



Jeremy R. Kriegel

Partner

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Jeremy R. Kriegel, whose practice focuses on design and mechanical patent matters, personifies the Firm's Creativity Doesn't End with the Invention® motto. *Chambers 2013* lists him as a "key individual" at Marshall, Gerstein & Borun LLP, praising 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." Jeremy 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. Jeremy's approach to design patents leverages clever strategies to obtain broad, yet practical, protection of ornamental designs for physical articles as well as static and dynamic graphical user interfaces.

Jeremy has been named an "IP Star" in *Managing IP's 2016 – 2019 IP Stars Survey* (fka the *World IP Handbook and Survey*) and selected to Illinois Super Lawyers® for Intellectual Property, 2017 – 2020. 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

Jeremy 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. Jeremy has obtained over 500 design patents for clients, including several animated graphical user interfaces for a global Internet solutions provider. 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, dental instruments, 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, Jeremy eased this innovative company's products' route to significant market successes.

Jeremy 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
- Athletic technology

Background and Credentials

Jeremy 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.

Jeremy 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, Jeremy 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., *with 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

September 28, 2020

"Riding The U.S. Patent System Roller Coaster"

Theme Park University

July 19, 2020

"When Robots Say "Enjoy Your Stay:" Patenting AI Solutions to Enhance Guest Experiences"

HotelExecutive

January 21, 2020

"Creative Use of Design Patents – IP Considerations and Strategies for Architects, Designers, Planners & Engineers"

University of Florida-Gainesville College of Design, Construction & Planning

September 27, 2019

"Preserving Patent Term Adjustment – There's No Time to Waste!"

Association of Legal Administrators Intellectual Property Conference

June 24, 2019

"Internal Inconsistencies Limit Design Patent Decision's Utility"

Law360

June 4, 2019

"A Bright Future for Brand Building with Packaging Design Patents"

Chief Packaging Officer

January 3, 2019

"Don't Expect Filing Disruptions If USPTO Shuts Down" (featured quotes)

Law360

June 29, 2017

"Major Departure at USPTO" (featured quotes)

Intellectual Property Magazine

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

“U.S. 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—U.S. 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

- A presenter at the Deerfield High School STEAM Career Day, Jeremy introduced high school juniors and seniors interested in STEAM-related subjects to career paths in intellectual property law.
- To better understand a client's brewing technology, Jeremy obtained a Certificate from the Siebel Institute, Executive Overview of the Industrial Brewing Process.
- He has twice co-chaired the Chicago Bar Association's national moot court competition.
- A volunteer for the Chicago Intellectual Property Alliance (CIPA), Jeremy 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