



## Jeffrey J. Catalano

Partner | Chicago

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### Areas of Practice

Intellectual Property | Intellectual Property Litigation | Copyright Law | Patent Law | Trade Secrets | Consumer Products

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Jeffrey Catalano is a Partner in the Intellectual Property Practice of Smith, Gambrell & Russell, LLP and serves as the Chicago Section Head. Mr. Catalano was previously a Partner with Freeborn & Peters, which combined with SGR in 2023.

Mr. Catalano focuses his practice on intellectual property litigation as well as IP-adjacent commercial litigation. His experience includes patent, copyright, trade secret, trademark, and unfair competition disputes before federal courts, arbitrators, the United States Patent and Trademark Office, and the International Trade Commission.

He also has in-depth experience related to patent licensing, including the licensing of standards-essential patents on fair, reasonable and non-discriminatory (FRAND) terms. His FRAND-related experience includes patent valuation, assessments of licensing terms for individual patents as well as patent portfolios, and litigation and alternative dispute resolution, including related affirmative defenses and rate setting proceedings.

Clients trust Mr. Catalano with contentious, high-stakes litigation and licensing matters that often have tens, if not hundreds of millions of dollars on the line. He has both the trial experience and the negotiation skills demanded by these cases. Although he represents clients of varying size, national origin, and litigation experience, He has made a practice of assisting domestic and foreign clients with their first significant U.S. litigations. His candor, communication style, and understanding of business realities allow him to help clients traverse the pitfalls and mitigate the burden of U.S. discovery. At trial, he is adept at presenting complicated concepts, principles, and technologies in an understandable, memorable, and relatable fashion.

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While at Freeborn (now SGR), Mr. Catalano served as the Leader of the Intellectual Property Practice Group. He previously was a Shareholder at Brinks, Gilson & Lione.

Mr. Catalano received his B.A. from Miami University and his J.D. from Georgetown University Law Center.

## Representative Experience

- Land use and zoning approvals for a 53-story, mixed-use, high-rise building in Chicago's Streeterville neighborhood.
- Represents a publicly-traded online travel company in connection with patent infringement litigation related to geolocation- and context-based searching in websites and mobile applications. The case is pending in District Court. (W.D. Tex.)
- Represents a large residential services company before in copyright litigation related to the unauthorized use of the client's customer-service manuals in training classes offered by the defendants. After a six-day jury trial in which Jeff was lead trial counsel, the jury found that defendants had willfully infringed client's copyright and denied all counterclaims and affirmative defenses. The case is pending on appeal. (M.D. Tenn.; 6th Cir.)
- Represented a telecommunications manufacturer in patent litigation involving technology directed to the reduction of power consumption in computer processors. (E.D. Tex.)
- Represented a telecommunications manufacturer in patent litigation related to multiband antenna technology. Jeff was instrumental in prevailing on a motion to dismiss for improper venue, resulting in the transfer of the case from the Eastern District of Texas to the Northern District of Texas. (N.D. Tex.)
- Represented a publicly-traded online travel company in connection with copyright litigation related to the use of photographs. (S.D. Fla.)
- Represented a media company in connection with copyright litigation related to the use of photography. (N.D. Ill.)
- Represented a telecommunications manufacturer in patent litigation related to use of voice recognition software by Android-based smartphones to search and retrieve electronic data. (S.D. Cal.)
- Represented a telecommunications manufacturer in four investigations at the International Trade Commission in Section 337 litigation related to alleged infringement of patents related to LTE standards, WCDMA standards, 802.11 standards ("WiFi"), microprocessor technology, and graphical user interfaces. (ITC)
- Represented a telecommunications manufacturer in copyright litigation related to the alleged use of copyrighted images as background wallpaper for smartphones. (D. N.J.)
- Represented a manufacturer of health and beauty products in copyright litigation related to alleged use of nearly 1,000 sound recordings in online and social media advertising. (M.D. Fla.)

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- Represented a telecommunications manufacturer in commercial litigation related to the alleged breach of a FRAND obligation by owner of a portfolio of standards essential patents. (S.D.N.Y)
- Represented a manufacturer of health and beauty products in case related to the false advertising of health claims and misappropriation of trade secrets by the defendant, a competing manufacturer of health products. (D. Utah)
- Represented a manufacturer of health and beauty products against claims of monopolization and attempted monopolization under Section 2 of the Sherman Act. (W.D.Mo.)

## Admissions

Illinois

United States Court of Appeals for the Federal Circuit

United States Court of Appeals for the Sixth Circuit

United States Court of Appeals for the Seventh Circuit

United States District Court for the Northern District of Illinois (Trial Bar)

United States District Court for the Eastern District of Texas

United States District Court for the Eastern District of Michigan

United States District Court for the Western District of Michigan

United States District Court for the Western District of Texas

## Recognitions

*Illinois Leading Lawyers - Emerging Lawyers - 2020 (cited in multiple years)*

## Publications

- Presenter, "Protecting Your Brand from Counterfeits and Knock-Offs," Juvenile Products Manufacturers Association Webinar (January 28, 2020).
- Panelist, "Enforcing IP in the United States," USPTO China IP Roadshow, John Marshall Law School (October 20, 2017).
- Litigant/Panelist, "China-US Intellectual Property Comparative Mock Trial," China's State Intellectual Property Office (SIPO) (June 15, 2017).
- Speaker, "Fundamentals of U.S. Patent Litigation," Changzhou Annual IP Seminar, Changzhou, China (June 9, 2017).
- Panelist, "Demystifying Recent Decisions and Appeals at the ITC," CenterForce IP Summit (April 2016).
- Speaker, "IP Protection for Product Designs," Association of Corporate Counsel, Chicago Chapter (August 2015).

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- Presenter, "The Shifting Economics of Patent Litigation," ABA Annual Meeting, Chicago, IL (July 31, 2015).
- Presenter, "Utilizing the ITC in Your Enforcement Strategy," IP Strategy Summit Conference, Chicago, IL (May 12, 2015).
- Panelist, "Protecting Trade Secrets and Defending Against Allegations of Corporate Theft," Association of Corporate Counsel, Mountain West Chapter, Winter Retreat (March 19, 2015).
- Moderator, "What is the Future of RAND/FRAND Licensing?," ABA Annual Intellectual Property Law Conference, Arlington, VA (April 3, 2013).
- Co-Author, Client Alert: U.S. Supreme Court Holds that Willful Trademark Infringement is Not a Prerequisite to the Recovery of Profits (Romag Fasteners, Inc. v. Fossil Group, Inc.), Freeborn & Peters LLP, April 24, 2020.
- Co-Author, Client Alert: Supreme Court Opens the Door for the Recovery of Foreign Lost Profits for Patent Infringement Under 35 U.S.C. § 271(f)(2), Freeborn & Peters LLP, July 3, 2018.
- Co-Author, Client Alert: Federal Circuit Rules that Plaintiffs Bear Burden of Establishing Venue in Patent Infringement Litigation, Freeborn & Peters LLP, May 17, 2018.