

Daniel S. Jones

Partner

Overview

Dan focuses his practice on mechanical technologies, design patents and licensing. He has prepared and prosecuted patent applications in many areas of technology, including internal combustion engines, microturbine engine generators, water heaters, outdoor power equipment, robotic inspection systems, air tools, compact construction equipment, hydraulics, golf carts and low-speed vehicles, hair clippers, and furniture.

Dan regularly helps clients negotiate research and development agreements, material transfer agreements and license agreements. He also routinely counsels clients in patent enforcement and avoidance.

Dan's status as a trusted advisor was reinforced in 2014 by his selection as a winner of the Client Choice Award (Lexology/International Law Office), a distinction that recognizes law firms and partners who stand apart for excellent client service. He has also excelled as a leader of the firm's IP practice, which is ranked in the top 20 percent of all law firms in the United States by *Intellectual Property Today*.

Dan is constantly exploring ways to further improve client service. He is currently developing methods clients can use to track the progress of their patent applications, and has established a practice of embedding client personnel at Michael Best and the firm's employees in client offices to enhance working relationships.

Experience

Notable matters include:

- Developed proposals for existing and new clients designed to significantly reduce spending in intellectual property matters while maintaining or improving client service. In one example for a large client, the proposal targets a 5 percent reduction in legal spend for patent prosecution while improving the quality of patent applications and achieving better results, with no material loss of global patent coverage.
- Assisted a major client's development of an IP Board to take a more strategic, centralized approach to patent portfolio management. This includes performing research and analytics of the competitive landscape and advising the client on making strategic



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Industries

Water

Practices

Intellectual Property
Licensing & Technology
Agreements
Patent

decisions based on actionable information. Client is using a wiser and more cost-effective approach to spending money on patent prosecution, with higher priority placed on product development efforts and new awareness of developments by competitors.

- Helped large clients analyze potential patent infringement by main U.S. competitors in extremely competitive industries. One infringement assessment included a review of more than 40 patents, assessing which patent claims form the basis for the strongest case of infringement, and preparing a demand letter to the competitor. This work has forced direct competitors of our clients to design around our clients' patents.
- Prepared and prosecuted *inter partes* reexamination of patent to stay litigation and attack validity of patent in United States Patent and Trademark Office
- Counseled clients on pre-litigation and litigation strategy as defendant and plaintiff in patent infringement lawsuits
- Drafted and negotiated license of worldwide patent portfolio relating to plant genetics, including very complex field-of-use, territory and royalty provisions
- Assisted in establishing and running patent review committee for several large clients
- Performed trade secret audits for several clients wishing to identify and secure confidential and proprietary corporate information
- Traveled to China with leadership of major manufacturer; interviewed multiple Chinese intellectual property firms with client; participated in selection of Chinese firm; oversaw consolidation of all matters with new Chinese firm and implementation of client service model in Chinese operations

Honors & Recognitions

- *The Best Lawyers in America*®, Patent Law, 2016-present
- IAM Patent 1000 – World's Leading Patent Practitioners, 2016-present
- Lexology Client Choice Award, Intellectual Property: Patents, 2014

Professional Activities

- Member, American Bar Association
- Member, State Bar of Wisconsin
- Yellow Belt Certified, Legal Lean Sigma

Education

- University of Wisconsin Law School, Juris Doctor (J.D.), *cum laude*, 1997
- University of Wisconsin-Madison, Bachelor of Science (B.S.), 1993; Engineering Mechanics

Admissions

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



Community Involvement

- Board of Directors, Milwaukee Youth Arts Center
- Former Executive Committee Member and Vice President of Strategic Planning, First Stage Milwaukee

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