

Aaron K. Nodolf

Partner

Overview

Aaron focuses on all aspects of intellectual property law, from counseling clients as they acquire IP assets to defending against competitor claims. He brings both experience and creative thinking to matters such as:

- Obtaining patent protection for and enforcement of IP assets, both in the U.S. and globally
- Licensing client technology, including preparation and negotiation of agreements to advance business strategies and protect interests
- Navigating competitor intellectual property, including validity and non-infringement analyses and opinions, and AIA post-grant proceedings
- Advising on product development and strategic decisions based on IP and other proprietary information

Aaron's experience spans a wide range of technologies, including medical devices, software implementation, biopsy technologies, healthcare products, cleaning management systems and products, bicycles and bicycle components, refrigeration systems, retail merchandising, seat systems, security and lock systems, glass panel assemblies, agricultural equipment, and internal combustion engines.

As a member of the firm's post-grant team, Aaron defends clients and challenges the validity and enforcement of competitors' patents through post-grant proceedings, including *ex parte* reexamination proceedings and *inter partes* review. He also counsels clients regarding acquisition and enforcement of U.S. and foreign trademark rights, copyrights, and trade secrets.

Aaron assists established companies, universities, and startups with IP protection and defensive strategies, and preparation and negotiation of technology transfers worldwide, including licenses, material transfer agreements, and laboratory testing agreements. Universities benefit from his skills in protecting and monetizing university research and entrepreneurship. Early-stage companies turn to Aaron to leverage their innovations to spur further development and achieve strategic growth. Aaron supports



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Industries

Higher Education

Practices

Intellectual Property

Licensing & Technology

Agreements

Patent

Venture Capital & Private Equity

start-ups through his work in the firm's Venture Best® Practice Group, which advises clients on the intellectual property, corporate, securities, and tax challenges that arise in equity-backed transactions.

IP law is a natural outgrowth of Aaron's academic and career background. With an undergraduate degree in mechanical engineering, he began his career working for manufacturing and engineering companies. His experience spanned mechanical brakes, substation transformers and related equipment, and gas turbine and steam turbine power generation.

Experience

Protecting Market Share

We guided a leading commercial refrigeration manufacturer through complex prosecution to obtain a patent on key technology for their business, and through multiple reexaminations that resulted in the client's patent being confirmed. In the face of several competitors coming to market with similar products, we identified key targets to focus on that enabled our client to protect, if not increase, its market share.

Derailing competitor claims in bet-the-company matters

One of the world's most renowned manufacturers of bicycles for competitive racing – including the Tour de France and the Giro d'Italia – faced a challenge relating to its wheel rims, which generate millions of dollars in sales each year. We filed a request for reexamination resulting in a highly favorable settlement. We then pursued the case to the Court of Appeals for the Federal Circuit to permanently derail the competitor.

Aligning IP strategy with business direction

In the emerging Internet-of-Things world, we worked closely with a leading commercial cleaning systems client on product development to determine an IP strategy in view of competitor technology and intellectual property. We leveraged our strategy and aligned our IP due diligence and patent prosecution efforts with the client's business goals to give our client an edge in the industry.

Defending a technology niche through creative patent prosecution

Our commercial cleaning systems client has had several competitors copy a very successful system that has been in the market for several years. Working closely with in-house counsel and the design team, we have prepared and successfully prosecuted numerous applications to grant through creative analysis of competitor products and the client's patent family, strategically expanding the scope of patent protection to encompass competing products entering the market.

Expanding business through IP

A manufacturing client sought to complement their product lines and enter new markets through the purchase of IP from another company. With the business goals in mind, we helped in-house counsel by evaluating the IP from offensive and defensive viewpoints, including consideration of lawsuits that had been filed or were ongoing, to give our client a complete landscape from which a purchase decision could be made.

Honors & Recognitions

- "Distinguished Young Alumnus" award, University of Wisconsin-Milwaukee College of Engineering & Applied Science, 2013

Professional Activities

- Member, American Bar Association
- Member, State Bar of Wisconsin
- Member, Golden Key National Honor Society

Education

- Marquette University Law School, Juris Doctor (J.D.), 2008
- University of Wisconsin-Milwaukee, Bachelor of Science (B.S.), 2001; Mechanical Engineering

Admissions

- United States Patent and Trademark Office
- Wisconsin
- United States District Court, Eastern District of Wisconsin

Community Involvement

- Board of Directors and President, Razor Sharp Minds Foundation (Alzheimer's Disease)
- Board of Directors and Secretary, Milwaukee Marathon

Related News

PUBLICATION

January 24, 2019

Secret Commercial Sale of an Invention May Qualify as Prior Art

EVENT

July 19, 2017

Your Company's Technology and the Importance of IP