BANNER WITCOFF

Robert H. Resis

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With more than 30 years of experience, Bob provides valuable insights and solutions to meet client IP needs. Nominated by a global industrial manufacturing client, Bob has been recognized nationwide for his superior client service in IP litigation. Bob was part of Amgen's winning trial team in Amgen Inc. v. Chugai Pharmaceuticals, et al., a leading biotechnology patent case. In addition to litigation, Bob's practice includes procuring, counseling and licensing aspects of intellectual property rights.

Bob has successfully prosecuted patents in a variety of fields, including chemical, medical device, and pharmaceutical arts. He has extensive experience effectively implementing post-grant review procedures of the U.S. Patent and Trademark Office to the benefit of the firm's clients, including those involved in litigation. He also assists clients with strategic planning and patent-portfolio management.

Bob's legal and chemical engineering background, including his work as a process engineer for Chevron U.S.A., allows him to effectively communicate with scientists and engineers, identify key evidence, and write persuasive briefs, thorough opinions, and solid patent applications.

Bob is chair of the Amicus Committee of the Intellectual Property Law Association of Chicago (IPLAC). Under his leadership, IPLAC has filed numerous amicus briefs in the U.S. Supreme Court and in the U.S. Court of Appeals for the Federal Circuit. He has written a number of articles and publications on a wide range of intellectual property issues. He wrote "A Petitioner's Guide" and "A

Patent Owner's Guide to Handling IPRs in the Higher-Survival Patent Arena of Biotech and Pharmaceuticals," published in Bloomberg BNA Patent, Trademark & Copyright Journal in 2016. He was also contributing author of several editions of "Patent Claim Construction in the Federal Circuit," published by IPLAC, and wrote "Preliminary Relief in Patent Infringement Disputes," a book published by the American Bar Association in 2011. All of Bob's publications can be viewed in the Library by clicking here.

Bob's contributions extend outside of the legal profession as well. He serves on the West Northfield School District 31 Board of Education, to which he was re-elected to a second four-year term in April 2017, and served as vice president from 2015-19. Bob is also serves on the board of directors for Temple Beth-El (Northbrook, IL).

Education

University of Illinois at Urbana-Champaign
1980, B.S., Chemical Engineering

Northwestern University Pritzker School of Law
1986, J.D.

Admissions

Bar Admissions
1986, Illinois

Court Admissions
Supreme Court of Illinois
U.S. Court of Appeals for the Federal 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 Northern District of Illinois, Trial Bar

U.S. Supreme Court

Practices

Counseling, Opinions + Licensing
Jury Trials
Litigation
PTAB Litigation
Patent Prosecution

Industries

Chemistry + Chemical Engineering
Defense Space
Life Sciences + Pharmaceuticals
Medical Devices

Accolades

- Recognized in BTI Client Service All-Stars 2017 for his superior client service for IP litigation.
- Listed in Leading Lawyers for his work in intellectual property law and patent law

Representative Matters

- In 2013-17, Bob assisted a large research and development organization in obtaining worldwide patents for processes for production of useful fuels from renewable sources.
- In 2012, Bob requested for a large pharmaceutical client an inter partes reexamination against a patent asserted by a competitor. The Patent Office rejected all of the claims of the asserted patent in the reexamination, and in 2013, after he filed third-party requester comments, sustained the rejection of all claims in a Right to Appeal Notice. Thereafter, the competitor stipulated to dismissal with prejudice of its infringement suit against Bob's client, thereby saving his client litigation costs and a trial. In 2015, the PTAB affirmed the rejection of all claims.
- In 2012, Bob obtained for an ecommerce client a dismissal of Digital Millennium Copyright Act (DMCA), Lanham Act, and state claims that had been filed against it by another ecommerce business. In 2013, he obtained a dismissal of the DMCA claim and a copyright claim based on an asserted work that had been filed in an Amended Complaint. The case settled shortly after the court's dismissal of claims of the Amended Complaint.
- In 2011, Bob requested ex parte reexamination for a client against a patent that was later asserted by a competitor. The Patent Trial and Appeal Board affirmed the Examiner's rejection of all of the claims of the asserted patent in the reexamination. The competitor did not file a further appeal, and Bob's client can practice all of the claims of the asserted patent without any liability risk.
- In 2010, Bob prepared pretrial and trial papers to help obtain a jury verdict of over $19 million in patent infringement damages for a firm client against a competitor. The jury verdict was upheld by the district court after denying the competitor's post-trial motions. Thereafter, the case settled favorably for the firm client.
- In 2010, after limited discovery, Bob obtained an agreed order of dismissal with prejudice of a non-practicing entity's claims of patent infringement that had been filed against a firm client in connection with its online order and delivery business. The firm client did not pay the NPE any money and did not take a license.
- In 2009, Bob requested for a transportation client an ex parte reexamination against patent claims previously asserted by the practicing patent owner against a competitor. The Patent Office rejected all of the claims in Bob's request. In 2013, the Patent Trial and Appeal Board sustained the rejection of all claims in his request, and the practicing patent owner did not file a further appeal. Thereafter, the Patent Office issued a Reexamination Certificate that canceled all of the claims in Bob's request, and his client can practice the canceled claims without risk of being sued for infringement of those claims.
- In 2009, Bob successfully defeated a motion by an accused infringer to stay a case pending inter partes reexamination. The case settled shortly after the motion to stay was denied.

- In 2009, Bob prepared pre- and post-trial papers in helping to obtain and maintain a jury verdict in favor of a firm client that all the patent claims asserted by the opposing party were invalid for obviousness.
- Bob takes pride in successfully representing clients against larger, well-financed opponents. For example, Bob achieved the successful enforcement of a patent in Texas for a small startup company against a multimillion-dollar defense effort by the primary and decades-long vendor in the industry. He achieved this success within 18 months of filing suit and despite summary judgment and patent reexamination efforts by the defendant. Southwest Die Corp. v. Ontario Die Company Limited, Civil Action No. EP-01-CA-0204-PRM (W.D. Tex.).

Affiliations/Memberships

Member, PTAB Bar Association

Member, Board West Northfield School District 31 Board of Education

Member, Board Temple Beth-El (Northbrook, IL)

Chair, Amicus Committee, Intellectual Property Law Association of Chicago (IPLAC)

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20 Banner Witcoff Attorneys Listed as 2025 Illinois Leading, Emerging Lawyers