



Gregory (Greg) M. Smith

Special Counsel

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Gregory has over 15 years of experience in various aspects of patent and trademark law, including the preparation and prosecution of U.S. and foreign patent applications; preparation of patent and trademark opinions such as non-infringement, invalidity, product clearance, and trademark availability opinions; patent and trademark litigation; the drafting and review of IP transactional documents; and IP due diligence reviews. Greg draws on his formal training as a mechanical engineer with practical experience in the mechanical, electrical, and acoustical fields to provide clients with informed and experienced advice.

Practices

- IP Litigation
- Patent Prosecution

Industries

- Automotive & Transportation
- Cleantech & Renewables
- Industrial & Mechanical Technologies

Representative Experience

Greg has extensive experience representing clients in patent portfolio management, including procuring and prosecuting U.S. and foreign patents and preparation of patentability, non-infringement and invalidity opinions. His work ranges across a variety of industries, including:

- Agricultural equipment
- Aircraft and spacecraft parts and systems
- Automotive filters
- Automotive interiors

- Business Methods and e-commerce
- Computer network equipment
- Computer systems and programs
- Flooring
- Hand tools
- Household cleaning products
- Nanotechnology
- Network cable management
- Pneumatic precision finishing tools, motors, and spindles
- Pneumatic system components
- Small appliances
- Sporting good equipment
- Traffic bollards and security posts
- Valves
- Process Management Technology

Greg also provides counsel to clients in drafting and review of patent-related transactional documents, including licensing agreements and assignments. Additionally, he works with clients to perform due diligence reviews for potential IP asset purchases or corporate mergers. He also represents clients in the procurement and prosecution of U.S. and foreign trademarks, in the preparation of trademark availability and infringement opinions and in the drafting and review of trademark-related transactional documents, including:

- Represented a major online travel website in procuring and maintaining its patent portfolio.
- Represents various manufacturers in procuring patent protection and maintaining their patent portfolios in areas such as traffic bollards and security posts, flooring, transmissions, valves, pneumatic tools, network equipment, aerospace, and automotive filters.
- Represented various product manufacturers in patent infringement lawsuits involving auto-retracting safety knives; ultra-thin mats and pads; agricultural conveyors; electronic fly traps; and hand-held pneumatic tools, including an appeal to the USCA for the Federal Circuit.
- Represented a major cable/satellite set-top box manufacturer in defending a patent infringement lawsuit involving interactive program guides for set-top boxes, including the filing of a request for reexamination before the USPTO.
- Represented a product manufacturer and its U.S. distributor in multiple patent infringement lawsuits involving auto-retracting safety knives.

Background and Credentials

Greg received a B.S. in mechanical engineering from the University of Colorado and his J.D. from the John Marshall Law School. He is admitted to practice in Illinois, before the United States Patent and Trademark Office, and to the United States District Court for the Northern District of Illinois (trial bar), United States Court of Appeals for the Seventh Circuit, and the United States Court of Appeals for the Federal Circuit. He is a member of the American Intellectual Property Law Association and the Intellectual Property Law Association of Chicago.

Education

- The John Marshall Law School (J.D.)
- University of Colorado (B.S.)
 - Mechanical Engineering

Bar Admissions

- Illinois
- U.S. Circuit Court of Appeals, Federal Circuit
- U.S. Circuit Court of Appeals, Seventh Circuit
- U.S. District Court, Northern District of Illinois
- U.S. District Court, Northern District of Illinois, Trial Bar

Publications and Presentations

- "Exploring the WIPO Green Marketplace," *Marshall Gerstein Insights*, February 2024.
- "What Pet Product Companies Must Know About Intellectual Property: Protecting Your Competitive Advantage," Co-Presenter, American Pet Products Association (APPA)'s Global Opportunities Education Series Webinar, October 10, 2013.

Community and Professional Involvement

- American Intellectual Property Law Association (AIPLA)
- Intellectual Property Law Association of Chicago (IPLAC)
- American Bar Association (ABA)
- ITC Trial Lawyers Association