

ANALYSIS: PATENTS

According to the State of Illinois, it is America's 4th largest industrial state, boasting over 11,800 Illinois-based manufacturers. The state's location within the industrial and geographical centre of the country contributes to its position as one of the nation's manufacturing leaders and the healthy research and manufacturing industry encourages strong patent output. The US Patent and Trademark Office records that 7,833 patent applications were led in Illinois in 2005. The research for this chapter has identified 21 leading practitioners in Illinois. We have focused our research on pre-eminent patent litigators – excluding, where possible, patent attorneys (or patent agents). The inclusion of a large number of individuals from specialised intellectual property firms highlights the weight that such outputs carry within the market.

The most highly nominated individual is from an IP boutique. **Mark Banner** of Banner & Witcoff Ltd is a "born patent litigator" and according to at least one source "deserves to be at the top of the list". He is also regarded as an authority in the area: having co-authored a *Patent Trial Advocacy Casebook* in conjunction with the American Bar Association and the National Institute for Trial Advocacy. Banner is past-chair of the American Bar Association's and former chairman of the Illinois State Bar Association's sections of intellectual property law.

There remain four other individuals that despite being the only ones from their firms on our list are of such renown they ensure their firms are well regarded in the market. Jenner & Block LLP can boast the "top-shelf" **Harry Roper**, who performed exceptionally well in the nominations. During the course of our research it became apparent

that clients and peers "think the world of him". He chairs the firm's intellectual property practice and was praised as a "highly skilled patent litigator". During his career he has represented companies such as Dow Chemical, Johnson & Johnson and Phillips Petroleum in patent infringement cases. Roper was recently lead trial counsel for Alza, a Johnson & Johnson subsidiary, successfully defending Alza's patent on a major anti-cancer drug from claims of inventorship by the plaintiff.

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Michael Warnecke from Mayer Brown Rowe & Maw LLP brings a "superb reputation" to the table. Before entering private practice, Warnecke was a patent examiner for the US Patent and Trademark Office in Washington DC. He has an "impressive national and international practice" that includes providing counsel to the Chinese government. Warnecke is, according to one source, "a force to be reckoned with" and he was placed in the upper ranks of our list.

Another individual with respected international experience is Leydig Voit & Mayer's **Michael Hartmann**.

Before joining the firm, he was employed as an engineer by Mobil Oil Corporation and completed an internship with a German patent firm. He puts this experience to use in a diverse and highly technical patent practice. Hartmann specialises in patent litigation in the area of international technology transfer and patent enforcement. He represents clients from diverse technical fields, including geophysical surveying equipment, polymeric soft contact lenses, molecular sieve zeolites, machine tools, ethylene oxide catalysts, and polymeric membranes.

Edward O'Toole practises at McCracken & Frank LLP and is known for his "deep industry knowledge". His practice concentrates on patent infringement litigation. He has asked for clients in the chemical, biotechnology, pharmaceutical, and mechanical industries throughout his illustrious career. These clients include such names as General Tire & Rubber Co, Dow Chemical Co, Abbott Laboratories and General Mills. O'Toole is also known for his in-depth knowledge of Markman hearings, writing and speaking on this topic frequently.

Jones Day partner **David Witcoff** features in this chapter; his degree in Electrical Engineering stands him in good stead to deal with high-technology patent disputes. Examples of such cases include the recent successful defence of Motorola and Freescale against allegations of infringing a patent generally related to simulation of a semiconductor fabrication plant in *Information Technology Innovation v Motorola and Freescale Semiconductor*. Witcoff also defended IBM against charges of patent infringement relating to updating and displaying electronic catalogue product information over the internet in



Harry Roper



Michael Warnecke



David Pritkin



Hugh Abrams



Richard Cederroth