



Robert M. Gerstein

Partner

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For clients in a wide range of industries, Robert M. Gerstein prepares, negotiates and provides opinions on agreements relating to patents, trademarks, copyrights, trade secrets, and the related development and commercialization of intellectual property intensive products and services. Building on over 35 years of experience, he treats each client individually, delving into their business and culture to provide advice that is not only legally advantageous, but is also practical and economical.

Most of Mr. Gerstein's agreement projects relate to the granting of rights in intellectual property, including licensing or sale of patents, trademarks and copyrights. In some cases, the projects involve the sale of intellectual property along with other business assets in mergers, acquisitions and asset sales.

Having extensive experience in intellectual property litigation, as well as knowledge of important intellectual property agreement issues, he has worked on over 250 agreements resolving patent disputes and dozens of other settlements relating to trademarks, trade secrets and copyrights.

Robert is particularly proud of his non-profit and pro bono activities. He founded and serves as president of the Evan Joseph Gerstein Foundation, named after his son Evan, which raises money for research and care for pediatric cancer. Other non-profit and pro bono activities include:

- Receiving the Award for Excellence in Pro Bono Service from the United States District Court for the Northern District of Illinois and the Chicago Chapter of the Federal Bar Association for his work helping an inmate at Cook County Jail and Stateville Prison obtain healthcare.
- Being a founding board member and current board member of Facility Theatre, and independent theater company in Chicago.

The business perspective that put him on the firm's Executive Committee, along with his technical know-how from training as a nuclear engineer, enable him to deliver in-depth advice on a range of issues faced by intellectual property intensive companies. As a result, he has earned acclaim as one of the "World's Leading Intellectual Property Strategists" by *Intellectual Asset Management (IAM)* magazine.

Robert has been selected as one of the "World's Leading Patent Practitioners" since 2012 and as one of the "World's Leading Intellectual Property Strategists" for several years by *Intellectual Asset Management (IAM)* magazine. He is listed in the Martindale-Hubbell®2009 Bar Register of Preeminent Lawyers and was also awarded its AV Peer Review Rating™. In 2013, he was recognized as a "Top Rated Lawyer in Intellectual Property" by *American Lawyer Media (ALM)* and Martindale-Hubbell. He has been selected by the *Chicago Law Bulletin* as a "Leading Lawyer," was voted an Illinois Super Lawyer and was selected by his peers for inclusion in *The Best Lawyers in America*® in the practice area of Patent Law. Since 2014, Robert has been named an "IP Star" in the *Managing Intellectual Property* IP Stars Survey. In 2022, he was named a Thomson Reuters Stand-out Lawyer.

Practices

- Copyrights
- IP Litigation
- IP Transactions
- Patent Prosecution
- Post-Grant Patent Proceedings
- Trade Secrets
- Trademarks

Industries

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

Representative Experience

- An information technology development company's largest customer decided it needed a formal agreement to cover the services provided. Most importantly, covering who would own and use the intellectual property related to what was developed. Marshall Gerstein negotiated a Master Services Agreement that kept the client's biggest customer happy, ensuring that the intellectual property provisions allowed the client to maintain its other relationships and provided a platform for future growth.
- Robert has worked on several agreements for a company that uses biotechnology to engineer fermentation processes to produce pharmaceuticals and their ingredients.
- When a large telecommunications company was sued by another large competitor, Marshall Gerstein helped develop an offensive strategy that went far beyond defending the lawsuit. We advised the client regarding third-party patents that could be asserted against the competitor, drafted and negotiated agreements with the third parties to acquire several patents, and asserted the patents against the competitor. That strategy led to a favorable settlement for the client without the need for time-consuming and expensive trials.

Robert has handled transactions and has given legal opinions for many technologies, including:

- Computers and software
- Pharmaceuticals and biotechnology
- Medical devices
- Vacuum cleaners
- Superconductors
- Video games

- Radio frequency filters
- Horticulture
- E-commerce
- Healthcare IT

Background and Credentials

Robert strives to get a deep understanding of each client's business and technology, and integrate all aspects of IP with the organization's business goals. The best solution for one client may not work for another due to their size, corporate cultures, product types and competitive landscape. Applying a concerted and analytical approach, he uncovers as much as possible about the client and the marketplace. That method leads to recommendations that the client can most easily use, while still affording the best legal protection.

In addition to his client counseling and work on transactions and licenses, he is involved in patent, trademark, copyright, unfair competition and contract arbitrations, mediations, and litigation. He has prepared numerous legal opinions for clients, primarily involving contract interpretation, patent validity, patent infringement or patentability. He also conducts due diligence for intellectual property transactions, as well as the intellectual property aspects of mergers, acquisitions and public offerings. Robert has also served as an expert witness on intellectual property transactions.

His experience includes patent and trademark prosecution. The patent prosecution work relates to U.S. foreign and international patent applications and has included reexaminations, inter partes reviews and appeals before the Board of Patent Appeals and Interferences.

He has been with Marshall Gerstein since 1988 and has been a partner since 1995. Robert served on the firm's Executive Committee for two decades and currently serves as Chair of the firm's Technology Committee.

In 1988, Robert graduated from The University of Michigan Law School, *cum laude*, and received his B.S.E., with honors, in nuclear engineering from the College of Engineering at the University of Michigan in 1985.

Education

- University of Michigan Law School (J.D., *cum laude*)
- University of Michigan (B.S., *with honors*)
 - Nuclear Engineering

Bar Admissions

- Illinois
- U.S. District Court, Northern District of Illinois
- U.S. Patent and Trademark Office
- Admitted to practice pro hac vice in various district courts throughout the U.S.

Publications and Presentations

- "IP Issues in AI, Software Licensing, and IT Services Agreements and Related Due Diligence," Co-Presenter, *World IP Forum*, May 4, 2021.
- "[Fed. Circ.'s UT Immunity Ruling Places Licensing In Spotlight](#)," *Law360*, August 3, 2020 (featured quotes).
- "[Mission Accomplished for Trademark Licensees](#)," *Managing Intellectual Property*, July 24, 2019.
- "[Tempnology Looks for Warm Trademark Ruling From Supreme Court](#)," *The Deal*, March 7, 2019 (featured quotes).
- "[Mission Product Oral Argument Promises Certainty on Long Unresolved Question](#)," *IPWatchdog*, February 25, 2019 (featured quotes).

See Robert's additional thought leadership.

Community and Professional Involvement

- American Bar Association (ABA)
- Chicago Bar Association (CBA)
- Illinois State Bar Association (ISBA)
- Intellectual Property Law Association of Chicago (IPLAC)
- American Bar Foundation
- Executives' Club of Chicago

Insights

May 4, 2021

"IP Issues in AI, Software Licensing, and IT Services Agreements and Related Due Diligence"

World IP Forum

August 20, 2020

Federal Circuit Reduces Licensor Control of Infringement Suits

Marshall Gerstein Alert

August 20, 2020

Federal Circuit Grants Licensees More Control Over Infringement Litigation

Marshall Gerstein Alert

July 31, 2020

"Fed. Circ.'s UT Immunity Ruling Places Licensing In Spotlight" (featured quotes)

Law360

July 24, 2019

"Mission Accomplished for Trademark Licensees"

Managing Intellectual Property

March 7, 2019

"Tempnology Looks for Warm Trademark Ruling From Supreme Court" (featured quotes)

The Deal

February 25, 2019

"Mission Product Oral Argument Promises Certainty on Long Unresolved Question" (featured quotes)

IPWatchdog

February 22, 2019

"2019 IPPulooza"

Association of Corporate Counsel, RTP Chapter

February 21, 2019

"SCOTUS Examines TM Licensing Post-Bankruptcy" (featured quotes)

World Intellectual Property Review

February 19, 2019

"SCOTUS Examines TM Licences in Bankruptcy" (featured quotes)

Intellectual Property Magazine

June 28, 2017

"Lessons From This Year's High Court IP Rulings: Part 2" (featured quotes)

Law360

May 31, 2017

"Lexmark: Good for Consumers, Bad for Manufacturers" (featured quotes)

Intellectual Property Magazine

May 31, 2017

"U.S. Supreme Court Overturns Federal Circuit Patent Exhaustion Stance in Impression v. Lexmark" (featured quotes)

Managing Intellectual Property

May 30, 2017

"Supreme Court Limits Use of Patents to Enforce Post-Sale Restrictions"

Marshall Gerstein Alert

May 30, 2017

"Patent Exhaustion at the Supreme Court: Industry Reaction to Impression Products v. Lexmark" (featured quotes)

IPWatchdog

March 28, 2017

"Impression v. Lexmark Arguments Analysis: When Are Patent Rights Exhausted?" (featured quotes)

Managing Intellectual Property

March 24, 2017

"SCOTUS Reviews 'Long and Tortured' Patent Exhaustion Doctrine" (featured quotes)

Intellectual Property Magazine

March 22, 2017

"Impression v. Lexmark: SCOTUS Questions Patent Exhaustion Rules" (featured quotes)

World Intellectual Property Review

March 20, 2017

"SCOTUS to Decide Patent Exhaustion Question" (featured quotes)

IPPro Patents

March 14, 2017

"The Diminishing Returns of Venture Philanthropy"

AUTM Annual Meeting

December 6, 2016

"Supreme Court to Review Important Patent Exhaustion Decision"

Marshall Gerstein Alert

April 6, 2016

"Preparing Your Business for Investment or Sale: Critical Viewpoints on Closing the Deal"

CIMposium 2016

February 15, 2016

"Federal Circuit Sidesteps Supreme Court Twice in Exhaustion Ruling"

Marshall Gerstein Alert

December 3, 2015

"Preparing Your Business for Investment or Sale: Critical Viewpoints on Closing the Deal"

MATTER Panel Discussion

June 22, 2015

"Attorneys React To Supreme Court Patent Royalties Case" (featured quotes)

Law360

August 6, 2013

"Cover Story: Tech Patent Battles"

First Business

July 2, 2013

"Capitalizing on R&D"

CFO.com

May 16, 2013

"USPTO Cuts Threaten To Hobble Already Stressed Agency" (featured quotes)

Law360

April 3, 2013

"Cover Story: Patents vs. Generics"

First Business

February 22, 2013

"Cover Story: Cyber Sleuth"

First Business

July 31, 2012

"Cover Story: Apple vs. Samsung"

First Business

November 18, 2011

“In Hot Patent Market, New Rules Expected to Spur Swifter Filings”

SmallBusinessExecutive

October 4, 2011

“Hospira’s Plan For Generic Drug Draws Lawsuit From Abbott”

Crain’s Chicago Business

October 1, 2011

“New Patent Law Highlights The Need For Speed”

CFO Magazine

September 21, 2011

“Patent Patience”

First Business, live video interview in nationally syndicated television program

September 13, 2011

“IP Lawyers See New Patent Law as Major Shift”

Chicago Daily Law Bulletin

September 9, 2011

“Patent Overhaul”

The Chicago Tribune

August 22, 2011

“Patent Reform”

First Business, live video interview in nationally syndicated television program

August 3, 2011

“Financial Independence For The Patent Office”

IPLaw360

March 29, 2011

“Are Bayh-Dole’s Best Days Over?”

Law360

2009

“Licensing Strategies for Success”

Panelist at Corporate Intellectual Property Conference 4th Annual Meeting

Client Successes

Navigant Expands Capabilities with Acquisition

When global professional services giant Navigant Consulting identified Atlanta-based RevenueMed as a strategic acquisition target, Navigant’s general counsel turned to Marshall, Gerstein & Borun LLP for guidance on all IP-related aspects of the transaction. RevenueMed, a provider of coding, revenue cycle management, and business process management services for the healthcare sector, represented an opportunity to further strengthen Navigant’s position as a leading provider of end-to-end revenue cycle business process management services and to expand the company’s platform to include global, offshore capabilities for its clients.

Marshall Gerstein's IP Transactions team began the engagement with significant technology due diligence, followed by a multidisciplinary effort ranging from extensive agreement review (encompassing open source agreements, employment agreements and all other relevant contracts) through the transfer of RevenueMed's IP portfolio to Navigant. As part of the transaction, Marshall Gerstein:

- Negotiated the IP-related provisions in the asset purchase agreement, as well as a master services agreement with a soon-to-be former affiliate of RevenueMed to develop software applications and other deliverables for Navigant following the acquisition.
- Drafted and negotiated a transition services agreement to effect the transition of operations of an affiliated entity not acquired by Navigant out of RevenueMed while ensuring that RevenueMed's business would continue to run smoothly during its integration into Navigant.
- Addressed IP-related employment issues.

This significant acquisition, which closed in February 2015, augments Navigant's business process management offerings and further positions this Marshall Gerstein client for long-term, sustainable growth.

Eliminating Spillover via an Inter Partes Victory

The Firm secured a complete victory for SSW Holding Company, Inc., in an inter partes review proceeding challenging the validity of an SSW patent, making its client one of just a handful to emerge from the newly established inter partes review process with every challenged patent claim fully intact.

Inter partes review (IPR) is a streamlined process for challenging patents created through the Leahy-Smith America Invents Act of 2011 and, to date, has proven favorable to those challenging patents. Of the 78 decisions issued in IPR proceedings through June of 2014, the Patent Trial and Appeal Board cancelled or invalidated nearly 80 percent of the patent claims before it. In only 14 percent of such cases did the board find in favor of the patent owner with respect to all of the patent claims under consideration, as it did in *Schott Gemtron Corp. v. SSW Holding Company, Inc.* The Patent Trial and Appeal Board's decision rejected arguments that SSW's patent—which covers spill-containing refrigerator shelving technology used by major appliance manufacturers—was “obvious” and therefore invalid. Oral argument in the case took place on June 23, 2014.

Zebra Technologies Accelerates Strategic Growth with Deal to Acquire Matrox Imaging

When Zebra Technologies Corporation, a world leader in designing, manufacturing, and selling innovative software, hardware, and digital solutions, decided to accelerate its strategic growth in machine vision by acquiring the imaging division of Matrox, it turned to Marshall Gerstein to handle the complex IP issues involved in the carve-out acquisition. Executing an interdisciplinary approach, Marshall Gerstein assembled a small team with deep subject matter experience within our IP transactions, electrical engineering patent prosecution, and trademark practice groups to ensure a smooth and successful deal that protected Zebra's interests, particularly with respect to use of IP assets with applicability across multiple businesses.

Zebra notes that “the acquisition of Matrox Imaging expands the portfolio of machine vision products, software and services Zebra can offer customers to help them thrive in the on-demand economy that is constrained by both labor shortages and limited supply of upstream goods and materials,” according to the company's press release.

[Read Zebra's press release on this intended acquisition made in part with the counsel of Marshall Gerstein.](#)

Representative Matters

Clients have benefitted from Robert's representation in the following cases:

*Ballard Medical Products v. Bissell Medical Products**

U.S. District Court, District of Utah

Case Type(s): Patent Infringement

Area(s) of practice: Mechanical Arts

Berfield v. White Consolidated Industries*

Case Type(s): Arbitration

Area(s) of practice: Intellectual Property Transactions

*Carrot Top, Inc. v. KES Irrigation Systems, Inc.**

U.S. District Court, Northern District of Georgia

Case Type(s): Patent Infringement

Area(s) of practice: Mechanical Arts

*Directed Electronics, Inc. v. Code Alarm, Inc.**

U.S. District Court, Southern District of California

Case Type(s): Patent Infringement

Area(s) of practice: Electrical Arts/Computer Software

Dynamic Graphics, Inc. v. Goldmind Publishing*

Illinois State Court

Case Type(s): Copyright Infringement

Area(s) of practice: Copyrights

Gatsby's Inc. v. Robert Bruce, et al.*

Illinois State Court

Case Type(s): Trademark Infringement

Area(s) of practice: Trademarks

Ghirardelli Chocolate Company et al. v. Kroger et al.*

U.S. District Court, District of Oregon

Case Type(s): Trademark Infringement

Area(s) of practice: Trademarks

*Johnson & Johnson v. The Procter and Gamble Co.**

U.S. District Court, District of Colorado

Case Type(s): Patent Infringement

Area(s) of practice: Chemistry/Chemical Engineering

*JVM Innovations, LLC v. Spalding & Evenflow Companies v. Kolcraft Enterprises, Inc., et al.**

U.S. District Court, District of Ohio

Case Type(s): Trade Secrets, Unfair Competition

Area(s) of practice: Mechanical Arts, Trade Secrets

Kitchens of Sara Lee, Inc. v. Sar A Lee, Inc.*

U.S. District Court, Northern District of Illinois

Case Type(s): Trademark Infringement, Trade Dress

Area(s) of practice: Trademarks

*Nabisco, Inc. v. Trolli, Inc.**

U.S. District Court, District of New York

Case Type(s): Trade Dress
Area(s) of practice: Litigation

National Gypsum Co. v. Centex American Gypsum*
U.S. Bankruptcy Court, Northern District of Texas
Case Type(s): General Civil Litigation
Area(s) of practice: Litigation

*Oscar Mayer v. Sara Lee**
U.S. District Court, Eastern District of Wisconsin
Case Type(s): Trademark Infringement, Trade Dress, Patent Infringement
Area(s) of practice: Mechanical Arts

*Oscar Mayer, Inc. v. Sara Lee Corp.**
U.S. District Court, Eastern District of Wisconsin
Case Type(s): Copyright Infringement
Area(s) of practice: Litigation, Copyrights

Paddock Pool Equipment, Inc. v. Kiefer*
Chancery Division, Circuit Court of Cook County
Case Type(s): Patent Infringement
Area(s) of practice: Mechanical Arts, Litigation

*Precor Incorporated v. Sports Art Industrial Co., LTD**
U.S. District Court, Washington
Case Type(s): Patent Infringement
Area(s) of practice: Litigation, Mechanical Arts

Schwinn Cycling and Fitness v. Mad Dogg Athletics*
U.S. Bankruptcy Court, Colorado
Case Type(s): General Civil Litigation
Area(s) of practice: Litigation

Sitrick v. Electronic Arts, Inc.*
U.S. District Court, Chicago
Case Type(s): Patent Infringement
Area(s) of practice: Electrical Arts/Computer Software, Litigation

Sitrick v. Nintendo of America, Inc. and Sega of America, Inc.*
U.S. District Court, Northern District of Illinois
Case Type(s): Patent Infringement
Area(s) of practice: Litigation, Electrical Arts/Computer Software

*Stars Beverages v. Ghirardelli Chocolate Company**
U.S. District Court, Minnesota
Case Type(s): Trademark Infringement
Area(s) of practice: Trademarks, Litigation

The Bradbury Company v. ASC Machine Tools, Inc.*
U.S. District Court, District of Kansas
Case Type(s): Patent Infringement
Area(s) of practice: Litigation, Mechanical Arts

The Procter & Gamble Company v. ICD Industries*

U.S. District Court, District of Pennsylvania

Case Type(s): Patent Infringement

Area(s) of practice: Mechanical Arts, Litigation

The Procter & Gamble Company v. Johnson & Johnson*

U.S. District Court, District of Wisconsin

Case Type(s): Patent Infringement

Area(s) of practice: Mechanical Arts, Litigation

*Toro Co. v. McCulloch Corp.**

U.S. District Court, District of Minnesota

Case Type(s): Patent Infringement

Area(s) of practice: Litigation, Mechanical Arts

Virtual World Entertainments Music, Inc. v. Bob Bejan and Controlled Entropy**

U.S. District Court, Northern District of Illinois

Case Type(s): Licensing

Area(s) of practice: Electrical Arts/Computer Software, Litigation, Trade Secrets

*Party Represented