



Richard B. Hoffman

Of Counsel

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Richard B. Hoffman advises U.S. and foreign clients, from major corporations to foundations to entrepreneurs. He brings over 40 years of experience counseling them on how to gain economic benefits and protections for their new products or ideas in mechanical and diverse related technologies. Whether negotiating effective intellectual property agreements and licenses, diligently pursuing patent protections, providing freedom-to-operate opinions, counseling on trade secret issues, or preparing intellectual property audits, he delivers practical and valuable solutions. Awarded a Martindale-Hubbell® AV Peer Review Rating™ for his abilities, he remains in the forefront of developing new technologies, including in the Cleantech and Renewables practice area and working on his own inventions in the biomass field outside the office.

In addition to his Martindale-Hubbell® AV Peer Review Rating™, he was also selected as a 2013 “Top Rated Lawyer in Intellectual Property” by *American Lawyer Media (ALM)* and Martindale-Hubbell. Mr. Hoffman has been selected by the *Chicago Law Bulletin’s* Leading Lawyer Network as a “Leading Lawyer,” and was voted an Illinois Super Lawyer. He is listed in *Who’s Who in America*, *Who’s Who in the Midwest*, *Who’s Who in the World* and *Who’s Who in American Law*.

Practices

- Patent Prosecution
- Trade Secrets

Industries

- Cleantech & Renewables
- Consumer Products
- Industrial & Mechanical Technologies
- Medical Devices

Representative Experience

- Successfully tackled a large manufacturing client's numerous IP issues to clear the launch of a new generation product, directing a Marshall, Gerstein & Borun LLP team with diverse backgrounds in several technologies and legal specialties. The work involved updating patent application protection, freedom-to-operate searching and opinions, licensing negotiation strategy and counseling, responding to IP-type concerns of prospective

customers, counseling regarding potential third-party infringement, and related foreign clearance searching and IP protection.

- For more than 25 years, Mr. Hoffman has been effectively prosecuting a large, ongoing series of U.S. patent applications spanning multiple technologies for a foreign-based manufacturer of beverage bottling machinery. This long-term relationship has demanded an intimate, evolving knowledge of the client's industry/technology and the need to continually apprise the client of changes in U.S. IP law and industry developments.
- Handled a diverse series of ongoing IP-related inquiries from several insurance companies on licensing matters, business method patents, freedom-to-operate questions, and confidential disclosure and employment-related issues.

Mr. Hoffman has represented entities in a diverse range of industries, including:

- Food/meat processing
- Beverage bottling
- Automated industrial machinery
- Sports and outdoor recreation equipment
- Horticultural seed products and processes
- Biomass/biofuels processing
- Appliance components
- Onsite waste and drainage
- Industrial hardware and tools
- Gravity-fed shelving
- Packaging
- Metal fabrications
- Insurance and financial service business methods

Background and Credentials

Mr. Hoffman is widely regarded for his experience in intellectual property law in the U.S. and abroad. He offers clients hands-on and knowledgeable support from over 40 years of handling patent application preparation, patent prosecution, design, trade secrets, and related opinions, counseling, intellectual property audits, and agreements.

In his practice, he has prosecuted numerous valuable patents, counseled and delivered opinions for large and small corporations, professional associations, foundations, entrepreneurs and other law firms, including substantial work for foreign clients.

Mr. Hoffman has also promoted clients' economic gains by preparing and reviewing numerous contracts for product and invention licensing, joint commercialization, trade secrets, know-how and confidential information, and intellectual property aspects of employment-related contracts. He has also represented clients in patent and trademark infringement litigation, including counterfeiting and knock-off matters.

Due to a personal interest, he has gained extensive knowledge as to ongoing developments in the renewable energy and clean technology fields, and particularly biomass processing, reading widely in that area. This attention culminated in his organizing and previously chairing the firm's Cleantech and Renewables industry practice group.

Mr. Hoffman obtained an L.L.M. (Patent Law) from John Marshall Law School in 1981, a J.D. from DePaul University College of Law in 1973, and a B.S. in general engineering from the University of Illinois in 1970.

Education

- The John Marshall Law School (L.L.M.)
 - Patent Law
- DePaul University College of Law (J.D.)
- University of Illinois, Urbana-Champaign (B.S.)
 - General Engineering

Bar Admissions

- Illinois
- U.S. Courts of Appeals, Seventh, Ninth, and Federal Circuits
- U.S. District Court, Northern District of Illinois
- U.S. Patent and Trademark Office

Publications and Presentations

- [“IP Pitfalls in Talking With Others - Part Two”](#) *Biomass Magazine*, May 2010.
- [“IP Pitfalls in Talking With Others - Part One”](#) *Biomass Magazine*, April 2010.
- “Protecting Your Intellectual Property” *Biofuels Journal’s* 2nd Annual Commercial Ethanol Technology and Research Workshop, October 2009.
- “Intellectual Property 101” Packer Engineering, July 2009.
- “Trade Secret Protection and the Biofuel Industry,” *Biofuels Journal’s*, May 2009, April 2009.

[Click here](#) to see additional Publications and Presentations.

Insights

May 2010

“IP Pitfalls in Talking with Others—Part Two”

Biomass Magazine

April 2010

“IP Pitfalls in Talking with Others—Part One”

Biomass Magazine

October 2009

“Protecting Your Intellectual Property”

Biofuels Journal’s

July 2009

“Intellectual Property 101”

Packer Engineering

May 2009, April 2009

“Trade Secret Protection and the Biofuel Industry”

Biofuels Journal’s

November 2008

“Biofuel Inventions/Innovations and Intellectual Property Law”

Biofuels Journal’s