

**Louis DiSanto**

Attorney  
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Louis DiSanto assists clients in developing and leveraging intellectual property portfolios to achieve their business goals. He applies a value-added approach to help clients obtain complementary intellectual property assets and to strategically use their portfolios to earn competitive advantages in the marketplace. Louis represents category leaders and well-known brand owners in trial, litigation, prosecution, and counseling matters.

In his litigation and enforcement practice, Louis serves as lead counsel in complex intellectual property cases from filing through trial and appeal. Louis recently earned favorable decisions in arbitration and inter partes review before the Patent Trial and Appeal Board. The IPR wins were featured in Law360.

Louis also earned summary judgment of patent non-infringement and affirmance of the judgment by precedential opinion of the U.S. Court of Appeals for the Federal Circuit. The win was featured in Law360 and Bloomberg BNA.

Louis also represents brand owners in trademark and trade dress actions in court and other forums to maintain brand integrity and defend their goodwill. He has also led multiple trade secret litigations on behalf of both plaintiffs and defendants. Louis believes that litigation and enforcement actions should be right-sized and tailored to achieve defined business goals.

Louis regularly counsels clients on steps to avoid litigation. He assists clients in the successful launch of new products and new brands by providing analysis and navigation of competitive intellectual property threats. Louis believes that most disputes should be avoided through adoption of best practices for due diligence and intellectual property clearance. He also believes that the best defense includes a strong offensive capability based on the client's own intellectual property portfolio.

In his prosecution and portfolio counseling practice, Louis assists clients in obtaining and maintaining utility patents, design patents, trademarks, trade dress, copyrights, and trade secrets that yield tangible competitive advantages. His counseling practice includes transactional work on valuating, acquiring, and licensing intellectual property rights. Louis believes that intellectual property assets must provide a return on investment and that cost management is a critical aspect of maintaining a portfolio that yields value. He is skilled at devising strategies to obtain a full spectrum of complementary intellectual property assets while limiting clients' costs in creating and managing their portfolios.

Louis's practice also includes pro bono representation of low-income families in court. Since 2005, he has worked with the Lawyers' Committee for Better Housing's (LCBH) to provide low-income families with legal representation to defend against wrongful evictions and otherwise navigate the eviction court system. LCBH honored Louis as the recipient of the "Volunteer Attorney of the Year Award" for his dedication and value as a volunteer attorney. Currently, he serves on the board of directors of LCBH.

**Exemplary Litigations**

- Coulter Ventures, LLC, d/b/a Rogue Fitness v. Jump Rope Systems, LLC, IPR Nos. 2019-00586 & 00587 (PTAB July 17, 2020) (lead counsel in successful challenge to patents asserted in Jump Rope Systems, LLC v. Coulter Ventures, LLC, No. 2:18-cv-00731 (S.D. Ohio)).
- Coulter Ventures, LLC, d/b/a Rogue Fitness v. Rogue Apparel Group, No. 01-19-0000-0675 (Am. Arb. Assoc.) (lead trial counsel in successful enforcement of trademark co-existence and indemnity agreement)
- Oregon Brewing Company v. Coulter Ventures, LLC, d/b/a Rogue Fitness, No. 2:18-cv-00756 (S.D. Ohio) (lead counsel in

defense of flagship trademark marks)

- Coulter Ventures, LLC, d/b/a Rogue Fitness v. Titan Mfg. & Dist., Inc., d/b/a Titan Fitness, No. 2:18-cv-1816 (S.D. Ohio) (lead counsel in enforcement of flagship trademark)
- Sloan Valve Co. v. Sloan Indus., LLC, No. 1:17-CV-4496 (N.D. Ill.) (lead counsel in successful enforcement of flagship trademarks)
- Phil-Insul Corp. v. Airlite Plastics Co., No. 8:12-CV-151, 201 WL 5107131 (D. Neb. Mar. 2, 2016), *aff'd*, 854 F.3d 1344 (Fed. Cir. 2017) (lead counsel in successful defense against patent infringement action, earning summary judgement of non-infringement and affirmance on appeal)
- YETI Coolers, LLC v. Kaiser Group, Inc., No. 1:15-CV-725 (W.D. Tex.) (co-lead counsel in successful enforcement of trade dress rights)
- YETI Coolers, LLC v. Great Am. Prods., Ltd., 1:15-CV-686 (W.D. Tex.) (successful enforcement of trade dress rights)
- Con-Way Freight, Inc. v. Ochoa, No. 1:12-CV-1291 (N.D. Ill.) (successful enforcement of trade secret rights)
- ESCO Corp. Reddig Equip. & Repairs, Inc., No. 9:11-CV-150 (D. Mon.) (co-lead counsel in successful enforcement of patent rights)
- Polyform, A.G.P., Inc. v. Airlite Plastics Co., 4:10-CV-43, 2010 WL 4068603 (M.D. Ga. Oct. 15, 2010) (co-lead counsel in successful defense against patent infringement action, earning transfer and dismissal of action)
- Polyform, A.G.P., Inc. v. Airlite Plastics Co., No. 8:07-CV-397 (D. Neb.) (co-lead trial counsel in successful defense against patent infringement action, earning jury verdict of patent invalidity)
- TronTech Licensing, Inc. v. Lexmark Int'l, Inc., 2:10-CV-218 (E.D. Tex.) (resolved patent infringement action on behalf of defendant)
- Demeter Tech., LLC v. Lexmark Int'l, Inc., 2:10-CV-209 (E.D. Tex.) (resolved patent infringement action on behalf of defendant)
- Tennessee Prod. Ctr., Inc. v. Eatsleepmusic Corp., No. 3:09-cv-159, 2009 WL 2852426 (M.D. Tenn. Sep. 1, 2009) (developed strategy that earned stay of litigation and subsequent settlement in successful defense of copyright infringement action)

### **Representative Clients Served & Sample Subject Matter of Representation**

- Rogue Fitness (strength and conditioning equipment)
- Sloan Valve Company (plumbing and sanitary devices)
- YETI Coolers (specialty coolers, drinkware, and outdoor equipment)
- NIKE (polymer-based materials and sports equipment)
- DSM Functional Materials (stereolithography equipment and polymers)
- Airlite Plastics Co (insulated concrete forms and injection-molded products)
- ESCO Corporation (wear parts for excavating equipment)
- Lexmark International (software and computer systems)
- Boeing (aeronautical devices and telecommunications)

Louis earned his Juris Doctor, *cum laude*, from the University of Illinois College of Law. There, he served as articles editor for the *Journal of Law, Technology & Policy* and editor of the Frederick Green Moot Court Competition. In addition, Louis served as a judicial extern for the Honorable E. Kenneth Wright, Presiding Judge of the First Municipal District of Cook County, Illinois. He earned his Bachelor of Science in Chemical Engineering from Michigan State University. As an undergraduate, Louis worked as a research assistant at the Michigan State University Plant Biotechnology Laboratory.

Louis draws on his experience as a research assistant at Nalco Chemical Company and as a pharmaceuticals manufacturing engineer at Abbott Laboratories, where he worked with a broad range of technologies. His research at the Nalco Chemical Company in the area of electrochemical devices led to the issuance of U.S. Patent No. 6,250,140, *Method for Measuring the Rate of a Fouling Reaction Induced by Heat Transfer Using a Piezoelectric Microbalance*, for which he is a co-inventor.

In his spare time, Louis enjoys the study of wine and making wine at home. Louis is an accredited Sommelier through the International Sommelier Guild.

### **Education**

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Michigan State University  
1999, B.S., Chemical Engineering

University of Illinois College of Law  
2005, J.D., *Cum Laude*

### **Admissions**

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#### **Bar Admissions**

Louis DiSanto

2005, Illinois

**Court Admissions**

Supreme Court of Illinois

U.S. Court of Appeals for the Federal Circuit

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

**Practices**

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Counseling, Opinions + Licensing

Litigation

PTAB Litigation

Patent Prosecution

**Recent News + Events + Related Publications**

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**NEWS - 01.26.23**

**Banner Witcoff Elects New President, Board Members, and Shareholders**

**NEWS - 01.24.23**

**17 Banner Witcoff Attorneys Named 2023 Illinois Super Lawyers and Rising Stars**

**LIBRARY - 04.11.21**

**Rogue Fitness scored a pair of victories at the PTAB**