



## Joseph A. Saltiel

Special Counsel

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Joseph A. Saltiel is an IP litigator with a long track record of successfully representing clients in court. He has litigated all types of IP and related matters in courts across the country, the USPTO, and the ITC. Joseph also regularly counsels clients on IP issues such as licensing, opinions of counsel, NDAs, due diligence, and related IP matters.

Joseph holds degrees in computer science and electrical engineering, but has handled matters involving a variety of technologies and is skilled at quickly mastering new technologies. Prior to law school, he worked as an engineer in the telecommunications industry.

### Practices

- IP Litigation
- Trade Secrets

### Industries

- Electrical & Computer Technologies
- Automotive & Transportation
- Industrial & Mechanical Technologies

### Representative Experience

Joseph has assisted clients in a range of different matters, including, for example, the following:

- Won summary judgment of non-infringement for a Fortune 50 company who was accused of stealing a former employee's patented process relating to software and machine automation.
- Received a jury verdict at trial of validity and infringement of client's consumer appliance patent against its competitor.
- Successfully moved to dismiss a patent infringement case because the asserted software patents were unpatentable under Section 101.

- Secured a preliminary injunction for a national food manufacture prohibiting a competitor from using a similar trademark on food products sold in grocery stores.
- In an early motion, persuaded the court to dismiss claims of patent infringement against his client with prejudice by identifying fatal inadequacies with the allegations.
- Prevailed in a venue dispute, which led to the case being dismissed, for a technology start-up that was sued for patent infringement.
- Successfully argued at the Federal Circuit for a dismissal of appeal by appellant seeking to overturn a district court's ruling in his client's favor.
- Audited company's procedures and policies regarding its research, development, and manufacturing of products to ensure that IP, including trade secrets, was being adequately protected.
- Won summary judgment of patent infringement against a global semiconductor manufacturer.
- Prevailed in a trademark opposition that was tried before the Trademark Trial and Appeal Board at the USPTO between two competitors using the same mark.

## Background and Credentials

Joseph is a registered patent attorney and prior to joining the firm, he served clients in law firms in Chicago. Prior to becoming a lawyer, he was a member of the technical staff at Bell Labs where he designed software relating to the telecommunications industry.

Joseph received his J.D. from the University of Illinois College of Law. During law school, he was the Internet Editor for the *Law Review* and the *Journal of Law, Technology, and Policy*. Joseph holds a master's degree in electrical engineering and computer science from the University of Illinois at Chicago and a bachelor's degree in computer science from the University of Illinois at Urbana-Champaign.

## Education

- University of Illinois College of Law, Urbana-Champaign (J.D., *magna cum laude*)
- University of Illinois at Chicago (M.S.)
  - Electrical Engineering and Computer Science
- University of Illinois, Urbana-Champaign (B.S.)
  - Computer Science

## Bar Admissions

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

- U.S. Circuit Court of Appeals, Ninth Circuit
- U.S. District Court, Northern District of Illinois
- U.S. District Court, Northern District of Indiana
- U.S. District Court, Western District of Michigan
- Trial Bar for the Northern District of Illinois

## **Publications and Presentations**

August 2019

### **"Five Years After Alice: Five Lessons Learned from the Treatment of Software Patents in Litigation"**

*World Intellectual Property Organization Magazine August 2019*

May 14, 2019

### **"Three Indicators a Software Patent May Be Unenforceable"**

*Bloomberg Law*

April 26, 2019

### **"7 Non-Alice Considerations For Software Patents"**

*Law360*

July 2018

### **"The 10 Biggest Litigation Mistakes That Companies Make"**

*Business.com*

May 10, 2018

### **"The District Court Split on Pleading Indirect Infringement"**

*Law360*

February/March 2018 Issue

### **"Should You Get a Software Patent?"**

*Software Executive Magazine*

2017

### **"Understanding How the Courts View Software Patents"**

*Softwarebusinessgrowth.com (ISV Insights)*

January 2017

### **"Is It Time to Rethink eBay?"**

*Landslide Magazine*

July 2016

**"Defend Trade Secrets Act and Updates on U.S. Patent Law"**

June 2016

**"Protecting Intellectual Property"**

July 2015

**"Patent Reform and Updates on U.S. Patent Law"**

April 30, 2015

**"Nothing Congress Has Proposed Will Help The PTO"**

*Law360*

April 2015

**"Federal Circuit Issues First Opinion on an Appeal from an Inter Partes Review"**

*Japanese Chamber of Commerce & Industry of Chicago*

February 2015

**"Patentability of Software Patents"**

November 2014

**"IP Issues in Software Application Development Agreements"**

November 2014

**"The Odds of Getting a Case Stayed Pending AIA Review"**

*Law360*

August 27, 2014

**"What Happened to Patent Reform in the U.S."**

*The Stellar Journal*

July 2014

**"Patent Trolls and Recent Updates in U.S. Patent Law"**

July 2014

**"Overlooked Problems With Induced Infringement"**

*Law360*

December 2012

**"Divide and Rule"**

*Intellectual Property Magazine*

October 4, 2010

**"Will the ITC Become the Next Popular Forum for NPEs?"**

*Bloomberg Law Reports*

July 16, 2010

**"Is Burying a Material Reference Inequitable Conduct?"**

*Law360*

July 2010

**"Is There a Better Way to Create Privilege Logs?"**

*Bloomberg Law Reports*

April 13, 2009

**"Sans Agreement, Patent Exhaustion Still Matters"**

*Law360*

2009

**"New Local Patent Rules In the Northern District of Illinois"**

*University of Illinois College of Law – Journal of Law, Technology, and Policy*

July 2008

**"Who Owns the IP Rights to High School Sports"**

*Illinois State Bar Association – Intellectual Property Newsletter*

## **Community and Professional Involvement**

- American Bar Association
- Intellectual Property Law Association of Chicago
- Hispanic Lawyers Association of Illinois