



**James P. Muraff**

**Member**

**Chicago**

**P: 312.642.1480**

### **Practice Focus**

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- Intellectual property
- Patents
- Trademark, branding, and e-commerce strategies
- Copyrights
- Trade secrets
- Trade secret, non-compete and unfair competition
- Intellectual property litigation and dispute resolution
- Business litigation
- Appeals
- International protection
- Technology transfer
- Franchising, licensing, and distribution
- Social media
- Media and First Amendment
- Portfolio management
- Antitrust and trade regulation
- Emerging technologies
- Automotive
- Medical devices
- Physicians and other health professionals
- Life sciences
- Sales representative and consulting
- Financial services
- Oil and gas
- Renewable energy development
- Solar energy development
- Colleges and universities

Jim is a member in McDonald Hopkins Intellectual Property Department and a strategic intellectual property advisor who helps clients develop and protect the value of their global intellectual property portfolios. His practice encompasses all components of intellectual property – domestic and foreign patents, trademarks, copyrights and trade secrets – with a primary focus on businesses seeking market penetration and growth in

the use of computer software, hardware, electronics, automation, and internet technologies.

A registered patent attorney, Jim is highly experienced in patent clearance and patentability counseling, as well as patent application preparation and prosecution before the U.S. Patent and Trademark Office. He regularly advises clients concerning corporate transactions, licenses and transfers related to various components of their intellectual property portfolios. Jim also has extensive experience enforcing and defending clients' intellectual property rights in litigation involving numerous technologies before federal courts across the country.

Before he started his legal career, Jim obtained valuable industry experience as a software engineer and systems analyst. He gained valuable insight into the vital business considerations and needs of companies that develop and market high-tech software and hardware products. His practical and legal background enables him to serve as a reliable business and legal advisor who develops cost-effective and competition-focused strategies to achieve their objectives.

A substantial portion of Jim's practice is devoted to protecting and developing comprehensive intellectual property portfolio strategies for communications, AI, data and system security and reliability, mobility, autonomous, navigation, controls, infotainment, data analysis, and other technologies in various industry sectors, including entertainment and streaming systems, automobiles and heavy equipment, healthcare devices and systems, medication delivery systems, pharmacy prescription-servicing systems, direct and online order fulfillment systems, automated vending systems, consumer electronics and products, and other businesses and industries. He has also acted as a legal testifying expert in a patent infringement action.

Jim is an adjunct faculty member of the University of Illinois – Chicago School of Law, where he teaches substantive U.S. patent law. Jim further teaches Chinese patent examiners and re-examiners, as well as groups of Chinese IP attorneys, U.S. patent law topics within a program he helped create through The John Marshall Law School Chinese IP Resource Center.

He has also been listed with Best Lawyers and Chambers for patent law for several years. He has served on the board of managers and various committees of IPLAC and acted as the Vice President of the IPLAC Educational Foundation. Jim is a contributing author for Patent Claim Construction in the Federal Circuit and has been for many years. Jim has also sat on the AIPLA Quarterly Journal Editorial Board. He has also been a judge for the History Channel's Modern Marvels Invent Now Challenge. Jim is often quoted in the press on intellectual property law matters.

Jim earned his J.D. from the University of Illinois – Chicago School of Law in 1994 and his B.S. in Computer Engineering from the University of Illinois at Urbana-Champaign in 1990.

### Representative Cases/Matters

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- *Redbox Automated Retail, LLC v. The Giving Dogs* (Trademark Trial and Appeal Board) – Represented plaintiff in a trademark opposition proceeding.
- *Redbox Automated Retail, LLC v. Chinecherem Eze LLC* (Trademark Trial and Appeal Board) – Represented plaintiff in a trademark opposition proceeding.
- *SBS Consulting Group, Inc. v. Alpha Exploration Company* (D. AZ.) – Represented plaintiff in a trademark infringement and unfair competition matter relating to social and business networking platforms.
- *CZS Holdings LLC (d/b/a Pur360) v. Arpad Kolbe and ARKO Ozone & UV Disinfection* (N.D. Ill.) – Represented plaintiff in a breach of contract and trade secret misappropriation matter relating to disinfection and

eradication systems and services.

- *Redbox Automated Retail, LLC v. Beijing Jiadun Building Materials Co., Ltd.* (Trademark Trial and Appeal Board) – Represented plaintiff in a trademark opposition proceeding.
- *Redbox Automated Retail, LLC v. Box, Inc.* (Trademark Trial and Appeal Board) – Represented plaintiff in a trademark opposition proceeding.
- *Vevo LLC v. Fevo Inc.* (Trademark Trial and Appeal Board) – Represented defendant in a trademark opposition proceeding.
- *Snap Inc. v. Enviropedia, Inc.* (Trademark Trial and Appeal Board) – Represented defendant in multiple trademark opposition proceedings.
- *Sportsheets International, Inc. v. Paul Jean* (N.D. Ill.) - Represented plaintiff in a trademark infringement matter relating to adult novelty goods.
- *RemoteMD L.L.C. v. Runabetterset LLC* (Trademark Trial and Appeal Board) – Represented plaintiff in a trademark opposition proceeding.
- *Redbox Automated Retail, LLC v. Staples, Inc.* (Trademark Trial and Appeal Board) – Represented plaintiff in a trademark opposition proceeding.
- *Redbox Automated Retail, LLC v. Target Brands, Inc.* (Trademark Trial and Appeal Board) – Represented plaintiff in a trademark opposition proceeding.
- *Sportsheets International, Inc. v. Luxurious Bliss* (N.D. Ill.) – Represented plaintiff in a trademark infringement matter relating to adult novelty goods.
- *Paul Jean v. Sportsheets International, Inc.* (Trademark Trial and Appeal Board) – Represented defendant in a trademark cancellation proceeding.
- *Johnsonville Sausage, LLC v. Klement Sausage Co., Inc.* (E.D. Wi.) – Acted as a testifying expert in a design patent infringement matter regarding food product packaging.
- *Syngen Inc. v. Cesca Therapeutics, Inc.* (9th Cir.) – Represented appellee in an appeal regarding contractual arbitration clauses.
- *Cesca Therapeutics, Inc. v. Syngen Inc.* (E.D. Cal.) – Represented plaintiff in a trade secret, patent infringement, and breach of contract matter relating to stem cell storage devices.
- *Sportsheets International, Inc. v. The Stockroom, Inc.* (C.D. Cal.) – Represented plaintiff in a trademark and unfair competition matter relating to adult novelty goods.
- *CarLyd Enterprises v. Jean-Robert Paquette* (S.D. Oh.) – Represented defendant in a patent infringement matter relating to sporting goods.
- *Hawk Technology Systems, LLC v. Presence Hospitals PRV* (C.D. Ill.) – Represented defendant in a patent infringement matter relating to digital video surveillance systems.
- *Hawk Technology Systems, LLC v. United Scrap Metal, Inc.* (N.D. Ill.) – Represented defendant in a patent infringement matter relating to digital video surveillance systems.
- *UL LLC v. Spencer Gifts LLC and Sportsheets International, Inc.* (N.D. Ill.) – Represented defendant in response to a charge of trademark infringement and involving a U.S. Customs and Border Patrol seizure of goods.
- *Redbox Automated Retail, LLC v. HAPA AG* (Trademark Trial and Appeal Board) – Represented plaintiff in a trademark cancellation proceeding before the USPTO Trademark Trial and Appeal Board.
- *Redbox Automated Retail, LLC v. Stanley Lee Barnes d/b/a Red Box Tickets USA, LLC* (Trademark Trial and Appeal Board) – Represented plaintiff in a trademark opposition proceeding before the USPTO Trademark Trial and Appeal Board.

- *Samsung Electronics Co., Ltd. et al. v. Petters Group Worldwide, LLC et al.* (D. Del.) – Represented defendant in a patent infringement matter relating to consumer electronics.
- *NICE Bearings, Inc. v. PEER Bearing Co.* (D. Conn.) – Represented defendant in a trademark and copyright infringement matter relating to product identifiers.
- *Palmgard International, Inc. v. Hillerich & Bradsby Co., Inc.* (N.D. Ill.) – Represented patent owner in a patent infringement matter relating to sports equipment.
- *Redbox Automated Retail v. DVDPlay, Inc.* (N.D. Ill.) – Represented patent owner in a patent infringement matter relating to DVD distribution systems.
- *Lavalife, Inc. v. Sportsheets International, Inc.* (Trademark Trial and Appeal Board) – Represented trademark owner in an opposition proceeding before the USPTO Trademark Trial and Appeal Board.
- *Civix-DDI, LLC v. National Association of Realtors* (N.D. Ill.) – Obtained favorable decision for granting patent re-examination from the USPTO for the patent-in-suit, establishing basis for extended stay of this lawsuit.
- *KSR International Co. v. Teleflex Inc., et al.* – Of Counsel in a Supreme Court brief filed by the Intellectual Property Association of Chicago as amicus curiae.
- *Cooper Bauck Corp. v. Dolby Labs, Inc.* (N.D. Ill.) – Represented defendant in a patent infringement matter relating to audio electronics technology.
- *Order Inn, Inc. v. Room Serv. USA, Inc.* (D. Ariz.) – Represented brand owner in a trademark infringement matter relating to the food service industry.
- *M&R Printing Equipment, Inc. v. Anatol Equipment Manufacturing Co., et al.* (N.D. Ill.) – Represented patent owner in a patent infringement matter relating to a clothing printing apparatus.
- *Kane Graphical Corp. v. Magnetic Specialty* (N.D. Ill.) – Represented patent owner in a patent infringement matter relating to advertising products.
- *Interactive Health LLC v. Finger-Fitting Products Inc.* (C.D. Cal.) – Represented defendant in a patent infringement matter relating to adult novelty products.
- *Jackson v. Alaska Airlines Inc. et al.; Jackson v. NEC Corporation; Jackson v. Advanced Telecom; Jackson v. Info Brokerage; and Jackson v. X10 Wireless* (N.D. Ill.) – Represented patent owner in various patent infringement matters relating to automated interactive voice response (IVR) systems.
- *Wolfram Research v. Cook* (N.D. Ill.) – Represented plaintiff in a breach of contract and trade secret misappropriation matter relating to scientific theories.
- *Knowles Electronics, Inc. v. Microtronic U.S., Inc.* (N.D. Ill.) – Represented patent owner in a patent infringement matter relating to transducers and hearing aid technology.
- *M&R Printing v. Tooling & Special* (N.D. Ill.) – Represented plaintiff in a patent infringement and copyright infringement matter relating to control software for printing presses.
- *Worldtronics International v. Ever Splendor Enterprise Co.; Worldtronics International v. High Performance Appliances; Worldtronics International v. Simatelex Manufacturing Co. Ltd.; and Worldtronics International vs. Black & Decker Inc, et al.* (N.D. Ill.) – Represented patent owner in patent infringement matters relating to controls circuitry for consumer electronics products.
- *Optodyne v. Leica* (N.D. Ill.) – Represented plaintiff in a trade secret misappropriation matter relating to optical positioning and control systems.
- *Florida Fruit v. Diamond Drinks* (N.D. Ill.) – Represented plaintiff in a trademark infringement matter relating to fruit juices.
- *OSI Industries v. Simeus Foods* (N.D. Ill.) – Represented plaintiff in a trademark infringement and unfair

trade competition matter relating to wholesale food products.

- *Hampden v. Advance Watch* (N.D. Ill.) – Represented plaintiff in a copyright infringement matter relating to jewelry designs.
- *Ginter v. Real Media* (N.D. Ill.) – Represented defendant in a trademark infringement matter and a related bankruptcy proceeding involving religious youth publications.
- *AnSCO Photo v. Freider* (N.D. Ill.) – Represented plaintiff in a copyright infringement matter relating to packaging for one-time use cameras.
- *Premier Networks v. US West* (N.D. Ill.) – Represented plaintiff in a patent infringement matter relating to electronics.
- *IP Innovation v. Merant PLC and IP Innovation v. Information Builders, Inc.* (N.D. Ill.) – Represented plaintiff in a patent infringement matter relating to database access technology.
- *RX Plastics v. Alpha Ag Inc., et al.* (N.D. Ill.) – Represented defendant in a patent infringement matter relating to farm equipment.

### Admissions - Court

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- Illinois Supreme Court
- U.S. Bankruptcy Court for the Southern District of Florida
- U.S. Court of Appeals for the 9th Circuit
- U.S. Court of Appeals for the Federal Circuit
- U.S. District Court for the Central District of Illinois
- U.S. District Court for the District of Connecticut
- U.S. District Court for the Eastern District of Michigan
- U.S. District Court for the Northern District of Illinois
- U.S. District Court for the Southern District of New York
- U.S. Patent and Trademark Office

### Admissions - State

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- Illinois

### Education

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- University of Illinois – Chicago School of Law
- University of Illinois - Urbana-Champaign

### Honors and Awards

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- Best Lawyers (2016-2022)

### Professional Membership

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- Intellectual Property Law Association of Chicago (IPLAC) – former board member

### Public Service and Volunteerism

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- IPLAC Educational Foundational – former Vice President and Treasurer
- Northbrook 4<sup>th</sup> of July Association – former board member

### Blog Posts

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- Parties to exploratory agreements beware: Contractual restrictions on IPR patent challenges are enforceable!

### News

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- 50 McDonald Hopkins attorneys recognized in The Best Lawyers
- Lawyer of the Year honorees Riley and Welin among 42 McDonald Hopkins attorneys recognized as 2021 Best Lawyers
- Intellectual property attorney James P. Muraff joins Chicago office of McDonald Hopkins LLC

### External Publications

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- Contributing author, "Patent Claim Construction in the Federal Circuit," (2010-2022 editions)

### Events

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- IPLAC 2021 Annual IP Symposium: Perspectives from the Judges and Inside Counsel | Tuesday, December 7, 2021
- IP Innovation Webinar Series, Session 6 | Thursday, June 24, 2021

### Speaking Engagements

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- "The IPLAC 2020 Annual IP Symposium: An Afternoon with the Judges," Intellectual Property Law Association of Chicago, December 3, 2020
- "Artificial Intelligence: Fault Lines, Key Issues, and the Way Ahead," UIC John Marshall Law School's 3rd Annual Intellectual Property Roundtable, October 31, 2019
- "Patent Application Readiness," USPTO's Chicago Regional Seminar, April 18, 2019