

## REGINALD J. HILL, Partner

*Reginald J. Hill is co-chair of the firm's Patent Litigation and Counseling Practice. He focuses his practice on intellectual property litigation and counseling. Corporations seek his help with a variety of matters including patents, copyrights, trademarks and trade secrets, particularly related to technology. He has served as lead counsel in bench and jury trials, appeals, PTAB trials, Markman hearings and arbitrations. His breadth of experience includes more than 25 years in the exploitation, procurement, development and protection of intellectual property in a wide range of technologies, including computers, digital communications, Internet and emerging technologies.*

Mr. Hill is AV Peer Review Rated, Martindale-Hubbell's highest peer recognition for ethical standards and legal ability. In 2003, *Diversity & the Bar* recognized him as one of the top intellectual property lawyers of color in the country. Every year since 2008, Mr. Hill has been recognized as an *Illinois Super Lawyer* in intellectual property. Mr. Hill is a member of the Patent Litigation and Counseling and Trademark, Advertising and Unfair Competition Practices, as well as a member of the firm's Management Committee.

Mr. Hill served as chair of the Illinois State Bar Association's Intellectual Property Section Council in 2001. His community work centers around opportunities for youth and includes serving as a member of the board of directors for Chicago Scholars. Before practicing law, Mr. Hill spent 10 years as an electrical engineer in research and product development with AT&T Bell Laboratories and Motorola, distinguishing himself in the design and development of computer hardware and architectures for audio and video technology.

### Significant litigated matters include:

- *Diamond Coating Technologies LLC v. Nissan North America, Inc. et al.* (C.D. Cal.) – Successfully defended against patent infringement claims generally directed to diamond-like or hard carbon coating arrangements that provide protection and favorable friction properties. Invalidated two patents in *inter partes* review procedures. Successfully argued appeal on standing before the Federal Circuit.
- *NISTAC v. Nissan North America, Inc. et al.* (E.D. Mich.) – Successfully defended against patent infringement claims directed at piston configurations and solid film lubricants for piston configurations. Case dismissed after favorable *Markman* ruling.
- *In re Certain Video Analytics Software, Systems, Components Thereof, and Products Containing Same*, Inv. No. 337-TA-852(ITC) – Defended respondent in patent infringement investigation relating to video camera analytics. Obtained settlement.
- *Automotive Technologies International, Inc. ("ATI") v. Siemens VDO Automotive Corp. et al.* (E.D. Mich.) – Successfully defended Nissan North America by obtaining summary judgment of invalidity on four patents relating to side impact crash and airbag technology.



## REGINALD J. HILL Partner

### CHICAGO

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### PRACTICE GROUPS

Intellectual Property  
Japan Practice  
Litigation  
Patent Litigation and Counseling  
Trade Secrets and Restrictive Covenants  
Trademark, Advertising and Unfair  
Competition Practice

### EDUCATION

The John Marshall Law School, J.D., 1994;  
*cum laude*; Order of The John Marshall; The  
John Marshall Dean's Scholarship; Giles S.  
Rich Patent Moot Court Competition  
Regional Semi-Finalist

Georgia Institute of Technology, M.S.E.E.,  
1985

Tuskegee Institute, B.S.E.E., 1984; Highest  
Honors; National Merit Achievement  
Scholarship; National Action Council for  
Minorities in Engineering (NACME)  
Scholarship; NCR Scholarship; Eta Kappa  
Nu Electrical Engineering Honor Society;  
Kappa Alpha Psi Southern Province Award

### ADMISSIONS

Illinois, 1994

### COURT ADMISSIONS

U.S. Patent and Trademark Office, 1995

U.S. Court of Appeals, Federal Circuit,  
2004

U.S. Court of Appeals, Seventh Circuit,  
2001

U.S. Court of Appeals, Ninth Circuit, 2004

U.S. District Court, Northern District of

- *ATI v. GM et al.* (E.D. Tex.) – Successfully defended Nissan North America by obtaining summary judgment of invalidity on three patents relating to occupant detection technology. Illinois, 1994  
U.S. District Court, Northern District of Illinois (Trial Bar), 1998
- *Phillip M. Adams & Assoc. v Dell Inc. et al.* (D. Utah) – Defended Dell against allegations of patent infringement relating to five patents covering computer storage technology. Obtained settlement. U.S. District Court, Eastern District of Michigan, 2008
- *Semiconductor Energy Laboratory Co., Ltd. (“SEL”) v. Toppoly Optoelectronics* (C.D. Cal.); *SEL v. AU Optronics and Acer Incorporated* (N.D. Cal.) – Represented research and development and licensing company in enforcing patents central to liquid crystal display technology relating to thin film transistors. Obtained settlement after extensive fact and expert discovery and *Markman* rulings.
- *Motorola v. U.S. Robotics et al.* (Cook Co. IL) – Defended employer and employee against trade secret misappropriation allegations from former employer relating to cable modem technology. Avoided preliminary injunction after one-week evidentiary hearing.
- *MGM Pictures, Inc. v. Mark Brown, Beauty Shop LLC et al.* (C.D. Cal.) – Represented producer Mark Brown and related companies in trademark, copyright, and unfair competition claims relating to release of a motion picture. Settlement obtained after preliminary injunction motion and appeal to the Ninth Circuit.
- *Eli’s Chicago Finest, Inc. v. The Cheesecake Factory, Inc.* (N.D. Ill.) – Obtained dismissal of trademark infringement action re jurisdiction.

## Awards

- Chicago Area Council, Boy Scouts of America  
Whitney M. Young, Jr. Service Award, 2012
- *Crain’s Chicago Business*  
Chicago’s Notable Minority Lawyers, 2018
- Glenn T. Johnson Chapter, Black Law Students Association  
The John Marshall Law School Legacy of Opportunity Award, 2008
- *Illinois Super Lawyers*  
Intellectual Property, 2008-2019
- *Managing Intellectual Property*  
Patent Star, 2018, 2019, 2020
- *Who’s Who in Black Chicago Chicago’s*  
Counselors at Law, 2007
- Co-Inventor, U.S. Patent Nos. 6,157,989 and 6,721,701

## Community

- Boy Scouts of America  
Advisor, Legal Explorer Post, 1995 – 1999
- Chicago Area Council, Boy Scouts of America  
Board of Directors, 2008 – 2014
- Chicago Recovery Alliance  
Pro Bono Counsel, 1997 – present
- Chicago Scholars  
Board of Directors, 2008 – present
- Tuskegee National Alumni Association  
Financial Secretary, 2016-18

## Service To The Bar

- American Bar Association - Intellectual Property Litigation Newsletter  
Seventh Circuit Reporter, 1994 – 1998
- American Intellectual Property Law Association  
Diversity Liaison, Corporate Practice Committee, 2002
- Cook County Bar Association
- Federal Circuit Bar Association
- Illinois Board of Admissions  
Member, 1st District Character and Fitness Committee
- Illinois State Bar Association - Intellectual Property Section Council  
Chair, 2001-2002; Vice-Chair, 2000 – 2001; Secretary, 1999 – 2000;  
Associate Newsletter Editor, 2008 – 2009
- National Bar Association
- Northern District of Illinois Local Patent Rules Committee  
Advisory Group, 2017-2018
- PTAB Bar Association

## Publications

- Client Alert:., Federal Circuit Narrows Ability of Defendants to Request Inter Partes Review After Service of Complaint in Unusual En Banc Footnote, September 10, 2018
- Supreme Court Upholds, and Changes, IPR Administrative Patent Challenges in Oil States and SAS, April 25, 2018
- "The Federal Circuit's View of Patentable Subject Matter after Alice," *Patent Litigation 2017: Advanced Techniques & Best Practices*, Practising Law Institute, October 2017
- "Friend or Foe in Multi-Defendant Patent Litigation," *Patent Litigation 2016*, Practising Law Institute, October 2016

- “Recent Appellate Cases and Developments in Patent Law and Litigation,” *Patent Litigation 2015*, Practising Law Institute, July 27, 2015
- Hospitality and Gaming Legal Review 2013, February 25, 2014
- “Patent Trial And Appeal Board Contested Proceedings—The First Six Months,” *Bloomberg BNA’s Patent, Trademark & Copyright Journal*, April 26, 2013
- “Scope of Waiver: Post-*Seagate* Trends,” American Bar Association *Intellectual Property Litigation Newsletter*, Summer 2012
- “New Local Patent Rules In Northern District of Illinois,” *Law360*, October 27, 2009
- Client Advisory: Northern District of Illinois Enacts Local Patent Rules, October 20, 2009
- “Traditional Patent License Negotiations Result in Declaratory Judgment Jurisdiction after *MedImmune*,” *ISBA Intellectual Property*, Vol. 46, No. 4, June 2007
- “The Enablement and Written Description Defenses in Patent Litigation,” *Patent Litigation*, Practising Law Institute, 2005
- “Can You Copy A Device Disclosed In An Expired Utility Patent?” *ISBA Intellectual Property*, Vol. 37, June 1998
- “Inevitable Disclosure -- No Noncompete Is Needed,” *Employment Law Strategist*, Vol. 3, December 1997
- “*Hilton Davis* Preserves Doctrine of Equivalents With Clarification?” *Intellectual Property Litigation*, Vol. VIII, Spring 1997
- “Shrinkwrap Licenses Are Enforceable,” *Intellectual Property Litigation*, Vol. VIII, Fall 1996
- “Supreme Court Unanimously Affirms *Markman v. Westview Instrument*,” *Intellectual Property Litigation*, Vol. VIII, Summer 1996

## Speaking Engagements

- Panelist, Northwestern Black Law Students Association, February 04, 2019
- Firm Lawyers Share Helpful Insight to Students Interested in Law, January 09, 2019
- “Is the Tide Changing Again on the Viability of 101 and 112 as Defenses in Patent Litigation?” Practising Law Institute, October 13, 2017
- Panelist, “Practice before the Board,” Federal Circuit Bar Association’s “Patent Litigation 2017: The Courts and Patent Trial and Appeal Board” Regional Meeting, February 01, 2017
- “Joint Defense and Indemnification -- How to Work with Others in the Same or a Sunken Boat,” PLI, October 13, 2016
- Panelist, “PTAB after Four Years: State of Play,” MIP US Patent Forum, March 15, 2016
- “The Strategy of District Court Litigation vs. IPR in View of Recent Appellate Decisions,” IP Strategy Summit, October 13, 2015
- “Recent Developments in Patent Law and Their Effects on Patent Litigation,” Practising Law Institute’s Patent Litigation 2015 Conference, October 08, 2015
- “A New Year – Getting the Year Off to a Good Start,” Chicago Black Partners Alliance, February 11, 2015

- Just the Beginning Foundation Summer Legal Institute, August 05, 2014
- “Discovering Our City,” Program of Urban Prep Charter High School, March 26, 2014
- Eighth Annual Corporate Intellectual Property Law Conference, February 13, 2013
- “Recent Developments and Changes in Patent Law and Their Effects on Patent Litigation,” Practising Law Institute's Patent Litigation 2012, Chicago, IL, October 11, 2012 to October 12, 2012
- “Trends from the Courts and the USPTO,” Law Bulletin Seminars' 7th Annual Corporate Intellectual Property Law Conference, Chicago, IL, February 08, 2012
- "Tips for Success: How to Stand Out In a Competitive Marketplace," Chicago-Kent College of Law, Chicago, IL, December 02, 2011
- “Where Zippers Meet Buttons and Hooks: Representation of Multiple Defendants in Complex Cases,” DRI - Business Litigation and Intellectual Property Seminar - Winning Strategies For Hard Cases, Chicago, IL, April 14, 2011 to April 15, 2011
- “Recent Trends in Patent Litigation,” Black Law Students Association and the Intellectual Property Law Society - Earl B. Dickerson Speakers Series - Black History Month, Chicago, IL, February 02, 2010
- InsideCounsel and Jenner & Block's Eighth Annual SuperConference, Chicago, IL, May 20, 2008 to May 21, 2008
- “The Basics of Patent Law,” Illinois State Bar Association - What Every Lawyer Should Know About Intellectual Property, Chicago, IL, May 12, 2008
- Alumni Honoree, "Legacy of Opportunity Reception" The John Marshall Law School Black Law Students Association, Chicago, IL, February 28, 2008
- Fifth Annual Law Firm Visit, University of Illinois Latino Law Students Association/Asian Law Student Association/Black Law Student Association/Latino Law Student Association/Native American Law Student Association, Chicago, IL, October 20, 2006
- Jenner & Block's African-American Affinity Group - Chicago Law Schools Reception, Chicago, IL, April 05, 2006
- "Diversity in the Law," Undergraduate Conference, Chicago, IL, March 03, 2006
- “Enablement & Written Description,” Practising Law Institute's Patent Litigation, Chicago, IL, November 28, 2005
- Fourth Annual Law Firm Visit, University of Illinois Latino Law Students Association - Asian Law Student Association - Black Law Student - association - - Latino Law Student Association - Native American Law Student Association, Chicago, IL, September 01, 2005
- “Patent and Trademark Year in Review,” Counsel Association's Fourth Annual CLE Expo, Chicago, IL, March 16, 2005 to March 18, 2005
- “Opportunities and Obligations of America's Top Black Lawyers,” Harvard Law School Black Law Students Association's Spring Conference -- A Call to Consciousness: Defining Professional and Social Responsibility to Inspire Progressive Leadership, Chicago, IL, March 11, 2005 to March 13, 2005
- Minority Corporate Counsel Association's 3rd Annual CLE Expo, Chicago, IL, March 31, 2004 to April 02, 2004

