



Jonathan E. Retsky

Partner

Jonathan Retsky's practice focuses primarily on patent litigation and counseling. He has specific experience in patent litigation regarding telecommunication, vehicle navigation/location and semiconductor technologies. Mr. Retsky also has experience in protecting computer software and hardware, licensing, technology transfer due diligence, and providing opinions of counsel regarding non-infringement and invalidity. Mr. Retsky has unique experience in intellectual asset management, including developing in-house IP strategies and processes.

Prior to joining Howrey, Mr. Retsky served as Corporate Vice President at Motorola, where he was responsible for Motorola's patent preparation, prosecution and maintenance activities. He oversaw a worldwide organization including 50 patent lawyers, and a portfolio of more than 25,000 patents. Mr. Retsky also managed Motorola's defensive IP litigation and matter management practices. As a design engineer, Mr. Retsky was a member of the architectural team for the Motorola 68030 microprocessor.

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ADMISSIONS

Illinois

EDUCATION

University of Texas School of Law
(JD, 1989)

Bradley University (BS, 1984)

REPRESENTATIVE MATTERS

- *BFGoodrich v. Insight*. Represented plaintiff in a preliminary injunction hearing. Patent covered a lightning strike detector for use in small airplanes. After 2-day trial, preliminary injunction was granted, which was affirmed on appeal.
- *Micro Solutions v. Hewlett-Packard et al.* Represented plaintiff-patentee on patent to parallel port interface to computer peripheral devices such as disk drives. Negotiated favorable settlement, which included Hewlett Packard exiting the parallel port computer peripheral business.
- *Oasis Technologies v. Sierra Design*. Represented plaintiff patent owner in preliminary injunction hearing. Patent was directed to electronic gaming system with a fixed pool of winning plays. After 3-day trial, preliminary injunction was denied.
- *SPS Technologies v. Motorola, Inc.* Represented defendant in 9-week trial against mis-appropriation of trade secrets claim. Trial resulted in a hung jury. Plaintiff was represented by Willie Gary.
- *Vehicle IP v. General Motors et al.* Represented GM in defense of charges of patent infringement for its OnStar service. Patent was directed to server-based vehicle navigation system. Won summary judgment of non-infringement.
- *Williams Wireless v. General Motors et al.* Represented GM against

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charges of patent infringement. Patent was directed to use of fax machines to send digital data. Plaintiff settled with a walk-away dismissal with prejudice for failing to comply with E.D. Texas patent disclosure rules.

COURTS & ADJUDICATIVE BODIES

- United States Court of Appeals for the Federal Circuit
- United States District Court for the Northern District of Illinois
- United States Patent and Trademark Office

PROFESSIONAL AFFILIATIONS

- Intellectual Property Law Association of Chicago
- Intellectual Property Owners Association
- Co-Chair, Licensing Executive Society
- Master of the Bench Membership, Richard Linn American Court

PUBLICATIONS & SPEAKING ENGAGEMENTS

ARTICLES

"Patent and Trade Secret Protection of Computer Technology." *VI Software L.J.* (2003). Co-authored with Gustavo Siller.

"Six Steps to Negotiating Successfully Through a Software Audit." *XIII Computer Law Strategist* (August 1996).

"Computer Software Protection in 1996: A Practitioner's Nightmare." *J. Marshall L. Review* (1996).

TESTIMONY

IPM Versus Attorney/Client Privilege - Managing the Grey Areas. IP Forum, Half Moon Bay, (March 2007).

Strategic Planning of Corporate IP. Corporate Patent Seminar, (2005).

International Strategies of Patenting Computer Software. International Bar Association, (October 1996).

IN THE NEWS

"Panning for Gold Nuggets in Your Patent/IP Portfolio." *SkyRadio, United Airlines* (February 2005).

"Maxing Out." *IP Law & Business* (February 2005).

"Interviewed on "The Money Wheel" regarding Digital Equipment Corp. v. Intel Corp." *CNBC business news program* (May 1997).