

**Charles W. Shifley**

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Over a full career, Charles has concentrated on intellectual property cases, trials, and issues. Recently, Charles has taken a lead in Patent Office inter partes review (IPR) practice. He has both challenged patents with IPR petitions and defended patent owners with IPR responses. See for example IPR2017-00861 and IPR2015-00409. He has also written extensively to share his perspectives on these experiences with those who might be less familiar with IPR practices. See for example the PTAB Highlights in the Library.

Other recent experiences of Charles have included the following:

- Charles and a team represented the maker of devices to reproduce iPhone touch screen icons on car displays, as in Buick vehicles, against allegations of patent infringement.
- Charles and a team gained the transfer of an ongoing patent case from the home base of Caterpillar in Peoria to a neutral court in Las Vegas. See 2012 WL 6618602. Earlier counsel had failed in a motion to dismiss from Peoria. The case has since settled.
- Charles and a team kept the ongoing defense of a motorcycle manufacturer away from risks of a jury by diverting the patent dispute into arbitration, and succeeding there.
- Before IPRs, Charles was succeeding for patent owners in earlier patent post-grant proceedings, putting patent challengers in situations worse for them than if they had not started proceedings they expected to win. See USPTO 95/001600, 95/000437, 95/000467.

Charles enjoys juries, avoiding juries, and resolutions that involve allowing others to act and events to occur in their own time.

- Charles and a team brought to a settlement a multi-year defense of a large automotive company against patent infringement for duplicating the products of a terminated supplier in 2008. Injunction efforts were defeated and the settlement was less than 6 percent of the supplier's demand, at one-third the supplier's legal fees.
- Earlier, Charles avoided litigation altogether by engaging opponents as needed and appropriate, while having third parties have priority and defeat the opponents, and even simply watching as windows of liability closed from passages of time.

In contrast, Charles is skilled in gaining fast relief for clients in difficult situations.

- Charles and a team brought the urgent enforcement of a patent for a construction industry company to a successful result in eight months, on a patent Charles had gained for the company. See Civil Action No. 4:07-cv-2099 (E.D.Mo.)
- Charles and teams of lawyers gained preliminary injunctions on a once-lapsed patent, see 56 USPQ2d 1329, a just-issued patent, see 53 USPQ2d 1547, and a patent in an uncertain market, see 2006 U.S. Dist. LEXIS 4910.
- Charles directed a team of lawyers for an arbitration in the digital video disk and movie industries, within 16 days of notice of arbitration. The arbitration settled on the 16th day, in major part because of the speed and thoroughness of the preparation.
- Charles has gained trademark preliminary injunctions, see 48 USPQ2d 1299 and 45 USPQ2d 1846.
- Similarly, Charles and a team brought the defense of a major instant message provider against a \$160M patent claim to a successful early summary judgment and resulting settlement. See Civil Action 04C4240 (N.D.II.).
- Charles and a trial team successfully enforced IP rights for a start-up company against a multimillion-dollar defense effort.
- Charles also successfully defended an Internet music delivery company, successfully defended a rail supply company,

and successfully ended an offensive case for a pharmaceutical software provider.

- Charles has gained several other early injunctions and seized counterfeit goods within hours of filing suits and within a day of contact with clients having problems to solve.
- In a case including a jury trial, Charles and his trial team proved willful patent infringement and had a permanent injunction in place 11 months after filing suit.

Where extended efforts are required, Charles provides them.

- Charles and a team brought the defense of the automotive industry and the nation's largest automotive supplier to a successful, affirmed summary judgment against patent infringement. See 501 F.3d 1274.
- Earlier, a trial team under Charles' direction won an affirmed jury verdict for willful patent and copyright infringement and breach of a shrink-wrap agreement. See 302 F.3d 1334.
- Charles also won an affirmed jury award for willful patent infringement and attorneys' fees. See 9 F.Supp.2d 601, 1999 U.S. App. LEXIS 8584, and 189 F.3d 1327.
- Charles and a team brought the defense of a major building systems provider against a \$200M trade secret misappropriation claim through extended arbitration discovery and to a successful settlement. See Civil Action 3:07CV312 (N.D.Tex.).
- Charles was also co-counsel in a trial defeating patent infringement claims, see 65 F.Supp.2d 757, and defended the judgment on appeal, 56 USPQ2d 1445.
- At a jury trial, Charles and a team of lawyers won an affirmed permanent injunction and patent damages award. See 61 USPQ2d 1152.
- Charles has also gained an important 7th Circuit trademark decision by appeal, see 362 F3d 986.

Charles has served as lead and co-counsel in numerous successful trials and appeals for Fortune 100 and additional companies, across the country. Technical subjects have included computer connectivity (USB) systems; in-building wireless systems; airbag actuation electronics; Internet delivery software; digital video disks; photochemistry; photographic software; engines, electronic components, and automotive hardware; human heart pacemakers and defibrillators; welding equipment; computerized controls; high technology valves; industrial franchise operations; high-technology metal casting and consumer goods. He has generated several large claims for damages, including one for \$30 million based on \$300,000 in accused sales. He has been consistently sensitive to costs and client communication. In addition, Charles has also developed capable counseling, negotiation, settlement and patent procurement strategy skills, see USPTO 13/116851, and prepared opinions and gained clients many valuable contracts concerning patents, trademarks, copyrights, trade secrets, and franchises. He is proud to have had a client grow from startup to \$25M in sales in a short time on the strength of its inventions, patents he gained, and patent enforcement suits he successfully pursued. He is also proud to have brought an individual inventor patent license royalties in excess of \$1M, for a single and simpler invention. Charles speaks on patent litigation and related matters, and authors articles espousing critical thinking in handling intellectual property concerns. He has taught pretrial, trial and appellate advocacy at Northwestern University, Georgetown, John Marshall of Chicago, and Chicago Kent Colleges of Law, with Federal Circuit Court of Appeals Chief Judge Paul Michel, among others, and taught Law for Engineering Managers at Northwestern for many years. He is currently President of the Intellectual Property Law Association of Chicago (IPLAC, www.iplac.org), past President-Elect and Vice President IPLAC, and past Chair of the IPLAC Amicus Committee, representing IPLAC in many U.S. Supreme Court, Federal Circuit and Illinois Supreme Court cases on issues including patent-eligible subject matter, patent damages, jurisdiction, and inequitable conduct. See Supreme Court 11-1118, Federal Circuit 2011-1301, 2011-1363, 2012-1548, and Illinois 112910. He is past President of the Richard Linn American Inn of Court. Charles earned a Bachelor of Science degree in Mechanical Engineering, summa cum laude, and a Juris Doctor degree, cum laude, both from The Ohio State University, in his home state.

Education

B.S.M.E. 1973, Ohio State University
J.D. 1976, Ohio State University

Admissions

Bar Admissions
1976, Illinois

Court Admissions
Supreme Court of Illinois
U.S. Court of Appeals for the Federal Circuit
U.S. Court of Appeals for the Seventh Circuit
U.S. District Court for the Eastern District of Michigan
U.S. District Court for the Eastern District of Wisconsin
U.S. District Court for the Northern District of Illinois
U.S. District Court for the Central District of Illinois

Practices

Charles W. Shifley

Appellate Litigation
Copyright
Counseling, Opinions + Licensing
Jury Trials
Litigation
Patent Interferences
PTAB Litigation
Trademarks

Industries

Electrical + Computer Technologies
Internet, E-Commerce + Business Methods
Life Sciences + Pharmaceuticals
Medical Devices

News + Events + Related Publications

[NEWS - 01.14.20](#)

25 Banner Witcoff Attorneys Listed as 2020 Leading, Emerging Lawyers

[EVENT - 11.04.19](#)

Banner Witcoff to Sponsor Reception After IPLAC Amicus Committee Program

[NEWS - 08.15.19](#)

Nine Banner Witcoff Attorneys Named to 2020 Edition of Best Lawyers in America

[EVENT - 07.17.19](#)

Rob Katz and Richard Stockton to Speak at AIPLA Design Rights Boot Camp

[NEWS - 05.20.19](#)

Charles W. Shifley Elected President of Intellectual Property Law Association of Chicago

[NEWS - 01.31.19](#)

Twenty-three Banner & Witcoff attorneys named 2019 Illinois Super Lawyers and Rising Stars

[EVENT - 09.06.18](#)

Charles W. Shifley presents on challenges the Wright Brothers' patent would face in contemporary law at the Pauline Newman IP American Inn of Court in Alexandria, Va.

[NEWS - 08.15.18](#)

Eight Banner & Witcoff attorneys named to 2019 edition of Best Lawyers in America

[EVENT - 07.18.18](#)

Banner & Witcoff sponsors, Charles W. Shifley presents at the 62nd Annual Intellectual Property Conference at John Marshall Law School in Chicago

[NEWS - 05.31.18](#)

Charles W. Shifley writes article on whether the Wright Brothers' patent would survive today's patent laws for the Journal of the Patent and Trademark Office Society

[NEWS - 05.08.18](#)

Charles W. Shifley comments on Supreme Court's Oil States case in Nature Biotechnology

[NEWS - 04.26.18](#)

IP Alert: Oil States: Patents Are Public Rights, IPRs Are Here to Stay

[EVENT - 02.16.18](#)

Charles W. Shifley presents "Designing Around" Valid U.S. Patents at PRG Spring 2018 Advanced Courses Program in New Orleans

[NEWS - 01.29.18](#)

Twenty-five Banner & Witcoff attorneys named 2018 Illinois Super Lawyers and Rising Stars

[NEWS - 01.24.18](#)

Banner & Witcoff Represents ABA in Move to Avoid Fee Shifting

[NEWS - 08.17.17](#)

Eight Banner & Witcoff attorneys named to Best Lawyers in America 2018 edition

[NEWS - 08.15.17](#)

IP Alert: Inter Partes Reviews – Who Can Get the Big Job Done

[NEWS - 01.16.17](#)

Twenty-six Banner & Witcoff attorneys named 2017 Illinois Super Lawyers and Rising Stars

[NEWS - 11.10.16](#)

Charles W. Shifley discusses fairness in IPRs in World Intellectual Property Review

[NEWS - 08.15.16](#)

Seven Banner & Witcoff attorneys named to Best Lawyers in America 2017 edition

[NEWS - 03.08.16](#)

Banner & Witcoff Represents LES in Move to Voice Concern Over Broadest Reasonable Interpretation Standard in Post-Grant Proceedings

[NEWS - 01.27.16](#)

Twenty-seven Banner & Witcoff attorneys named 2016 Illinois Super Lawyers and Rising Stars

[NEWS - 11.20.15](#)

Twenty Banner & Witcoff attorneys named to 2015 Super Lawyers Business Edition

[NEWS - 08.17.15](#)

Eight Banner & Witcoff Attorneys Named to Best Lawyers in America 2016 Edition

[NEWS - 08.03.15](#)

Charles W. Shifley discusses the potential impact of inter partes reviews in Chicago Lawyer magazine

[NEWS - 06.23.15](#)

Charles W. Shifley discusses the Supreme Court's decision in *Kimble v. Marvel* in Law360

[NEWS - 06.22.15](#)

IP Alert: Supreme Court Affirms Brulotte, "Green-Lights" Collecting Patent Royalties After Patents Expire

[NEWS - 05.01.15](#)

Eight Banner & Witcoff attorneys named to Chicago's Top Rated Lawyers of 2015

[NEWS - 04.22.15](#)

Six Banner & Witcoff attorneys named to Euromoney's 2015 Patent Expert Guide

[NEWS - 04.20.15](#)

Charles W. Shifley discusses significant 2015 Federal Circuit decisions in Law360

[NEWS - 01.12.15](#)

Twenty-three Banner & Witcoff attorneys named 2015 Illinois Super Lawyers and Rising Stars

[NEWS - 10.24.14](#)

Charles W. Shifley discusses the Federal Circuit's potential review of the standard for willful infringement in Law360

[NEWS - 08.18.14](#)

Eight Banner & Witcoff Attorneys Named to Best Lawyers in America 2015 Edition

[NEWS - 06.20.14](#)

IP Alert: Computer-Implemented Inventions: Ideas That Are Fundamental Truths And Generically Implemented Are Not Patent Eligible

[NEWS - 04.02.14](#)

IP Alert: Supreme Court Justice Characterizes Alice v. CLS Bank As Being On The Idea Of "Solvency," Or "Computer, Stop;" While All Justices Search Among King Tut, Scylla, Charybdis And Archimedes For Inspiration

[NEWS - 02.27.14](#)

IP Alert: Patent Case Attorneys' Fee Awards: The Supreme Court Characterizes Cases As "A Search for Adjectives"

[NEWS - 02.25.14](#)

Charles W. Shifley discusses Supreme Court's arguments over attorneys' fees in Law360

[NEWS - 02.06.14](#)

Charles W. Shifley discusses the potential value of Fisker's patents in Bloomberg

[NEWS - 01.13.14](#)

Twenty-five Banner & Witcoff attorneys named 2014 Illinois Super Lawyers and Rising Stars

[NEWS - 11.27.13](#)

Twenty Banner & Witcoff attorneys named to 2013 Super Lawyers Business Edition

[NEWS - 08.16.13](#)

Eight Banner & Witcoff Attorneys Named to Best Lawyers in America 2014 Edition

[NEWS - 05.10.13](#)

IP Alert: Federal Circuit CLS Bank Decision on Computer-Implemented Inventions Just Handed Down

[NEWS - 04.30.13](#)

Nine Banner & Witcoff Attorneys Named to Chicago's Legal Leaders 2013 List of "Top Rated Lawyers"

[NEWS - 04.12.13](#)

Seven Banner & Witcoff Attorneys Named to Euromoney's Expert Guides

[NEWS - 02.07.13](#)

Eight Banner & Witcoff Attorneys Named to Best Lawyers in America 2013 Edition

[NEWS - 01.28.13](#)

Twenty-two Banner & Witcoff Attorneys are Named Illinois Super Lawyers and Rising Stars

[NEWS - 01.06.12](#)

Eighteen B&W Attorneys named to the Illinois Super Lawyers and Rising Stars List

[NEWS - 08.31.11](#)

Six B&W Attorneys Named to Best Lawyers in America 2012 Edition

Charles W. Shifley

[NEWS - 08.02.11](#)

Patent Law Update: The US PTO Proposes to Adopt Therasense Materiality Standard for Practice in the US PTO

[NEWS - 06.09.11](#)

Patent Law Update: Microsoft v. i4i

[NEWS - 05.27.11](#)

Charles W. Shifley comments on the Federal Circuit decision in Therasense v. Becton, Dickinson in the Bloomberg/BusinessWeek and in IP Law360

[NEWS - 05.05.11](#)

Patent Law Update: Therasense v. Becton Dickinson

[NEWS - 01.04.11](#)

Eighteen B&W Attorneys named to the Illinois Super Lawyers and Rising Stars List

[NEWS - 12.06.10](#)

Charles W. Shifley discusses the Microsoft v. i4i case in BNA's Patent, Trademark and Copyright Law Journal

[NEWS - 11.29.10](#)

Patent Law Update: Microsoft v. i4i

[NEWS - 11.19.10](#)

Charles W. Shifley discusses the oral argument in Therasense v. Becton Dickinson in a BNA article

[NEWS - 11.12.10](#)

Charles W. Shifley discusses inequitable conduct in a Bloomberg News article

[NEWS - 11.09.10](#)

Patent Law Update: Therasense v. Becton Dickinson

[NEWS - 08.05.10](#)

Twelve B&W Attorneys Selected as Illinois Leading Lawyers

[NEWS - 06.30.10](#)

Webinar: Inter Partes Reexamination: Myths Busted, Tips Given, and Pitfalls Avoided, From Actual Practitioner Experiences

[NEWS - 05.24.10](#)

Debunking Conventional Wisdom You CAN End Inter Partes Reexamination

[NEWS - 04.26.10](#)

Patent Law Update: Federal Circuit Signals Big Changes on Inequitable Conduct Likely By Year End 2010

[NEWS - 04.23.10](#)

Patent Law Update: A Review of i4i v. Microsoft

[PRESS - 01.18.10](#)

Fifteen B&W Attorneys named to the Illinois Super Lawyers and Rising Stars List

[NEWS - 09.10.09](#)

Mark T. Banner Scholarship for law students established by Linn Inn of Court

[NEWS - 06.18.09](#)

Twelve Banner & Witcoff attorneys named as Corporate Counsel Super Lawyers

[NEWS - 04.29.09](#)

Marc S. Cooperman, Dale H. Hoscheit, Jon O. Nelson, Joseph M. Potenza, and Charles W. Shifley are named amongst the "World's Leading Patent Practitioners" by Euromoney.

[PRESS - 01.19.09](#)

Banner & Witcoff attorneys named Illinois Super Lawyers and Rising Stars

[PRESS - 08.27.08](#)

Seven Banner & Witcoff, Ltd. attorneys were named "Leading Lawyers" in 2007 by the Leading Lawyers Network

[NEWS - 09.06.07](#)

Banner & Witcoff helps Delphi gain an affirmance of summary judgment of patent invalidity in U.S. Court of Appeals for the Federal Circuit.

[NEWS - 05.04.06](#)

B&W Attorneys named "Top Intellectual Property Lawyers" by the Leading Lawyers Network

[NEWS - 04.17.06](#)

Federal Circuit affirms decision for Sandia Corp.

[NEWS - 04.04.06](#)

Banner & Witcoff formulates winning strategy for RealNetworks.

[NEWS - 02.08.06](#)

Banner & Witcoff wins patent preliminary injunction in Georgia federal court

[NEWS - 12.12.05](#)

B&W enjoys summary judgment in Chicago patent case.

[NEWS - 11.08.05](#)

B&W wins patent infringement lawsuit.

[NEWS - 08.21.05](#)

B&W wins Delphi case.

[NEWS - 04.14.05](#)

Twelve B&W Attorneys Named "Illinois Super Lawyers."