

GARY M. ROPSKI



EDUCATION

J.D., cum laude
Northwestern University School of Law, 1976
B.S., Physics
Carnegie-Mellon University, 1972

BAR ADMISSIONS

Illinois
U.S. Dist. Court, Dist. of Minnesota
Supreme Court of the United States
U.S. Patent & Trademark Office
U.S. Dist. Court, W.D. Wisconsin
U.S. Dist. Court, N.D. Illinois
U.S. Dist. Court, N.D. California
U.S. Dist. Court, E.D. Wisconsin
U.S. Dist. Court, E.D. Michigan
U.S. Dist. Court, Dist. of Colorado
U.S. Dist. Court, C.D. Illinois
U.S. Court of Appeals, Fed. Cir.
U.S. Court of Appeals, 9th Circuit
U.S. Court of Appeals, 7th Circuit
U.S. Court of Appeals, 3rd Circuit
U.S. Court of Appeals, 11th Cir.
U.S. Court of Federal Claims
Illinois Supreme Court

When Gary Ropski addresses a courtroom, he speaks with the force and authority of over 40 years of trial and appellate experience. During his career Gary has handled more than 125 patent, trademark and copyright cases in every federal judicial circuit, including jury trials, controversies before the U.S. Patent and Trademark Office, and appeals at the Court of Appeals for the Federal Circuit and several others. His is a familiar face in cases before key patent litigation district courts, and in precedent-setting appeals nationwide.

Clients and colleagues describe Gary as a "top-drawer" litigator, "a class act," "unflappable," "overflowing with common sense" "who works tirelessly to bring about commercial resolutions to conflicts." He is able to "turn an esoteric subject into something easy to understand" and "he has all the people skills needed to be a successful attorney and is a great listener." Gary has a "real forte in strategy" and "tells it straight and doesn't overreach and that has the effect of inspiring confidence" while "taking a central role in must-win cases with consummate professionalism." These traits he has honed in virtually every variant of patent, trademark, trade dress and

copyright litigation. They serve him well in helping adversaries resolve disputes as an arbitrator and trained mediator.

Gary has long been recognized as one of America's best intellectual property lawyers. In 2018 and 2014, *Leading Lawyers Magazine* ranked him #1 in Intellectual Property in Illinois. In 2013, *The Best Lawyers in America* named him Chicago's Patent Litigation Lawyer of the Year.

An experienced sailboat racer, Gary believes in thinking forward in legal matters just as he would in a boat race. He keeps a fixed eye on his client's ultimate goal in litigation, and looks for the most efficient and cost-effective route to the finish line.

During Gary's six-year tenure as its president, Brinks Gilson & Lione became the first intellectual property law firm in the Midwest Region and only the second in the country to receive the Thomas L. Sager Diversity Award from the Minority Corporate Counsel Association.

EXPERIENCE | OVERVIEW

- Successfully defended a German company and its U.S. affiliate in ITC proceedings in Washington, D.C. and the district court in Detroit, alleging infringement of 11 patents relating to automated mechanical transmissions. In the district court, he won summary judgments on several patents and a jury verdict of non-infringement and invalidity on the remaining ones. In the ITC proceedings, he obtained the first known positive advisory opinion and enforcement proceeding result for a respondent that redesigned a product.
- Obtained in Austin, and the Federal Circuit affirmed, two summary judgments for a defendant in the automobile- and hand-held navigation industry, ending a potentially costly litigation with minimal discovery expense.
- At claim construction in Detroit, avoided a trial and further legal expense by obtaining an indefiniteness patent invalidity ruling for an automobile parts supplier, which the Federal Circuit unanimously affirmed.
- Obtained a preliminary injunction in the Western District of Wisconsin to enforce two patents on lithium iron disulfide batteries.
- Defeated a preliminary injunction motion in Atlanta for a plastic molding machine equipment patent based, in part, on the "repair vs. reconstruction" doctrine.
- Won a trial holding a patent invalid and non-infringed in the D.C. district court for a Swiss client, which was affirmed without opinion one week after oral argument on appeal.

EXPERIENCE | LEGAL

- **Brinks Gilson & Lione**, Chicago, Illinois
1976-2019
President, 2006-2011

EXPERIENCE | TEACHING

- **Northwestern University School of Law**, Chicago, Illinois
Adjunct Professor, Patents and Copyrights
1981-1997

EXPERIENCE | CIVIC ACTIVITIES

- **Chicago and Northern Illinois Region of the National Conference for Community and Justice** (formerly the National Conference of Christians and Jews)
Executive Committee, 1986-2006
- **Lira Ensemble (Professional Polish Performing Arts Company)**
Board of Directors, 2012-2017

- **Northwestern University School of Law**
Law School Fund Board, 2003-2007

PRACTICE GROUPS AT BRINKS

Appellate
Copyright
International Trade Commission (ITC)
Licensing
Litigation
Post-Grant Patent
Trademarks & Unfair Competition

AREA OF FOCUS

Chemicals, Energy & Agriculture
Electrical & Computer
Mechanical
Automotive

PRESENTATIONS

- "U.S. Post-Grant Patent Proceedings—Inter-Partes Review (IPR)," VPP, Leipzig, Germany, October 25, 2017
- "PTAB and the District Court," Managing Intellectual Property US Patent Forum 2017, Palo Alto, California, March 21, 2017
- "PTAB and the District Courts," Brinks Webinar, May 18, 2017
- "Verletzungs- und Nichtigkeitsverfahren in den USA und Wechselwirkungen mit Verfahren vor dem US-Patentamt" (Infringement and Invalidity Proceedings in the US and Interactions with Procedures Before the US Patent Office), VPP, Würzburg, Germany, October 24, 2014
- "Intellectual Property Litigation in the US: Different Approaches via District Courts or the International Trade Commission," VPP, Leverkusen, Germany, June 13, 2013
- "The Business Case for Diversity: Reality or Wishful Thinking?" ABA Section of Litigation Annual CLE Conference, Chicago, Illinois, April 26, 2013
- "Comparison of International Competitiveness: What Works in the United States and What We Can Learn From Other Countries," Federal Circuit Bar Association 2012 Bench & Bar Conference, San Diego, California, June 23, 2012
- "Comparison of Patent Litigation in the United States, Germany and Japan," Illinois State Bar Association, Chicago, Illinois, June 12, 2008
- Minority Corporate Counsel Association Diversity Roundtable Discussion, Washington, D.C., August 7, 2007
- "Litigating Software Patents," Moderator, Intellectual Property Committee of the American Bar Association Section of Litigation Roundtable Discussion, Chicago, Illinois, April 27, 2006
- "ITC: Battles at the Border," Brinks Gilson & Lione Litigation Seminar, Chicago, Illinois, October 25, 2005
- "The ITC Rocket Docket," Brinks Gilson & Lione Seminar, Glenview, Illinois, May 31, 2005
- "Patent Infringement Issues," Law Seminars International, Patent Law for Business People and Non-Patent Lawyers, Chicago, Illinois, July 26, 2004
- "Client Relationship Management: Improving the In-House/Outside Counsel Relationship," LexisNexis, Law Firm Marketers' Roundtable, Phoenix, Arizona, November 4, 2003
- "Proof of Monetary Recovery Under the Lanham Act," LexisNexis, Advanced Trademark Strategies Conference, Chicago, Illinois, April 15-16, 2002

- Trial Practice Program, demonstrated direct examination techniques and acted as instructor, International Trademark Association, Chicago, Illinois, July 11-13, 2000
- "Grey-Market Goods and Parallel Imports," International Bar Association, Section on Business Law Conference, Barcelona, Spain, September 20-22, 1999
- "Claiming and Defending Against Monetary Awards for Trademark Infringement," International Trademark Association 119th Annual Meeting, San Antonio, Texas, May 3-7, 1997
- "Patenting of Computer Software," co-chair, International Bar Association 26th Biennial Conference, Berlin, Germany, October 14-18, 1996
- "Remedies In USA Patent Litigation," International Bar Association 25th Biennial Conference, Melbourne, Australia, October 9-14, 1994
- "Intellectual Property Rights in the United States," Wirtschaftsverband Industrieller Unternehmen Baden e.V., Freiburg, Germany, March 29, 1990
- "Intellectual Property Litigation in the United States," Deutscher Verband der Patentingenieure und Patentassessoren e.V., Wiesbaden, Germany, November 9, 1989
- "Intellectual Property Litigation in the United States," Gewerblicher Rechtsschutz und Urheberrecht – Bezirksgruppe Südwest, Stuttgart, Germany, October 4, 1989
- "Damages in Intellectual Property Litigation and the Right Of Publicity," International Bar Association's 22nd Biennial Conference, Buenos Aires, September 28 and 29, 1988
- "Revolutionary Changes In Liability and Rewards of New Product Development," Albany Law School/Rensselaer Polytechnic Institute Center for Industrial Innovation Conference, Albany, New York, June 4, 1986
- American Chemical Society, Division of Chemistry and The Law, 1985 Annual Meeting, Chicago, Illinois, September 10, 1985
- "Recent Developments in Trademark and Unfair Competition Law," Bureau of National Affairs Seminar, June 21, 1984
- "The Right of Publicity," United States Trademark Association Forum, New York, New York, March 16, 1983
- The American Patent Law Association's Annual Meetings, Miami, Florida, January 26, 1981; Scottsdale, Arizona, January 30, 1982
- 18th Annual Institute on Patent Law of the Southwestern Legal Foundation, Dallas, Texas, March 14, 1980

HONORS

- *The Best Lawyers in America*, Litigation - Intellectual Property, Litigation - Patent, 2020
- #1 Leading Intellectual Property Lawyer in Illinois, *Leading Lawyers*, 2014, 2018
- *Chambers USA: America's Leading Lawyers for Business*, 2008–2019
- *Euromoney Expert Guide to the World's Leading Patent Law Practitioners*, 1997, 1999, 2001, 2003, 2005, 2009, 2010, 2013, 2015, 2017
- Leading Patent Practitioner, *Intellectual Asset Management* magazine's "IAM Patent 1000: The World's Leading Patent Practitioners," 2012-2018
- Legal Media Group *Expert Guide: Trademark*, 2018
- Top Rated Lawyer in Appellate Law, Martindale-Hubbell "AV" Peer-Review, 2013
- Patent Litigation Lawyer of the Year - Chicago, *The Best Lawyers in America*, 2013
- Fellow of the Litigation Counsel of America, 2013-2016
- Leading Patent Litigator, *Intellectual Asset Management* magazine's "IAM Patent Litigation 250 - The World's Leading Patent Litigators," 2011
- Leading Intellectual Property Lawyer, *Leading Lawyers Network*, Law Bulletin Publishing Company, 2004–2007, 2009–2017

- Top 100 Business Lawyers, Leading Lawyers Network, 2012
- #6 among the Top Ten Business Litigators in Illinois, 2009
- Top 10 Leading Lawyers for Business in Illinois, 2006, 2007, 2009, 2010
- Illinois Super Lawyers, Intellectual Property Litigation, 2005–2017
- Illinois Super Lawyers, Top 10 Attorneys, 2006, 2007
- Illinois Super Lawyers, Top 100 Attorneys, 2008–2010, 2012
- *Lawyer Monthly*, Leading Lawyer 100 - Intellectual Property, 2011
- Best of the Best USA: Patents, 2008, 2010, 2012, 2014, 2016
- *PLC Which lawyer?*, Recommended Intellectual Property Lawyer in Chicago, 2006–2012
- *The Best Lawyers in America*, Litigation - Intellectual Property, Litigation - Patent, 2011-2019
- *Who's Who Legal - Patents*, 2001, 2003, 2005, 2007, 2008, 2010-2012, 2014-2016, 2018-2019
- *Who's Who Legal - Trademarks*, 2001, 2004, 2005, 2007, 2009, 2011, 2012, 2014
- *International Who's Who of Business Lawyers*, 2009, 2013
- *Managing Intellectual Property's Guide to the World's Leading Trade Mark Law Practitioners*, 2006–2008
- *Euromoney Guide to the World's Leading Trade Mark Law Practitioners*, 1996, 1998, 2000, 2006, 2008, 2009, 2012, 2018
- Stephen P. Ladas Award from the United States Trademark Association for outstanding article in the field of trademark law, 1980
- Robert C. Watson Award from the American Patent Law Association for outstanding article in the field of patent law, 1977
- Executive Editor, *Journal of Criminal Law and Criminology*, Northwestern University, 1975–1976
- Tau Beta Pi, Carnegie-Mellon University

PAST AFFILIATIONS

- American Bar Association
Dispute Resolution Section—Intellectual Property Section
Intellectual Property Section—Alternative Dispute Resolution Committee
Litigation Section
Senior Lawyers Division—Alternative Dispute Resolution Committee
- American Intellectual Property Law Association
Acting Judge, Giles S. Rich Moot Court Competition
- Chicago Committee on Minorities in Large Law Firms
Inaugural Mentorship Academy, Mentor
- Federal Circuit Bar Association
- Institute for Inclusion in the Legal Profession
Advisory Board Member, 2010-2018
- Intellectual Property Law Association of Chicago
Chair, Antitrust Committee, 1995-1997
- Intellectual Property Litigator Editorial Board, 1997-2002
- Intellectual Property Owners Association
Vice-Chair, Patent Law Committee, 2012-2018
Member, Annual Meeting Program Committee, 2009
Member, Damages and Injunctions Committee, 2009
Vice-Chair, Committee on Discovery in Litigation, 2000-2004
- International Bar Association
Chair, Patent Subcommittee of the Intellectual Property Committee, 1994-1997

Biographies | Gary M. Ropski

- International Trade Commission Trial Lawyers Association
- International Trademark Association
Trademark Mediators Network, 2014-present
Special Advisor to U.S. Legislation Committee regarding drafting a federal right of publicity statute, 1994-1998
Editorial Board, The Trademark Reporter, 1981-1984; 1987-1989
- Litigation Counsel of America, 2014-15
Diversity Law Institute, 2014-15
Member, The Trial Law Institute, 2014-15
Barrister, Order of Veritas, 2014-15
Barrister, Order of Certus, 2014-15
- Richard Linn American Inn of Court, 2006-2019

LANGUAGES

- German

REPRESENTATIVE MATTERS

- Patent Litigation
- At claim construction, obtained an indefiniteness invalidity ruling regarding two nonce, generic terms lacking support in the patent specification, which the Federal Circuit unanimously affirmed.
- Affirmance of two summary judgments granted for defendants in Austin, Texas with minimal discovery expense. The plaintiff had been trying unsuccessfully to get the court to rule that electronic encyclopedia patents also covered automobile and hand-held navigation systems.
- Settlement of an ITC proceeding and district court action in Los Angeles relating to 14 aviation-related patents asserted to cover automobile and hand-held navigation systems.
- Obtained a preliminary injunction in Madison, Wisconsin to enforce two patents on lithium iron disulfide batteries.
- Successfully defended German and U.S. companies in ITC proceedings in Washington, DC and district court actions in Detroit, alleging infringement of 11 patents relating to automated mechanical transmissions, including summary judgment for the defendant companies on several patents and a jury verdict of non-infringement and invalidity on the remaining patents. Also obtained the first known positive advisory opinion and enforcement proceeding result from the ITC for a respondent who redesigned a product.
- Settlement of a four-patent lawsuit in Los Angeles involving web-enabled controllers after various summary judgment motions in favor of our client.
- Settlement of a patent infringement lawsuit for an electronic futures trading system a month before trial in Dallas, involving the leading futures exchanges in the country, permitting our client to continue its activities for a payment of less than 5% of the damages sought by plaintiffs.
- Obtained dismissal of a district court case in Chicago in which the plaintiff alleged breach of contract as well as trade secret and copyright infringement regarding health insurance computer software for debugging computer programs, based on untimely submission of the claims and failure to protect trade secrets.
- Defeated preliminary injunction motion in Atlanta for a plastic molding machine equipment patent based, in part, on the “repair vs. reconstruction” doctrine.
- Obtained consent judgments in Rockford, Illinois against nine companies infringing patents for parallel port peripheral products for use with a personal computer.
- Obtained summary judgment in Newark holding noninfringement of a patent for low-fat cheese asserted against four of the largest U.S. cheese manufacturers; affirmed on appeal.

- Won a trial in Washington, DC holding a patent invalid and non-infringed for our Swiss client, which was affirmed without opinion one week after oral argument on appeal.
 - Protected our client in Greeneville, Tennessee by limiting a trial judgment to less than 15% of the amount sought by the patentee relating to a furnace used in making fused silica.
 - Completed an ITC proceeding within a year of patent issuance with permanent injunctions against two respondents and favorable settlements against the others for a patent relating to SIMM memory modules.
 - Obtained judgment of inequitable conduct after a two-week bench trial in Delaware on a patent asserted against several large machine tool manufacturers relating to flexible manufacturing systems—inequitable conduct affirmed on appeal.
 - Obtained a summary judgment in San Francisco of non-infringement of a patent for air conveyors, based on the reverse doctrine of equivalents even though literal infringement was found on some claims.
- Trademark and Copyright Litigation
- Successfully stopped infringement of the famous design trademark, service mark and trade dress for the RUBIK's CUBE puzzle design in district court and at the U.S. Border Patrol (Customs) in Washington, DC.
 - Obtained summary judgment dismissing all counts of copyright and trade secret infringement and breach of contract for computer software for debugging computer programs used in the insurance industry.
 - Won an appeal in the Ninth Circuit affirming our client's fair use of alleged trade dress in a heart-shaped cut-out in a metal figurine on issues of decorativeness, functionality and ornamental, non-trademark use.
 - Settled a case between major competitors relating to trade dress in the shape of the head of a cable tie and a related trademark.
 - Obtained a consent judgment after successful summary judgment motions thwarted a significant competitor's product comparisons involving false statements about our client's trucks.
 - Received summary judgment eliminating defendant's defenses of fair use, priority, laches and estoppel in a trademark lawsuit relating to fire trucks and heavy duty trucks.
 - Prevented our client's competitor from using a NASDAQ trading symbol identical to the trademark of our client.
 - Settled a right of publicity and trademark lawsuit permitting our client to continue to use the name EAMES for furniture.
 - Established the rule in the Seventh Circuit that a first-filed declaratory judgment action does not take precedence when it merely anticipates an assertive action filed for trademark infringement.
 - Developed a courthouse-steps settlement just prior to a judge announcing his decision on a preliminary injunction motion. A non-competitive business had been seeking to prevent our client from using its new trademark based on reverse confusion.
 - Obtained denial of a preliminary injunction against our client on a false advertising claim for "five full ounces of milk in every slice."
 - Argued one of the first cases in the Federal Circuit, which affirmed a TTAB decision awarding priority and deciding likelihood of confusion in favor of our client.