

**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

1983, B.S.M.E., Mechanical Engineering
 1976, J.D.

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

Practices

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

Recent News + Events + Related Publications

NEWS - 02.22.21

27 Banner Witcoff Attorneys Named 2021 Super Lawyers and Rising Stars

NEWS - 09.18.20

Banner Witcoff Ranked as One of the Best Performing, Most Active Law Firms in IPR

NEWS - 08.20.20

Eight Banner Witcoff Attorneys Named to Best Lawyers in America Guide

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

LIBRARY - 12.12.18

In IPR, a Picture is Worth a Thousand Words ... or Worse than Worthless

LIBRARY - 11.15.18

Magic! Now You See the Patent, Now You Don't!

LIBRARY - 10.15.18

In IPR, a Patent Owner gets SASsy — With a Bold New Interpretation that the Supreme Court SAS Case Makes for Bad in many IPRs

LIBRARY - 09.10.18

In IPR, It's What, Why, and How That Makes Your Case

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

LIBRARY - 08.13.18

In IPR, It Ain't Who to Believe, It's What to Believe, at a Detailed Level

LIBRARY - 07.24.18

Is There a New "New Narrative" to be Told About Patents?

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

LIBRARY - 07.10.18

Patents – Equal to Franchises and Toll Bridges? Seven Justices Seem to Say Yes in Inter Partes Review Decision

LIBRARY - 06.25.18

"You Took My Patent in IPR! Now You Owe Me!" ... Don't Take Out Your Wallet Just Yet

LIBRARY - 06.04.18

Your Inter Partes Review Petition and its Proof – Couldda, Wouldda ... Shouldda

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

LIBRARY - 05.30.18

The Wright Brothers: Would Their Patent Survive Today's Patent Law Rigors? Doubtful