



Erik J. Halverson

Associate

Chicago
+1.312.807.4240

erik.halverson@klgates.com

OVERVIEW

Erik Halverson is an associate in the Chicago office, a PTO-registered patent attorney with a background in engineering physics and materials science, and a member of the post-grant review, IP litigation, and IP procurement and portfolio management practice groups. He concentrates his practice in post-grant practice at the Patent Trial and Appeal Board (PTAB) and has experience arguing before the PTAB as well as trial experience in federal district court.

As a PTO-registered lawyer, Erik has experience with post-grant proceedings at the PTAB. His involvement includes the preparation and prosecution of numerous inter partes review petitions, defense of challenged patents, preparation of expert declarations, defending and taking expert depositions, and all manner of motion practice before the PTAB. Additionally, Erik has experience arguing *inter partes* review trials at the PTAB. In all instances, Erik's involvement has been coupled with overall trial strategy for co-pending district court litigation. Erik is also experienced in all facets of intellectual property litigation, including fact and expert discovery, motion practice, claim construction practice, and trial practice. His trial experience includes the presentation of and cross examination of technical experts in federal district court.

Erik also has experience handling standard patent prosecution matters as well as arguing prosecution appeal matters before the PTAB. Erik also handles patent licensing, due diligence and counseling matters. His experiences include license negotiation and drafting; joint development agreements and independent contractor agreements; and international IP portfolio review. As an attorney licensed to practice before the U.S. Patent and Trademark Office, Erik's experience includes electrical and mechanical devices, medical devices, semiconductors, industrial materials, consumer electronics, and a variety of internet-related work including application development, networking, cellular communication, and remote computing technologies. He also provides strategic counseling, due diligence research and analysis for portfolio acquisitions, and opinion work such as patentability, validity, non-infringement, and freedom-to-operate opinions.

PROFESSIONAL BACKGROUND

Prior to joining K&L Gates, Erik was a Public Interest Law Initiative (PILI) Graduate Fellow with Catholic Charities Legal Aid in Chicago where he provided legal assistance to underserved members of the Chicago community.

SPEAKING ENGAGEMENTS

- *Real Parties in Interest post-RPX before the PTAB*, Chicago Bar Association, (March 26, 2019)

ADDITIONAL BACKGROUND

Erik was a summer associate at the firm in 2014. Erik serves on the board of directors for the Illinois Rowing Association.

EDUCATION

- J.D., Chicago-Kent College of Law, Illinois Institute of Technology, 2015 (*Chicago-Kent Journal of Intellectual Property, Managing Editor*)
- B.S., University of Illinois, 2011 (*Engineering Physics*)

ADMISSIONS

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

THOUGHT LEADERSHIP POWERED BY HUB

- 24 September 2020, PTAB Decisions Can Now Be Nominated Anonymously (*Research Surveys*)
- 27 July 2020, PTAB's Motion to Amend Patentability Powers (*Research Surveys*)
- 26 March 2020, PTAB Designates Additional Decisions precedential Relating to its Discretion to Deny Petitions (*Research Surveys*)
- 3 January 2020, Shifting Gears on the Presumption of Nexus for Secondary Considerations of Non-Obviousness (*Research Surveys*)
- 30 December 2019, Shifting Gears on the Presumption of Nexus for Secondary Considerations of Non-Obviousness (*Alerts/Updates*)
- 23 December 2019, POP Provides Clarity Regarding Level of Proof for Printed Publications Before the PTAB (*Research Surveys*)
- 5 November 2019, Unconstitutionality of PTAB Judges Corrected by Federal Circuit (*Alerts/Updates*)
- 3 November 2019, Unconstitutionality of PTAB judges corrected by Federal Circuit decision (*Research Surveys*)

- 31 July 2019, IPR of pre-AIA patent not an unconstitutional taking (*Research Surveys*)
- 18 July 2019, Second update of PTAB Trial Practice Guide issued (*Research Surveys*)
- 16 April 2019, St. Regis Mohawk Tribe petition for certiorari denied (*Research Surveys*)
- 3 March 2019, US: Helpful Guidance From Judge Bryson Regarding Stays Pending IPR (*Research Surveys*)
- 17 August 2018, US: Estoppel Attaches Even If Dismissed Without Prejudice (*Research Surveys*)
- 16 August 2018, US PTAB Trial Practice Guide Updates (*Research Surveys*)
- 2 May 2018, The Supreme Court Upholds and Clarifies Inter Partes Review (*Alerts/Updates*)
- 24 April 2018, U.S. patent case update: IPR proceedings (*Research Surveys*)
- 23 February 2018, Designing aftermarket auto parts: exhausting design patent rights (*Research Surveys*)
- 25 October 2017, Changing Tides: The Federal Circuit Reverses the Aqua Products Decision and Shifts the Burden to the Petitioner for Proving Unpatentability of Amendments (*Alerts/Updates*)
- 5 October 2017, Petitioners bear the burden of proving invalidity of amended claims in IPR proceedings (*Research Surveys*)
- 5 October 2017, Jury Awards Profits for Infringing Sales in Post-Samsung Design Patent Case (*Research Surveys*)
- 14 June 2017, Supreme Court to Consider Constitutionality of PTAB Proceedings (*Research Surveys*)
- 13 June 2017, Supreme Court to Consider Constitutionality of PTAB Proceedings (*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*)
- 1 February 2017, Setting Up the Scope of IPR Estoppel for the Federal Circuit (*Alerts/Updates*)
- 21 June 2016, *Cuozzo* Furthers the USPTO's Authority in Managing Its Agency Proceedings (*Alerts/Updates*)
- 15 June 2016, U.S. Supreme Court Eases Inelastic *Seagate* Standard for Enhanced Patent Damages (*Alerts/Updates*)
- 24 May 2016, Abstract Ideas and the USPTO: Examiner Guidance Post *Enfish* and *TLI* (*Alerts/Updates*)

AREAS OF FOCUS

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

REPRESENTATIVE EXPERIENCE

- IPR2018.01608 - IPR counsel for petitioner
- IPR2018.01797 - IPR counsel for petitioner
- IPR2018.01062 - IPR counsel for patent owner
- 1:17-cv-10649-LTS iRobot Corporation v. Bissell Homecare, Inc. et al. - counsel for Defendant, successfully settled mid-discovery
- 1:18-cv.00409-LPS-CJB Signode Industrial Group LLC v. 3M Company - counsel for Plaintiff, successfully settled mid-discovery
- IPR2017.00580; IPR2017.01263; IPR2017.01454; IPR2017.01533; IPR2017.01866; IPR2017.01669; IPR2017.01821; IPR2017.02044 - IPR counsel for Petitioner Westinghouse successfully rendering unpatentable challenged claims of six patents.
- 1:16-cv.00284-LPS Siemens Mobility, Inc. v. Westinghouse Air Brake Technologies Corporation et al. Trial counsel for Defendant Westinghouse in a federal jury trial on patent infringement in the district of Delaware involving eight train control patents.
- IPR2017.00276; IPR2017.00477 - IPR counsel for petitioner successfully rendering unpatentable challenged claims of three patents.
- IPR2017.01391; IPR2017.01392; IPR2017.01406; IPR2018.00327; IPR2018.00328; IPR2018.00329 - IPR counsel for petitioner successfully rendering unpatentable challenged claims of three patents.
- ITC-337-TA-1087 Batteries and Electrochemical Devices Containing Composite Separators, Components Thereof, and Products Containing Same