



## DANIEL M. FITZGERALD

### PARTNER

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Dan Fitzgerald is a partner in the firm's Intellectual Property practice where he chairs the electrical and computer science group. Dan has developed an extensive intellectual property law practice with several Fortune 500 corporations, handling transactions, product development, patent prosecution, litigation strategy and *inter partes* review strategy. In his practice, Dan regularly counsels clients and supervises due diligence reviews on proposed transactions, and negotiates and drafts agreements for acquisitions, licenses and technology transfers. He also develops and implements strategies to merge and integrate acquired technology for synergistic results and cost efficiencies.

Registered to practice before the U.S. Patent and Trademark Office, Dan performs product clearance assessments and guides product development to minimize intellectual property risks in a variety of industries, including database management systems, cloud computing, online advertising systems, mobile device technology, payment processing and fraud detection systems, financial and insurance management systems, medical diagnostic devices, packaging products and machinery, control systems, railroad equipment and other business-related systems. He also develops programs to map relevant patent activities, and counsels clients and provides opinions in support of product launch and patent litigation.

An experienced IP practitioner, Dan also advises his clients on the strategic aspects associated with enforcing or defending patent rights. Over the years, he has been involved in a number of patent infringement controversies involving the enforcement of patent rights, the defense of product-producing clients and challenging the validity of patents.

Additionally, Dan manages patent estates involving several thousand patent and trademark matters, including supervising and performing all phases of patent and trademark prosecution in the United States and throughout the world. He also develops and implements programs to monitor intellectual property activities by competitors, and facilitates and manages internal innovation efforts.

### EDUCATION

- University of Notre Dame Law School (J.D., *cum laude*, 1993)
- University of Notre Dame (B.S., 1989)

### SERVICES AND INDUSTRIES

Intellectual Property  
Post Grant Proceedings  
Technology  
Manufacturing and Innovation  
Patent

### ADMISSIONS

Missouri  
Illinois  
U.S. Patent and Trademark  
Office

## PROFESSIONAL ACTIVITIES

- The Missouri Bar
- Illinois State Bar Association
- National Lawyers Association
- Madison County Bar Association
- Alton-Wood River-Jersey Bar Association

## ACCOLADES

- *The Best Lawyers in America*®; Patent Law (2013-present)
- Best Patent Attorneys, *St. Louis Small Business Monthly* (2018)

## BACKGROUND

Prior to attending law school, Dan worked as a project engineer in the metal refining industry.

## EXPERIENCE

### **Successful PTAB Administrative Appeal**

Won an administrative appeal for a global technology company before the U.S. Patent Trial and Appeal Board in a case involving a patent application that sought to protect a method of predicting a consumer's future purchases, based on previous transaction card purchases indicating that a "life event" had recently occurred for the consumer. The United States Patent and Trademark Office had rejected the application as directed to an abstract idea under a 2014 Supreme Court case. In its decision in favor of the client, the Appeal Board held that any abstract idea was integrated into a practical application because the patent claims "improve the underlying consumer behavior prediction technology."

### **Filed Trademarks for Retirement Plan Provider in Naming of Major Sports Stadium**

Served as IP counsel to a retirement plan provider related to their involvement in purchasing naming rights to a major U.S. sports stadium. Provided counsel on and filed for trademark protection of names and logos following multi-year deal.

### **Structured Multimillion-Dollar, Multi-Year Sponsored Research Program and Joint Venture for Health Care Client**

Structured a multimillion-dollar, multi-year sponsored research program and related joint venture, between a health care client and a leading research university. Structured budgeting and oversight mechanisms for research funding; structured LLC joint venture (JV) entity and related governance matters; completed licensing agreements and conducted analysis related to JV intellectual property ownership; all enabling future commercialization of intellectual property developed from funded research.

### **IP Agreements for Health Client Entering Third-Party Partnerships**

Prepared various IP-related agreements including licenses, commercialization and joint development agreements, enabling client to successfully enter into partnerships with

third parties.

**Patent Clearance Projects in Pharmaceutical Industry**

Managed several patent clearance projects relating to a computer ecosystem designed to manage the prescription process and use by patients of a multimillion-dollar pharmaceutical product.

**Patent Infringement, Invalidity Analysis Relating to Display Screen Technology**

Managed patent infringement and invalidity analysis for a client in the area of display screen technology. This involved numerous design patents covering various types of display screens.

**Patent Landscape Analysis for Fintech Client**

Conducted patent landscape analyses and ideation sessions for a large fintech client in the area of authenticating online users.

**Patent Portfolio Development Related to Autonomous Vehicles**

Led a team of patent attorneys to prepare and file several patent applications for a large client directed to the control, management and diagnostic testing of autonomous vehicles.

**Patent Portfolio in Touch Screen Technology**

Managed the filing of a portfolio of patent applications for an international client in the touch screen technology area.

**Payment Authentication Patent Portfolio for Fintech Client**

Developed patent portfolio for large fintech client in the area of payment authentication services. Multiple patent attorneys prepared and filed numerous patent applications directed to authenticating online users using client device metadata.

**IP Due Diligence for \$900 Million Business Acquisition**

Handled the IP due diligence for a client that acquired a payments technology company valued at about \$900 million.