



Jacob C. Vannette

Associate

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OVERVIEW

Jacob Vannette is a PTO-registered lawyer with a technical background in mechanical engineering. He focuses his practice on intellectual property litigation, including patent and trademark infringement, false advertising, and trade secret misappropriation.. Previously, he served as a law clerk to the Honorable Robert W. Schroeder III of the United States District Court for the Eastern District of Texas.

Jacob is experienced in all phases of patent and trademark litigation, including fact and expert discovery, preliminary and permanent injunction requests, witness preparation, discovery and dispositive motion practice, claim construction, trial preparation, and trial and post-trial practice. His patent experience covers a range of technologies, including control systems, electrical devices, communications systems, and materials science, while his trademark experience extends across a variety of industries, including fashion and nutrition. Jacob also has extensive appellate experience, particularly in the United States Court of Appeals for the Federal Circuit. He has engaged in the full range of appellate litigation, from initial filings, to motion practice, brief drafting and submission, hearing preparation, and oral argument.

Jacob routinely practices in front of the United States Patent and Trademark Office. He has prepared numerous inter partes review petitions and expert declarations at the Patent Trial and Appeal Board on behalf of petitioners for patents covering a variety of technologies. He has also represented clients in many opposition and cancellation matters at the Trademark Trial and Appeal Board.

Jacob regularly advises clients on global brand portfolios and protection and enforcement of trademark, copyright, and other intellectual property rights. Jacob also handles patent portfolio management, including patent prosecution, freedom-to-operate study work, due diligence, and counseling. His prosecution experience extends to diverse mechanical and electrical technologies, including aerospace devices, hydrodynamic systems, software, and electromechanical devices.

Jacob also has an active pro bono practice, representing clients at the PTO, asylum applicants in immigration court, supporting a guardian ad litem, and representing veterans before the United States Court of Appeals for Veterans Claims.

PROFESSIONAL BACKGROUND

Jacob was a summer associate at the firm's Chicago office in 2015. While in law school, Jacob gained patent prosecution experience working for the Naval Surface Warfare Center in Crane, IN, drafting applications involving a variety of technologies. He also participated in the State Appellate Defender clinic, representing an indigent criminal defendant in an appeal. In 2014, he interned with the in-house intellectual property group at Rolls-Royce North America, where he engaged in patent prosecution, strategic portfolio management, and business development activities.

While attending Villanova University, Jacob was a member of the Air Force Reserve Officer Training Corps. During his final year at Villanova, Jacob travelled to Nicaragua as a member of an engineering service team tasked with designing, building, and maintaining gravity-driven water networks for remote villages.

EDUCATION

- J.D., University of Illinois College of Law, 2016 (*magna cum laude*)
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- B.S.M.E., Villanova University, 2013

ADMISSIONS

- Bar of District of Columbia
- Bar of Illinois
- United States Patent and Trademark Office
- United States Court of Appeals for the Federal Circuit
- United States District Court for the Central District of Illinois

LANGUAGES

- French

THOUGHT LEADERSHIP POWERED BY HUB

- 14 November 2021, Federal Circuit Further Clarifies Venue in Hatch-Waxman Cases (*BlogPost*)
- 14 June 2021, Federal Circuit Holds Prosecution Laches Defense is Available to PTO in a 35 U.S.C. § 145 Action (*Alerts/Updates*)
- 25 July 2019, Towards a Uniform Theory of Patent Law: The Federal Circuit Declines to Create Design-Patent-Specific Rules for Exhaustion or Repair (*Alerts/Updates*)

- 17 May 2018, Federal Circuit Declines to Alter Alien Venue Rule in Patent Cases Post-*TC Heartland* (*Alerts/Updates*)
- 2 May 2018, The Supreme Court Upholds and Clarifies Inter Partes Review (*Alerts/Updates*)
- 17 May 2017, Be Careful What You Wish For: Federal Circuit Says Statements Made During IPR Can Limit Scope of Patent (*Alerts/Updates*)
- 12 December 2016, Supreme Court Signals Shift in Approach to Damages in Design Patent Infringement Cases (*Alerts/Updates*)

OTHER PUBLICATIONS

- "Key Design Patent Takeaways From Fed. Circ.'s Ford Decision," *Law360*, 7 August 2019
- "How PTAB Applies Mayo To Method Involving Natural Principle," *Law360*, 6 February 2017

AREAS OF FOCUS

- IP Litigation
- Appellate Litigation
- IP Procurement and Portfolio Management
- Post-Grant Patents
- Technology Transactions and Sourcing

REPRESENTATIVE EXPERIENCE

- Represents clothing company in trademark litigation and brand protection in the Trademark Trial and Appeal Board and federal district courts across the United States.
- Represents domestic and foreign corporations in patent litigation in federal district courts across the United States and in administrative proceedings at the Patent Trial and Appeal Board.
- Represented asylum applicant in immigration court and obtained asylum for client.
- Represents veterans before the United States Court of Appeals for Veterans Claims.
- Represented plaintiff in trademark infringement, unfair competition, and cybersquatting in the Northern District of Illinois and obtained favorable judgment, a multi-million dollar damages award, and an injunction.
- Served as trial counsel for supplier to rail and transportation industries in two-week jury trial on eight patents. Favorable pre-trial damages rulings significantly limited potential exposure.
- Served as appellate counsel for the Board of Trustees of the University of Illinois in the Federal Circuit and secured a Rule 36 affirmance related to a request for attorneys' fees.