

Austen Zuege

Patent & Trademark Attorney, Officer

Overview

Austen Zuege focuses his practice on intellectual property (IP) law in both transactional and litigation settings, including patent, trademark, copyright, trade secret and domain name dispute matters. This includes international IP application filings and prosecution such as Paris Convention patent applications, PCT applications and related national stage patent applications, and the coordination and supervision of global IP portfolios. He has familiarity with a variety of technical areas.

Austen has extensive experience organizing and conducting complex freedom-to-operate studies, advising on IP strategies, conducting validity/non-infringement opinion of counsel analyses, negotiating agreements, enforcing rights and defending clients in contentious IP disputes, and creating strategic plans for companies. He embraces processes and systems from an engineering and process improvement standpoint. He also writes and speaks about IP issues, and can translate complex legal issues into actionable tips and strategies for clients and their inside counsel.

He holds a bachelor's degree in industrial engineering. In his spare time, Austen is an avid cyclist. He commutes to work by bike year-round, including snowy Minnesota winters.

Areas of Practice

- Patents
- Trademarks
- Copyrights
- Trade Secrets
- Domain Name Disputes
- Freedom-to-operate Studies
- Validity/non-infringement opinions
- IP Litigation
- PCT National Phase Filings and Paris Convention filings in the US.
- Global Patent Portfolio Management and Strategy
- Patent Office Proceedings
- Local Counsel for IP Disputes in the District of Minnesota
- IP Licensing

Areas of Technical Expertise

- Aerospace
- Airfoils and Fans
- Medical Devices
- Automotive
- 3-D Printing and Additive Manufacturing
- Communications and Networking
- Building Systems Including Elevators and Escalators
- Mechanical Devices
- Electrical and Electromechanical Devices
- Data Storage (e.g., Hard Drives)
- Machine Vision Systems
- Sensors, Transducers and Controls
- Software
- Office Products, Recreational Equipment and Gaming
- Environmental Systems (e.g., HVAC)



Contact Information

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Bar Admissions

United States Patent and
Trademark Office
Minnesota State Bar
Federal Court for the District of
Minnesota
Court of Appeals for the Federal
Circuit

Education

University of Illinois College of Law,
Juris Doctor, *cum laude*
University of Wisconsin-Madison,
B.S. Industrial Engineering

Honors & Recognition

Recognized in *The Best Lawyers in America*© (2018-20) in the field of patent law

Minnesota Super Lawyers®, Rising Star (2013-2018)

Top Patent Prosecutor, Patent Buddy®

Professional Affiliations

Member, American Intellectual Property Law Association (AIPLA)

Member, Minnesota Intellectual Property Law Association (MIPLA)

Member, Minnesota State Bar Association (MSBA)

Member, Hennepin County Bar Association (HCBA)

Member, International Trademark Association (INTA)

Community Service

Board Member, Minneapolis Civilian Police Review Authority, 2008-2012

Other Interests

Bicycling

Music

Representative Matters

- Prepared, prosecuted and supervised hundreds of patent applications, including PCT and foreign counterparts, on a variety of technologies on behalf of multi-national corporations, medium-sized businesses, small businesses, and individual inventors
- Coordinated patent clearance/freedom-to-operate studies for billion-dollar product lines; advised client regarding risk management and patent avoidance strategies, and prepared associated opinions of counsel
- Defended international maker of optical identification systems against non-practicing entity in the Eastern District of Texas, in a case involving most competitors in the industry; negotiated settlement resolving all claims
- Implemented trademark policing and enforcement program for innovative photography service company; successfully pursued infringement action in the Central District of California, with a default judgment obtained over Defendant's active opposition
- Worked on litigation team for a leading automotive component business asserting multiple patents against competitor; negotiated settlement of all claims; also successfully defended the patents-in-suit in five concurrent *ex parte* and *inter partes* reexaminations
- Conducted diligence study of medical device company patent portfolio for possible corporate acquisition

Publications

- [Understanding Patent and Commercial Warranty Liability Stemming from Pending Patent Applications](#), 18 WAKE FOREST JOURNAL OF BUSINESS AND INTELLECTUAL PROPERTY LAW 444 (Spring 2018)
- [Patent Freedom to Operate Searches, Opinions, Techniques, and Studies](#) (ABA 2017), editor and lead co-author
- **Beyond the Looking Glass: Patent-Eligible Subject Matter After Alice and Mayo**, *Intellectual Property Today*, Vol. 21, No. 11 (November 2014), with Erik Wright
- [A New Theory for Patent Subject Matter Eligibility: A Veblenian Perspective](#), 5 *CYBARIS* 211 (2014)
- **Strategic Third-Party Submissions Against Patent Applications**, *Intellectual Property Today*, Vol. 19, No. 12 (December 2012)
- **A New Era for Patent-Eligible Subject Matter**, *Intellectual Property Today*, Vol. 19, No. 5 (May 2012)
- **No Short-Cuts: Weighing the Facts Under §103**, *Journal of the Patent and Trademark Office Society*, Vol. 91, No. 6 (June 2009), with Carolyn Beck
- **Untying Patents from the Sherman Act: Illinois Tool Works, Inc. v. Independent Ink, Inc.**, *The IP Book*, 4th Edition (2006), with Thomas Stueber and Jessica Kwak
- **Implications of SmithKline Beecham v. Apotex Corp. on the Experimental Use and Inherent Anticipation Doctrines**, *The IP Book*, 3rd Edition (2005), with Michael Pape and Jessica Kwak
- **The "Written Description" Requirement: Recent Cases and Their Practice Implications**, *The IP Book*, 2nd Edition (2004), with David Fairbairn and Andrew DeMaster
- [Intellectual Property Law for Business Lawyers](#), Thomson Reuters®, annual (former contributing author and chief editor, 2002-2016)
- [Federal Intellectual Property Laws and Regulations](#), Thomson Reuters®, annual (former chief editor, 2009-2016)

Presentations

- [Structuring Freedom to Operate Opinions: Reducing Risk of Patent Infringement](#), with Michael S. Cuiello & John M. Fleming, 2019
- [The “Patent Troll” Debate](#)
Intellectual Property: Advanced Topics for Businesses in a Changing Legal Landscape, 2014
- [Oracle v. Google and Its Impact on Software Development and Protection](#)
Intellectual Property: Key Topics for In-House Counsel and Business Lawyers Today, 2013
- [Design Patents: Review & Developments](#)
Intellectual Property: Key Topics for In-House Counsel and Business Lawyers Today, 2013
- **And Now From the Peanut Gallery: Understanding New Avenues for Third-Party Attacks on Pending Patent Applications**
Hennepin County Bar Association Corporate Counsel Section, 2013
- [The New Paradigm for Patentable Subject Matter](#)
Intellectual Property Strategies: Seizing Opportunities and Managing Risks, 2012
- **Practical Copyrights for Small Businesses**
Intellectual Property Law: Beyond the Basics, 2011
- **Copyright and Street Art**
Intellectual Property Law: Beyond the Basics, 2011
- **Patent Reexamination: A View from the Trenches**
Intellectual Property Law: Beyond the Basics, 2010
- **State of the USPTO**
Intellectual Property Law: Beyond the Basics, 2009
- **Myths of Copyright Law**
Intellectual Property Law for Business Lawyers, 2008
- **Pushing the Bounds of Copyright**
Intellectual Property Law for Business Lawyers, 2008
- **Pushing the Boundaries of Copyright Law**, with Thomas Stueber
Midwest Intellectual Property Institute, 2007
- **eBay v. MercExchange: Injunctive Relief**
Intellectual Property Law for Business Lawyers, 2007
- **Copyright Basics**
Intellectual Property Law for Business Lawyers, 2006
- **Top Patent Cases**
Intellectual Property Law for Business Lawyers, 2006

