

Partner

Jonathan H. Urbanek

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Profile

“I became a mechanical engineer because I enjoyed building machines and solving technical problems, and I became a patent lawyer so that I could help clients protect their innovations.”

Jonathan H. Urbanek has a broadly based IP law practice focused on the preparation and prosecution of patent applications in the United States and abroad. Clients trust Jon to work closely with engineering teams to identify the inventive aspects of new products and prepare patent applications that persuasively differentiate the invention from the prior art. Jon frequently meets with engineers and management in person to determine where each product and its intellectual property fit into the business strategy of the client.

Jon goes beyond the details of the patent process to advise clients on those issues that support an effective patent strategy, including freedom-to-operate decisions, product design-arounds, and patent whitespace analysis. As a result, he plays an important role in counseling clients on developing meaningful patent protection for their technologies while avoiding competitors' patents.

Clients that Jon assists range from individual inventors and small businesses to Fortune 500 companies. Their technologies and applications are equally diverse, encompassing medical devices, irrigation, conveyor belt accessories, power systems, earth-moving equipment, packaging, food processing, communications equipment, e-commerce, computer systems, electro-mechanical devices, railcar systems, and manufacturing.

Jon is a member of Fitch Even's Marketing and Client Development Committee.

Representative Matters

- Develops patent portfolio for global manufacturer of industrial components for railroad and vehicular markets.
- Works closely with manufacturer of access control systems to prepare, prosecute, and enforce intellectual property. Provides real-time IP counseling during product conception and development.
- Advises global consumer products company in managing worldwide patent portfolio directed to beverages, beverage cartridges, and on-demand beverage systems.
- Counsels medical device manufacturer in developing patent portfolio to protect new products and expanding patent portfolio to protect existing products.
- Represents worldwide leader in irrigation technology in freedom-to-operate investigations, patent application preparation, and U.S. and international patent prosecution.

Education

J.D., DePaul University College of Law, 2008

B.S., Mechanical Engineering, University of Michigan, 2005

Bar Admissions

Illinois

U.S. Patent and Trademark Office

Recognition

DePaul University College of Law

Editor of Articles, Notes, and Comments, *DePaul Law Review*

Intellectual Property Scholarship from Fitch, Even, Tabin & Flannery

Law Merit Scholarship

Services

IP Portfolio Management

IP Strategy Development

Patent Preparation + Prosecution

Product Clearance + Legal Opinions

Industries

Computer Software + Hardware

Electronics

Food + Agricultural Sciences

Internet + E-Commerce

Mechanical Engineering + Manufacturing

- Counsels midsized manufacturers in conveyor belt industry regarding product development, patent preparation and prosecution, and non-patent IP matters.

Presentations + Publications

Presentations

- “Aftermarket, Not Afterthought: Patent Strategies for Protecting Aftermarket Parts,” Fitch Even webinar, with Jacqueline L. Thompson, October 29, 2020.
- “Widening Your Moat: Using Continuation Applications to Protect Commercially Successful Products,” Fitch Even Webinar, with Mark A. Borsos, September 28, 2017.
- “Practical Tips on Drafting Your First Patent Application,” American Intellectual Property Law Association webinar, with Conor S. Hunt, March 24, 2016.
- “The Lure of Functional Claiming: Benefits, Pitfalls, and Recent Court Decisions,” Fitch Even Webinar, with Stephen S. Favakeh, December 17, 2014.

Publications

- “Terminal Disclaimer Best Practices,” Intellectual Property Committee of the Chicago Bar Association Young Lawyers Section, March 2, 2011.
- “A Postmortem for Permanent Injunctions Against Business Method Patent Infringement in the Wake of *eBay v. MercExchange*,” *DePaul L. Rev.*, vol. 57, no. 2, Winter 2008: 607.

Memberships

- Hinsdale Little League
 - Board of Directors