



## Jonathan C. Hughley

Partner

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Jonathan Hughley focuses his practice on the preparation and prosecution of patent applications involving mechanical, electro-mechanical, and software technologies. His former experience and technical background provide substantial knowledge of numerous technological areas. He prepares and prosecutes domestic and foreign utility and design applications and prepares patentability and infringement opinions for global companies.

Since 2017, he holds the designation of an “Emerging Lawyer” by his peers, less than 2% of all lawyers licensed in each state have received this distinction. Additionally, *Super Lawyers* selected Jonathan for the 2020 *Illinois Rising Stars*® list, featuring top attorneys in the practice of intellectual property law. The Chicago Committee for Advancing Minorities in Large Law Firms selected Jonathan to the Committee’s inaugural *Pathway to Partnership Fellowship* program which aims to develop client relationships for diverse attorneys. *Profiles in Diversity Journal* recognized Jonathan on the inaugural Black Leaders Worth Watching list and most recently *Crain’s Chicago Business* recognized him on the 2021 Notable Rising Stars in Law list.

Jonathan strives to extend his practice beyond intellectual property law by representing clients on a pro bono basis in conjunction with local legal service providers. Recently his pro bono client was granted clemency—his client was one of just 30 petitioners whose petitions were granted on the last day of Former Governor Rauner’s term.

In addition to his client-focused work, he serves on the firm’s Diversity & Inclusion Committee and is a former member of the firm’s peer-elected Associates Committee. When he’s not working, Jonathan enjoys serving at his church, cooking (and particularly grilling and barbecuing) for his family, building toys and playing with his son, and fishing.

### Practices

- Patent Prosecution

## Industries

- Automotive & Transportation
- Cleantech & Renewables
- Consumer Products
- Industrial & Mechanical Technologies
- Materials Science
- Medical Devices
- Non-Profit Technology Transfer

## Representative Experience

Inventors and in-house counsel rely on Jonathan's experience to assist them in developing appropriate patent protection strategies. Jonathan takes the same approach when managing the intellectual property of all his clients: to first identify the clients' needs, and later develop an effective protection strategy that will help the client meet those needs.

- Prepared and prosecuted domestic and foreign utility and design applications for global companies.
- Conducted wide-ranging search and opinion work for global leaders in respective industries.
- Completed M&A IP portfolio review, analysis, and due diligence to assist with successful acquisitions and mergers.
- Assisted startup company in obtaining patent protection, resulting in a successful appearance on entrepreneurial investment show *Shark Tank*.

Jonathan's work spans a variety of industries, including:

- Agricultural equipment
- Aircraft components and equipment
- Automotive components and drive systems
- Autonomous driving systems
- Building construction materials and tools
- Consumer products and goods
- Fitness and sporting goods equipment
- Food processing and packaging
- Heavy-duty machinery
- Household appliances
- Illumination technologies
- Imaging systems
- Industrial control systems
- Manufacturing systems and machinery

- Medical devices
- Nanotechnology
- Oil and gas systems
- Portable electronic devices and accessories
- Sound attenuation technologies

## Background and Credentials

Jonathan understands clients. Prior to joining Marshall, Gerstein & Borun LLP, he worked in numerous engineering and legal capacities at International Truck & Engine Corporation and Caterpillar, Inc. In law school, he worked as a Commercialization Analyst for the University of Illinois' Office of Technology Management, where he identified, marketed, and licensed intellectual property developed by on-campus research. Jonathan also worked at the University of Illinois College of Law Patent Clinic, conducting prior art research and assisting IP clients with patent applications and other matters.

Jonathan's leadership roles include serving as an Associate Board member of The Chicago Committee for Advancing Minorities in Large Law Firms, an organization that seeks racial and ethnic diversity in the legal profession. He currently serves as the Chair of the Nominations Committee, and is a member of the Partner Roundtable Committee.

Jonathan received his J.D., *cum laude*, from the University of Illinois College of Law. Additionally, he holds a B.S. degree in Mechanical Engineering from the University of Illinois at Urbana-Champaign.

## Education

- University of Illinois College of Law, Urbana-Champaign (J.D., *cum laude*)
- University of Illinois, Urbana-Champaign (B.S.)
  - Mechanical Engineering

## Bar Admissions

- Illinois
- U.S. Patent and Trademark Office

## Publications and Presentations

September 16, 2021

**"Managing Today's Fast-Paced IP Department"**

*ACC Docket*

October 16, 2020

**"How I Made Partner: Show Your Commitment, Advises Marshall Gerstein's Jonathan Hughley"  
(featured quotes)**

*Law.com*

July 30, 2020

**"Overcoming Bias in the Legal Industry and Paving a More Inclusive Path Forward"**

*Lawyer Monthly*

January 29, 2015

**Utility Model Patents: Use and Enforcement in Global Patent Practice**

*CLE Presentation*

December 13, 2011

**Critique Legal Arguments and Provide Insights into the Field of Law**

*Mather High School on behalf of the Institute for Inclusion in the Legal Profession*

October 27, 2011

**Diversity in the Legal Field**

*Just the Beginning Foundation at Chicago Bulls Preparatory Academy on behalf of the Institute for Inclusion in the Legal Profession*

October 9, 2011

**Why Diversity in the Legal Profession is Important**

*Apostolic Whole Truth Church on behalf of the Institute for Inclusion in the Legal Profession*

September 29, 2011

**How Engineering Degrees Can Be Useful in the Legal Field**

*Morill Engineering Program at the University of Illinois at Urbana Champaign, on behalf of the Institute for Inclusion in the Legal Profession*

## Community and Professional Involvement

- The Chicago Committee for Advancing Minorities in Large Law Firms – Associate Board
- American Bar Association
- Institute for Inclusion in the Legal Profession
- American Intellectual Property Law Association (AIPLA)
- Wills for Heroes Foundation
- Cabrini Green Legal Aid
- Lupus Foundation of America