masuda funai

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Michael Golenson's litigation and dispute resolution practice is focused on intellectual property, particularly patent claims in federal courts and at the United States International Trade Commission (ITC). He is experienced in all phases of the litigation process, including trial and appellate work, motion practice, fact and expert discovery, claim construction, development of case strategies and defenses and pleadings. Michael has successfully worked on claims with values that range from millions to a half a billion dollars at stake.

In addition to his litigation practice, Michael routinely counsels clients regarding freedom-to-operate and patentability of inventions, as well as various other IP and litigation issues. Michael is a registered Patent Attorney and has experience in handling AIA post-grant proceedings at the United States Patent and Trademark Office (USPTO) as part of an overall litigation strategy. He also has experience drafting license agreements and conducting settlement negotiations. Michael is appreciated by clients for his objective analysis of the matter at hand, as well as for his ability to clearly communicate the pros, cons and viable paths to resolution.

Michael has been involved in legal matters that represent a broad range of technologies. His experience includes automotive vision-based driver assistance systems, banking products and systems, consumer and commercial printers, digital cameras, image processing, cellular telephones, telecommunications, mechanical devices, baking and food processing systems, gaming devices, medical devices, liquid crystal displays, stem cell therapies, home building products and drug testing devices.

Prior to joining Masuda Funai, Michael spent more than seven years practicing intellectual property law with a major

Education

The University of Illinois Chicago School of Law, (f/k/a The John Marshall Law School), J.D., cum laude, 2009;
Executive Lead Articles Editor, Review of Intellectual Property Law

University of Illinois, B.S. Mechanical Engineering, with honors, 2006

Admissions

Illinois

U.S. Court of Appeals: 9th Circuit

U.S. District Court, Northern District of Illinois

U.S. District Court, Southern District of Illinois

U.S. District Court, Central District of Illinois

U.S. District Court, Western District of Michigan

U.S. District Court, Eastern District of Texas

U.S. Patent and Trademark Office

Practice Areas

Intellectual Property & Technology

Litigation

Commercial, Competition & Trade

international law firm and a large national law firm. Prior to his law firm experience, Michael clerked for the Honorable Edward A. Bobrick (Ret.), Special Master to the United States District Court for the Northern District of Illinois and arbitrator/mediator with JAMS Arbitration, Mediation and Alternative Dispute Resolution Services. He also served as a Judicial Extern to the Honorable Ronald A. Guzman of the United States District Court for the Northern District of Illinois.

Experience

- Successfully defended an international manufacturer of agricultural and livestock nutritional and cleaning products in a federal district court lawsuit involving claims of trademark infringement, false advertising, and domain name cyber squatting. Obtained a settlement on favorable terms for the client.
- Won ruling of no violation for a leading Tier 1 automotive supplier in an ITC investigation involving vision-based driver assistance systems that was brought by a competitor. Administrative Law Judge found asserted claims of one patent were not infringed and asserted claims of the second patent were invalid. Commission affirmed ALJ's ruling and found additional grounds supporting the ruling of no violation.
- Successfully defended a leading Tier 1 automotive supplier against 31 patents and 1,000+ asserted patent claims in a competitor dispute involving vision-based driver assistance systems that spanned across four district court lawsuits, two ITC investigations, and 60+ petitions for inter partes review at the U.S. Patent and Trademark Office. Won ruling of no violation in one ITC investigation; remainder of dispute settled on favorable terms for the client after the first week of a month-long jury trial in federal court.
- Successfully defended a leading nation bank against various lawsuits and threatened actions brought by non-practicing entities. All matters resolved on favorable terms for the client.
- Won ruling of no violation for a leading consumer electronics company in an ITC investigation involving a digital camera and image processing technology. Administrative Law Judge found that (1) client did not infringe either of the two asserted patents, (2) one of the asserted patents was invalid, and (3) complainant lacked the required domestic industry for the second asserted patent. Commission declined to review the ALJ's decision and the Federal Circuit affirmed the Commission's decision.
- Successfully defended a leading commercial printer company in a district court lawsuit involving data streams and proprietary programming languages for commercial label printers. Obtained early settlement on favorable terms

Languages

English
Russian

for the client after disclosure of initial invalidity contentions.

- Successfully defended a leading consumer electronics company in a district court lawsuit involving technology related to operating system design, digital camera user interfaces and power management, ink-jet printers, and serial communication technology. Case settled favorably for the client.
- Successfully defended a major cellular telephone manufacturer in an ITC investigation involving teleconferencing technology in cellular telephones. Obtained early settlement on favorable terms for the client during fact discovery.
- Successfully defended a drug testing company in a district court lawsuit involving allegations of false advertising related to drug testing services. After a two-week trial, the district court entered a Consent Order with the client paying no damages and having no obligation to change any of its products or services.
- Won an appeal for a stem cell therapeutics company in the U.S. Court of Appeals for the Ninth Circuit reversing a district court ruling which dismissed the case on forum non-conveniens grounds.
- Advised a multinational technology and materials company in its steps to achieve compliance with the California Consumer Privacy Act (CCPA).

Memberships

- American Bar Association
- American Intellectual Property Law Association

Distinctions

- Legal 500 Chicago Elite – Intellectual Property: Contentious