

Partner

Paul B. Henkelmann

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📍 Chicago, IL



## Profile

"I enjoy the challenge of effectively understanding a client's technology and business objectives and applying the law to get a good result."

Paul B. Henkelmann focuses his practice on patent post-issuance proceedings, U.S. and international patent procurement, and intellectual property litigation and counseling. He has represented clients as both lead and second chair counsel in well over 40 *inter partes* review (IPR) and covered business methods proceedings, including developing expert declarations, taking and defending expert depositions and presenting oral argument. Paul has substantial experience in both asserting and defending against patent and trademark infringement claims in the federal courts, while remaining active in procuring and managing international IP portfolios. Paul also frequently assists clients with product clearance to mitigate risk and accurately assess their freedom to operate.

Paul has experience representing clients in a wide variety of industries, including the following:

- Semiconductors
- Computer peripherals
- Software
- Electronics
- Nanocoatings
- Plasma polymerization
- Medical devices
- Surgical tools
- Industrial tools and machinery
- Automotive transmissions
- Automotive restraint systems
- Automotive roof systems
- Sporting goods
- Sports medicine
- Performance apparel
- Footwear
- Educational tools
- Printing equipment
- Packaging
- Consumer products
- Control systems
- Electric fans
- Digital rights management

## Education

J.D., Chicago-Kent College of Law, 2007, *with Honors*

B.S., General Engineering (Minor in German), University of Illinois at Urbana-Champaign, 2002

## Bar Admissions

Illinois

Colorado

U.S. Patent and Trademark Office

U.S. Court of Appeals for the Federal Circuit

U.S. District Court for the Northern District of Illinois

U.S. District Court for the Eastern District of Michigan

## Recognition

Named a Top 200 Best Performing Attorney Representing Patent Owners at the PTAB by Patexia (case range 2018–23)

Named a Top 100 Most Active Attorney Representing Patent Owners in IPRs by Patexia (case range 2014–19)

Clients benefit from Paul's broad technical background and experience. Prior to joining Fitch Even, he was a project engineer for an original equipment manufacturer in the printing industry. There he was responsible for designing, developing, and testing a diverse line of automated process control equipment.

As an undergraduate at the University of Illinois, Paul's studies focused on mechanical and electrical engineering, controls, and programming. He was awarded a one-year grant to study mechanical engineering at the Technische Universität München in Munich, Germany.

Paul is conversationally fluent in German.

Paul is a member of Fitch Even's Marketing and Client Development Committee

## Representative Matters

- *Favored Tech Corporation v. P2i Ltd.* (PTAB 2021-23). Lead counsel representing P2i in IPR proceeding filed against its patent directed to plasma-polymerized protective nanocoating technology. Obtained final written decision upholding patentability of all claims. Secured Rule 36 affirmance from Federal Circuit on appeal.
- *Google Inc. and Apple Inc. v. ContentGuard Holdings, Inc.* (PTAB 2015). Integral member of team representing ContentGuard in 35 IPR and CBM proceedings filed against its digital rights management patent portfolio. Five proceedings dismissed voluntarily. After submission of patent owner preliminary responses, obtained PTAB decisions denying institution of trial in all but one remaining proceeding.
- *Epic Provisions v. Luchi LLC* (W.D. Tex. 2015). Represented Luchi in defense of its trademark rights. Case settled favorably for Luchi to maintain its trademark rights and control of the vegetarian protein supplement market.
- *TK Holdings Inc. v. CTS Corporation and CTS Automotive Products* (E.D. Mich. 2008-14). Member of litigation team defending claims of infringement under patents relating to automotive seat weight sensors. Obtained summary judgment rulings that our client's sensors do not infringe and that the asserted patents are invalid for multiple reasons.
- *McDavid Knee Guard, Inc. et al. v. Adidas Sales, Inc.* (N.D. Ill. 2009). Member of litigation team representing plaintiff in a patent infringement action related to protective apparel. Settlement reached.
- *McDavid Knee Guard, Inc. et al. v. Nike USA, Inc.* (N.D. Ill. 2008-14). Member of litigation team representing plaintiff in a patent infringement action

## Services

International IP Protection

IP Litigation

Appellate Practice

Brand Enforcement

Commercial + Technology  
Disputes

Copyright Disputes

IP Professional  
Responsibility + Malpractice

ITC Section 337 Disputes

Northern District of Illinois  
Local Counsel Services

Patent Litigation

Standard Essential Patents

Trade Secret Litigation

IP Portfolio Management

IP Strategy Development

Patent Preparation +  
Prosecution

Product Clearance + Legal  
Opinions

PTAB Trial Practice

Reissue + Reexamination  
Proceedings

## Industries

Computer Software +  
Hardware

Consumer Products +  
Packaging

Electronics

Environmental Engineering

Material Science

Mechanical Engineering +  
Manufacturing

Medical Devices + Diagnostics

Transportation

related to protective apparel. Settlement reached.

## Presentations + Publications

### Presentations

- “Discretionary Denial and Beyond: Recent Developments in AIA Trial Practice,” Fitch Even Webinar, with Brian P. Herrmann, July 27, 2023.
- “The European Patent System Is A-Changin’: The Unitary Patent and Unified Patent Court,” Moderator, Fitch Even + Greaves Brewster Webinar, October 18, 2022.
- “Leveraging Separate IPR Counsel to Maximize Litigation Success,” Fitch Even Webinar, with Timothy P. Maloney, November 18, 2021.
- “Tales from the IPR Counsel’s Table,” Fitch Even Webinar, with Nicholas T. Peters, June 4, 2020.
- “Post-Grant Strategies for Correcting and Challenging Patent Claims,” Co-presenter, American Intellectual Property Law Association webinar, March 4, 2020.
- “Immunity for Sale? Tribal and State Sovereign Immunity at the PTAB,” Fitch Even Webinar, Co-Presenter, February 22, 2018.
- “Reasonable Error Correction or Death Squads—Is the PTAB’s Invalidation Rate Too High or Just Right?,” Moderator, Chicago-Kent College of Law, October 20, 2017.
- “*Inter Partes* Review Tips and Considerations for Practitioners,” Fitch Even, Washington, D.C., October 28, 2015.
- “Joint Infringement and Indefiniteness After *Limelight* and *Nautilus*,” Fitch Even Webinar, June 26, 2014.
- “Patent Law Primer Post-AIA: Do We Still Need to Keep Lab Notebooks?,” Fitch Even Webinar, November 21, 2013.
- “Practical Considerations for U.S. Patent Practice After the America Invents Act,” Grünecker, Kinkeldey, Stockmair & Schwanhäusser, Munich, Germany, October 8, 2013.
- “How Far Do You Have to Look Under the Rock? To What Extent Is There a Duty to Investigate Potentially Invalidating Prior Art?,” with Karl R. Fink and Joseph F. Marinelli, AIPLA 2009 Annual Meeting, Washington, D.C., October 15, 2009.

## **Publications**

- “Your Patent Has Been Challenged in an IPR; Now What?,” *Business Law Today*, American Bar Association, June 2021.

## **Memberships**

- PTAB Bar Association
  - Communications Committee