pharmaceuticals
- Medical products
- Heavy equipment (cranes, mining equipment, truck components)
- Computer networking equipment and computer software
- Web-based communication systems
- Telephony
- Consumer and sports products
- Heavy equipment

Background and Credentials

Mr. Rupert has worked extensively on complex technology matters in all phases of litigation, including patent, copyright, trademark, and related matters in federal and state courts throughout the country and overseas. He has tried cases in federal and state courts throughout the country and has argued cases before the U.S. Courts of Appeals for the Federal Circuit and the Seventh Circuit. Additionally, he is a member of the Commercial Panel of the American Arbitration Association, arbitrating IP disputes.

In his licensing and transaction work, he has provided strategic advice to many companies, negotiated domestic and international licenses, supply and distribution agreements, handled litigation settlements, and performed corporate due diligence reviews and transactions. His experiences also include patent prosecution in a wide range of technologies.

Mr. Rupert has been a deposition instructor for the National Institute for Trial Advocacy for years and is a member of the committee that prepared and revised patent jury instructions to be used in the federal district courts of the Seventh Circuit.

He received his J.D., *cum laude*, from Washburn University School of Law (1976), where he served on the board of editors for the *Washburn Law Journal* and remains actively involved. Prior to entering law school, Mr. Rupert served in the U.S. Air Force as a research scientist and intelligence officer. Mr. Rupert earned his B.S. in chemistry from Miami University (1968).

Education

- Washburn University School of Law (J.D., *cum laude*)
- Miami University (B.S.)
 - Chemistry

Bar Admissions

- Illinois
- Texas
- U.S. Supreme Court
- U.S. Court of Appeals, Seventh Circuit
- U.S. Court of Appeals, Federal Circuit
- U.S. District Court, Central District of Illinois
- U.S. District Court, District of Minnesota
- U.S. District Court, Eastern District of Michigan
- U.S. District Court, District of Colorado
- U.S. District Court, Northern District of Illinois
- U.S. District Court, Northern District of Illinois, Trial Bar
- U.S. Patent and Trademark Office
- Canadian Patent Office

Publications and Presentations

In his career, Mr. Rupert has authored or co-authored numerous articles concerning intellectual property and other topics. His publications have been cited by federal district and appellate courts. His publications include:

June 23, 2015

“Supreme Court Decision Today: Post-Expiration Patent Royalties are Unenforceable”

Marshall Gerstein Alert

May 2015

“U.S. Supreme Court's Roadmap for Giving Preclusive Effect to ITC Decisions”

Co-author, World Intellectual Property Report

September 2013

“A Common Sense Approach to Owning Your Innovations”

ACC Docket

February 5, 2013

“Federal Circuit denies vulgar trademark to rooster-shaped lollipops”

InsideCounsel

January 8, 2013

“4 ways to avoid the Rule 26 trap”

InsideCounsel

December 11, 2012

“Secondary considerations save patents, earn \$15 million”

InsideCounsel

November 6, 2012

“Log it or lose it”

InsideCounsel

October 23, 2012

“Consequences from the Federal Circuit’s Medtronic decision”

InsideCounsel

September 11, 2012

“Follow the Rules and Do The Surveys During a Patent Damages Analysis”

InsideCounsel

July 31, 2012

“Going for Broke on Damages Claims”

InsideCounsel

July 3, 2012

“Dummkopf! You’re Fired – Daubert Derails Damages Experts for Both Sides in Apple-Motorola IP Battle”

InsideCounsel

June 5, 2012

“Factors to Consider when Faced with Multi-District Patent Litigation”

InsideCounsel

2012

Patent Claim Construction in the Federal Circuit, 2012 Edition

Contributing Author, Thomson West

January 3, 2011

Patent Claim Construction in the Federal Circuit, 2011 Edition

Contributing Author, Thomson West

October 25, 2010

“Covenants Not to Sue In Light of Federal Circuit Decisions”

Intellectual Property Litigation

Fall 2010

“Litigation Settlements and License Agreements: The Effect of Covenants Not To Sue In Light Of Recent Federal Circuit Decisions”

Co-author, Intellectual Property Litigation, Vol. 22, No. 1, American Bar Association

October 1, 2010

“Therasense v. Becton, Dickinson: An Opportunity for the Federal Circuit to Mend Its Fractured Inequitable Conduct Rulings”

Co-author, Intellectual Property & Technology Law Journal

June 16, 2010

“Clarifying, Confusing, or Changing the Legal Landscape; A Sampling of Recent Cases from the Federal Circuit”

Co-author, The Federal Circuit Bar Journal, Vol. 19, No. 4, 521

2010

Patent Claim Construction in the Federal Circuit, 2010 Edition

Contributing Author, Thomson West

May 13, 2009

“Trolling for Dollars—Part 2”

Intellectual Property & Technology Law Journal

March 20, 2009

“Trolling for Dollars: A New Threat to Patent Owners”

Intellectual Property & Technology Law Journal

2009

Claim Construction in the Federal Circuit, 2009 Edition

Contributing Author, Thomson West

2008

"Intellectual Property Litigation Strategies"

chapter in Inside the Minds: Commercial Litigation Strategies, Aspatore Books

2007

"Arbitration Clauses in Patent Disputes"

IP Law 360

April 2005

"Storm Over the Blackberry—The Boundaries of Liability"

Co-author, Patent World, Issue 171

2003

"Vitiating the Doctrine of Equivalents: A New Patent Law Doctrine"

Co-author, The Federal Circuit Bar Journal, Vol. 12, No. 3, 457

2001

"Patent Indemnification Under the UCC"

Co-author, International Legal Strategy, Vol. X-12, Japan

April 2000

"Patenting Computer Software and Methods of Doing Business: The United States vs. The World"

Co-author, International Trade and Business Law Annual, Vol. V

1999

"E-commerce and the Internet: Personal Jurisdiction in the U.S."

Managing Intellectual Property Trademark Yearbook

1989

"The Discoverability of Documents Prepared for Alternative Dispute Resolution Proceedings"

Alternative Dispute Resolution Report, Vol. 3, No. 21, Bureau of National Affairs, Inc.

1987

"Hybrid License Agreements in the Circuit Courts of Appeals: The Demise of Contract Principles"

Selected Legal Papers, Vol. V, No. 2, American Intellectual Property Law Association

1986

"An Introduction to United States Antitrust Law"

83 The Law Society Gazette 112

1981

“The Relationship of Patent Law to Antitrust Law”

49 Antitrust Law Journal 755

Presentations

- "ADR Involving Intellectual Property Disputes," panel chair and presenter, co-sponsored by the American Arbitration Association, the Intellectual Property Association of Chicago, and the Center for Intellectual Property Law & Information Technology of the DePaul College of Law, DePaul College of Law, Chicago, Illinois, October 5, 2016.
- "Using ADR to Resolve IP Disputes," presenter, American Intellectual Property Law Association, 2015 Spring Meeting, Los Angeles, California, May 1, 2015.
- "Malpractice Issues in IP Cases," presenter, 7th Annual Program, Ethics in the Practice of Intellectual Property Law, sponsored by John Marshall Law School, Chicago, Illinois, April 24, 2015.
- "IP Update: Patent Law Reform," panel chair and presenter, *InsideCounsel's* SuperConference 2012, Chicago, Illinois, April 23, 2012.
- "Patent Litigation," panel chair and presenter, Corporate Intellectual Property Law Conference, Law Bulletin Seminars, Chicago, Illinois, February 8, 2012.
- "Trial by Arbitration: The Arbitration Process from Three Perspectives," panel chair and presenter, Intellectual Property Law Association of Chicago, John Marshall Law School, Chicago, Illinois, November 2011.
- "Using ADR to Resolve IP and Licensing Disputes," panel chair and presenter, Intellectual Property Law Association of Chicago, Chicago-Kent College of Law, October 2011.
- "Patent Mismarking - 2010 and Beyond," panel moderator and presenter; discussed current patent trends at the Law Bulletin Corporate IP Conference on February 8, 2011.
- "False Patent Marking," panel chair and presenter, Corporate Intellectual Property Law Conference, Law Bulletin Seminars, Chicago, Illinois, May 2010.
- "Rule 50 Requirements on Appeal and Traps of Rule 50, F.R.Civ.P. The Need, and How to, Preserve JMOL and New Trial Positions for Consideration on Appeal," Intellectual Property Law Association of Chicago, DePaul University School of Law, May, 2010
- "Intellectual Property Risk Management," Practising Law Institute, September 2009.
- "IP Risk Management: Professional Responsibility, Conflicts, and Malpractice," Chicago Bar Association, February 2009.
- "Using ADR to Resolve IP and Licensing Disputes," 2008 Licensing Executives Society Annual International Conference, Chicago, Illinois, May 2008.
- "Jury (De)Selection in Federal Courts," Litigation Skills II, Law Bulletin Seminars, Chicago, Illinois, May 2008.

- "Intellectual Property Arbitration – Demystifying the Process: What You Should Know," Broadcast Webinar, December 2007.
- "The Federal Circuit Court's Recent Decision: *In re Seagate Technology*," Law Seminars International, August 2007.
- "Developing an Integrated Intellectual Property Strategy," speech presented at the Richard T. Farmer School of Business Administration, Miami University, Oxford, Ohio, February 2007.
- "Ethical Issues In the Practice of Law," speech presented to the Washburn University School of Law, October 2006.
- "Intellectual Property Issues in the Business Environment," speech presented at the Richard T. Farmer School of Business Administration, Miami University, Oxford, Ohio, February 2004.
- "Expert Witnesses in the Courtroom," speech presented at the Washburn University School of Law, October 2003.
- "Overview of Intellectual Property," speech presented at the Richard T. Farmer School of Business Administration, Miami University, Oxford, Ohio, February 2003.
- "New Developments in Copyright Law," speech presented at the DePaul University School of Law, Chicago, Illinois, November 2002.
- "Intellectual Property Issues in Distance Learning Settings," speech presented to the North Suburban Higher Education Consortium, Chicago, Illinois, February 2001.
- "Intellectual Property Issues in International Trade," speech presented to the Industrial Club of Mexico, Mexico City, June 1999.
- "Intellectual Property Issues in the E-commerce Environment," E-commerce Seminar, sponsored by Mayer, Brown & Platt, New York City, New York, January 1999.
- "Intellectual Property in the International Marketplace," Pressure Sensitive Tape Council, Chicago, May 1996.
- "Introduction to the Effective Use of Statistical Analyses in Intellectual Property Litigation," Intellectual Property Litigation Update, sponsored by Coopers & Lybrand L.L.P., Chicago, March 1996.
- "Patent Damages — Should the Georgia Pacific Approach be Scrapped?" Licensing Executives Society, Waikoloa, Hawaii, October 1994.
- "Ethical Considerations in the Practice of Intellectual Property Law," Iowa Intellectual Property Law Association, Dubuque, Iowa, October 1992.
- "The Use of Expert Witnesses in Complex Technology Litigation," Iowa Intellectual Property Law Association, Dubuque, Iowa, October 1992.
- "Complex Technology Related Litigation," Kansas Bar Association Continuing Legal Education Seminar, Topeka, Kansas, March 1991.
- "Effects of United States Antitrust Law on Patent Law," Japanese Intellectual Property Owners Association, Tokyo and Osaka, May 1991.

- "The Discoverability of Documents Prepared for Alternative Dispute Resolution Proceedings," American Bar Association Annual Meeting, Section of Patent, Trademark, and Copyright Law, Honolulu, August 1989.
- "Hybrid License Agreements in the Circuit Courts of Appeal: The Demise of Contract Principles," American Intellectual Property Law Association, Pittsburgh, Pa., May 1987.

Community and Professional Involvement

- Washburn University, Alumni Fellow
- National Institute for Trial Advocacy, Deposition Instructor
- Washburn University School of Law, Advisor, Trial Advocacy Center
- DePaul University School of Law, Center for Intellectual Property Law & Information Technology Board of Advisors
- American Bar Association: Section for Dispute Resolution, Section of Intellectual Property, and Section of Litigation
- American Intellectual Property Law Association
- Richard Linn American Inn of Court
- Intellectual Property Law Association of Chicago, Amicus Committee (2011–present), Vice Chair of Litigation Committee (May 2010–May 2011)
- Homestead Ranchers Summer Collegiate Baseball Team, General Manager, Chicago Suburban Baseball League (2011–present), Great Plains Collegiate Baseball League (2010)
- American Legion Post 42 Baseball Team Advisory Board, Evanston, Illinois (2008–2010)

Representative Matters

- Defense of patent infringement case involving transaction payments.
- Defense of a breach of license case for a foreign company.
- Defense of a trademark infringement case for a manufacturer of off-road vehicle products.
- Defense of a patent infringement case for a large manufacturer of arcade games.
- Prosecution of a patent infringement action for a heavy equipment manufacturer involving mining equipment.
- Defense of a patent infringement case for a major heavy equipment manufacturer involving mobile cranes.
- Defense of a products liability action for an international sports products manufacturer involving alleged defective sports equipment.
- Prosecution of an arbitration involving a patent license for an equipment manufacturer.
- Defense of a breach of contract and fraud action for a consumer products manufacturer involving the termination of an asset purchase agreement.

- Defense of a breach of license action for an international sports products manufacturer that also involved a companion trademark infringement case brought by the manufacturer and a further companion bankruptcy action filed by the manufacturer's licensee.

Military and Government Service

- U.S. Air Force, 1968–1974; served to Captain, honorably discharged
- U.S. Air Force, Foreign Technology Division, private consultant, 1974–1981